

BL O/0966/24

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. UK003689648
IN THE NAME OF TIGER TRADE AG
FOR THE FOLLOWING TRADE MARK:**

TIGER TRADE

IN CLASSES 9, 36, 38 & 42

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY UNDER NO. 504790
BY TIGER FINTECH (SINGAPORE) PTE LTD**

AND

**IN THE MATTER OF APPLICATION NO. UK00003753046
BY TIGER FINTECH (SINGAPORE) PTE LTD
TO REGISTER:**



Tiger Trade

IN CLASSES 9, 36 & 41

AND

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 435289
BY TIGER TRADE AG**

AND

**IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY TIGER FINTECH (SINGAPORE) PTE LTD
AGAINST A DECISION OF A COOPER
DATED 25 MARCH 2024**

DECISION

Introduction

1. This is an appeal from a decision of A Cooper, acting for the Registrar, dated 25 March 2024, in relation to consolidated invalidity proceedings filed by Tiger Fintech (Singapore) Pte Ltd (“**the Appellant**”) against UK Trade Mark registration no. UK003689648 for the mark “TIGER TRADE” (“**the Respondent’s Mark**”) owned by Tiger Trade AG (“**the Respondent**”) and opposition proceedings filed by the Respondent against the Appellant’s UK Trade Mark application no. UK00003753046 for the following mark (“**the Appellant’s Mark**”):



Tiger Trade

2. The Respondent’s Mark is registered for goods and services in classes 9, 36, 38 and 42 with a filing date of 2 September 2021 and a priority date of 5 May 2021 (Switzerland).
3. The Appellant applied to have the Respondent’s trade mark declared invalid under section 47 of the Trade Marks Act 1994 (“**the Act**”) under sections 5(2)(b), 5(4)(a) and 3(6) of the Act.
4. In respect of the ground under section 5(2)(b) the Appellant relied on the following mark (“**the Earlier Mark**”):



UK registration no: 801454486

Filing date: 30 November 2018

Priority date: 31 May 2018 (Singapore).

The goods and services relied on are set out in paragraph 32 below.

5. In respect of the 5(4) ground, the Appellant relied on its use of the unregistered signs TIGER TRADE and TIGER BROKERS in the UK since at least 2016 in respect of a variety of goods and services.
6. In respect of the 3(6) ground, the Appellant claimed that the Respondent had no bona fide intention to use the Respondent's Mark in the UK, and that the Respondent must have known about the Appellant's use of its mark. The Appellant submitted that the sole purpose of applying for the Respondent's Mark was to try to prevent the Appellant from continuing to use or register its TIGER marks in the UK for its own personal/financial gain.
7. The Respondent filed an opposition against the Appellant's Mark relying on section 5(2) and the likelihood of confusion with the Respondent's Mark.
8. Both parties filed evidence in chief, and neither party requested a hearing but filed written submissions in lieu. The Appellant filed a counterstatement claiming that the Respondent's Mark was invalid.
9. The proceedings were consolidated. Only the Appellant filed evidence, but the Respondent filed written submissions during the evidence rounds. Neither party requested a hearing but both parties filed written submissions in lieu, so the decision was taken on the papers. The Appellant was represented by Morgan, Lewis & Bockius LLP and the Respondent by Lane IP Limited.

The Hearing Officer's Decision

Invalidity of the Respondent's Mark

10. Since the Appellant's invalidity action was aimed at the only mark relied on in the Respondent's opposition, the Hearing Officer dealt with it first.

Section 5(2)

11. The Earlier Mark was not subject to proof of use pursuant to section 47(2B) of the Act, so the Appellant could rely on all of the goods and services for which the Earlier Mark was registered.
12. The Hearing Officer found that some of the class 9 goods of the Respondent's Mark were identical to those of the Earlier Mark, some were similar to a medium or a high degree, but others were dissimilar. Some of the class 36 services were found to be identical, with

others similar to a medium or high degree. Some of the class 38 services were found to be similar to a medium degree, but others were found to be dissimilar, and the class 42 services were found to be similar ranging between low to high degrees of similarity.

13. Since some similarity of goods or services is required under section 5(2)(b), the opposition consequently failed under that ground for the following goods and services:

Class 9: Software for creating searchable databases of information and data.¹

Class 38: Telecommunication services; provision of access to computer databases; providing access to databases on computer networks; provision of access to a worldwide computer network; providing internet chatrooms and online forums; electronic messaging services.

14. The Hearing Officer found that the average consumer would be the public at large, who would pay an average degree of attention (increasing to relatively high for some services with a high cost or high interest rates), but would also include business users who were likely to pay a higher degree of attention. The selection process was likely to be dominated by the visual component, but the aural component could not be ignored, particularly with goods and services relating to finance, where the aural component was likely to play an equal role for some consumers.

15. The Hearing Officer found the marks to be visually similar to a low degree, aurally similar to a medium degree and conceptually similar to a high degree.

16. The Earlier Mark was found to be inherently distinctive to a medium degree, but had not been enhanced through use of the mark in the UK.

17. The Hearing Officer concluded that there was no likelihood of direct confusion, but found a likelihood of indirect confusion with respect to all of the goods and services which shared some degree of similarity due to the common presence of the word TIGER.

Other grounds

18. The opposition failed under the 5(4) and 3(6) grounds, but these were not the subject of this appeal.

¹ Paragraph 151 of the Decision omits in error these class 9 goods which were retained.

The Respondent's opposition to the Appellant's Mark

19. The Respondent's opposition was limited to the goods and services which survived the invalidity attack, as set out in paragraph 13 above (which were not subject to proof of use pursuant to section 47(2B) of the Act).
20. The Hearing Officer found that some of the class 9 goods of the Appellant's Mark were identical to some of the class 9 goods of the Respondent's Mark and similar to a low degree to "*telecommunications services*" covered by the Respondent's Mark. Some services were similar to a low degree, but other goods and services were dissimilar.
21. The average consumer, being the general public and business users, would pay between a low and relatively high degree of attention, with the same selection process criteria as with the invalidity action.
22. The marks were found to be visually similar to a high degree, and aurally and conceptually identical.
23. The Respondent's Mark was found to be inherently distinctive to an above medium (but not high) degree, but with no enhanced distinctiveness.
24. The Hearing Officer concluded that there was a likelihood of direct confusion for all of the goods and services which were found to be similar. Accordingly, the Respondent's opposition partially succeeded in respect of those goods and services.

The Appeal

25. The Appellant filed a Notice of Appeal to the Appointed Person under s.76 of the Act. At the hearing before me, which was held remotely, the Appellant was represented by Matthew McAleer of Lane IP Limited. The Respondent did not attend and was not represented.

Standard of review

26. It is well established that in order to interfere with the decision of the Hearing Officer I must be satisfied that there was a distinct and material error of principle in the decision or that the Hearing Officer was wrong. The relevant principles were set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24]. An appeal is by way of review, not a rehearing. Neither surprise at a Hearing Officer's conclusion nor a belief that she or he has reached the wrong decision will justify interference. The decision of the lower court will be "*wrong*" if the judge makes an error of law, which might involve

asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. In the absence of an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "*outside the bounds within which reasonable disagreement is possible*" (*Actavis Group* at [80]). In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education v Pie Corbett Consultancy* [2017] RPC 17 at [52(iv)], *REEF Trade Mark* [2003] RPC 5 at [28] and *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11 at [50]-[51]).

27. In a recent trade mark appeal in *Stitch Editing Limited v. TikTok Information Technologies Ltd* [2023] EWHC 1167 (Ch), Sir Anthony Mann said at paragraphs [6] to [8]:

"6. The correct approach to appeals such as this has recently been confirmed in the decision of Richards J in Instagram LLC v Meta 404 Ltd [2023] EWHC 436 (Ch). In that case (which was another trade marks appeal case) the judge followed the guidance to be applied in appeals generally and set out in Volpi v Volpi [2022] EWCA Civ 464.

"i) An appeal court should not interfere with the trial judge's conclusions on primary facts unless it is satisfied that he was plainly wrong.

ii) The adverb "plainly" does not refer to the degree of confidence felt by the appeal court that it would not have reached the same conclusion as the trial judge. It does not matter, with whatever degree of certainty, that the appeal court considers that it would have reached a different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.

iii) An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not mention a specific piece of evidence does not mean that he overlooked it.

iv) The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must of course consider all the material evidence (although it need not all be discussed in his judgment). The weight which he gives to it is however pre-eminently a matter for him.

v) An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable.

vi) Reasons for judgment will always be capable of having been better expressed. An appeal court should not subject a judgment to narrow textual analysis. Nor should it be picked over or construed as though it was a piece of legislation or a contract."

7. So far as the decision below is evaluative, an appellate court should also approach the appeal with caution:

"76. So, on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out a balancing task afresh but must ask whether the decision of the judge was wrong by reason of some identifiable flaw in the judge's treatment of the question to be decided, "such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermines the cogency of the conclusion". (Re Sprintroom Ltd [2019] EWCA Civ 932)

8. And last, as Richards J observed in *Instagram*, proper respect should be paid to the decision of an expert tribunal in the field in question:

"26. Finally, it is relevant to observe that this is an appeal from a tribunal with particular expertise. As Lady Hale observed in AH (Sudan) v Secretary of State for the Home Department [2007] UKHL 49 at paragraph 30, the court should approach the appeal on the basis that it is probable that an expert tribunal, charged with applying the law in their specialist field, has probably got it right."

28. I have borne those principles firmly in mind.

Grounds of Appeal

29. The Appellant’s appeal was directed at the Hearing Officer’s decision not to invalidate the Respondent’s Mark in relation to the retained goods and services set out in paragraph 13 above. Had he done so, then there would have been no retained goods or services left on which the Respondent could have relied on in its opposition against the Appellant’s Mark.
30. If the appeal did not succeed on that ground, then the Appellant applied to amend the class 9 specification for the Appellant’s Mark so that the words “*computer software*” were replaced with:
- “Computer software related to financial information, investment, and trading, namely, electronic trading software and investment portfolio management software; Computer software in the field of finance, investments and trading”.*
31. If the Appellant succeeds on the first issue, then there will be no need to consider the proposed limitation, so I will consider the appeal on the invalidity decision first.

Invalidity Action under Section 5(2)(b)/Section 47(2)

32. The Appellant submitted that the Hearing Officer erred in finding that there was no likelihood of confusion in relation to the retained goods and services covered by the Respondent’s Mark, set out in paragraph 13 above, and the goods and services covered by the Earlier Mark, which I have set out side by side in the table below:

Earlier Mark	Respondent’s Mark
<p>Class 9: Computer software related to financial information, investment, and trading, namely, electronic trading software and investment portfolio management software; software for providing electronic connectivity to financial exchanges and markets.</p> <p>Class 35: Business research; providing business information via a website; economic forecasting and analysis; advisory services for business</p>	<p>Class 9: Software for creating searchable databases of information and data.</p> <p>Class 38: Telecommunications services; provision of access to computer databases; providing access to databases on computer networks; provision of access to a worldwide computer network; providing internet chatrooms and online forums; electronic messaging services</p>

<p>management; business management consultancy.</p> <p>Class 36: Financial consultancy; securities brokerage; stock brokerage services; stock exchange quotations; stocks and bonds brokerage; investment of funds.</p> <p>Class 41: Providing non-downloadable on-line electronic publications, namely, magazines, newsletters and reports in the field of securities and investment information; educational services, namely, providing conferences, webinars, webcasts, and seminars in the fields of investment and finances.</p> <p>Class 42: Providing on-line non-downloadable software related to investment, namely, electronic trading software, investment portfolio management software and financial analytical software.</p>	
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33. The Appellant argued that that decision was erroneous for the following reasons:

- a. The Hearing Officer failed to correctly apply the principles of *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] R.P.C. 117 when comparing the relevant goods and services;
- b. No reasoning was given as to why “*Software for creating searchable databases of information and data*” was not complementary to the goods and services covered by the Earlier Mark;
- c. There was an inconsistency in finding “*software programs for spreadsheet management*” to be similar to a medium degree, but “*software for creating searchable databases of information and data*”, which could be wholly encompassed by the former, as dissimilar;

- d. There were general inconsistencies between the comparison of goods and services between the invalidity action and the opposition; and
- e. The Hearing Officer failed to apply the interdependency principle such that a greater degree of similarity between the marks can offset a lesser degree of similarity between the goods and services.

34. Before commencing his analysis of the goods and services in issue, the Hearing Officer set out the relevant extract from the *Canon* judgment, as well as the often-cited passages from *Treat* ([1996] R.P.C. 281) and *Gerard Meric v OHIM*, Case T-133/05. He then went on to assess the various class 9 goods in paragraphs 32 to 36 of his Decision as follows:

“Class 9

Software; software [downloadable]; computer software; computer application software; mobile application software.

32. The above goods of TTA are broad software related goods and sufficiently cover Fintech’s “software for providing electronic connectivity to financial exchanges and markets”. These goods are, therefore, identical under the principle outlined in Meric.

Financial management software; investment management software; software for the handling of financial transactions; software for displaying and analysing financial and investment information; software programs to allow access to investments accounts.

33. All of the above goods are broad enough that they can be said to cover software that relates to trading, investment portfolio management and that which allows connection/access to financial exchanges and markets. Given that this is the purpose of Fintech’s class 9 software goods, namely “computer software related to financial information, investment, and trading, namely, electronic trading software and investment portfolio management software” and “software for providing electronic connectivity to financial exchanges and markets”, I am of the view that they are identical under the principle outlined in Meric. If I am incorrect to find identity, the goods are plainly similar to an above medium degree on the basis that they are likely to overlap to some degree in nature, method of use, purpose, trade channels and user.

Software programs for spreadsheet management.

34. The above goods of TTA can be said to have different core purposes than Fintech’s goods. That being said, in the context of software relating to finance, the above can be said to be goods that cover the management of spreadsheets that relate to financial portfolios. [Footnote: On this point, I consider it necessary to set out that spreadsheets and databases in the context of financial services are likely to include spreadsheets/databases that are used to track user’s financial investments and/or asset holdings. For the avoidance of doubt, this understanding will carry through the body of this goods and services comparison.] As such, I do consider there exists some overlap in purpose with “computer software related to financial information, investment, and trading, namely, electronic trading software and investment portfolio management software” and “software for providing electronic connectivity to financial exchanges and markets” in Fintech’s specification. Further, I am of the view that (again, in the context of finance) both goods will be produced by the same undertakings and accessed by the same users. As a result, I consider that the goods also overlap in trade channels and user. As for nature and method of use, I am of the view that it can reasonably be said that these overlap to some degree also on the basis that both sets of goods are items of software that will be used in the ordinary

way. Taking all of this into account, I am of the view that the limited nature of these overlaps is sufficient to give rise to a finding that these goods are similar to a medium degree.

Software for creating searchable databases of information and data.

35. The above software is for the creation of databases and I do not consider that, upon the ordinary reading of the term, the goods can reasonably be said to relate to financial software. Even if the database ultimately created did relate to investment information, the aim of the above goods is to create a database meaning that there is no overlap in purpose between the above goods and “computer software related to financial information, investment, and trading, namely, electronic trading software and investment portfolio management software” and “software for providing electronic connectivity to financial exchanges and markets” in Fintech’s specification. The nature and methods of use for these goods may overlap to some degree as both goods are items of software that will be used in the ordinary way. However, I do not consider it necessarily follows that users and trade channels will overlap. I say this because I have nothing to suggest that those looking to create searchable databases will also use the specific software of Fintech and neither is there anything to suggest that they are provided by the same undertakings. Lastly, the goods are not complementary or competitive in nature. Taking into account the limited overlap in nature and method of use, I do not consider that this is sufficient to warrant a finding that the goods are similar to any degree. I say this because the goods are items of software and a finding of similarity on this basis alone would mean that it could be argued that all types of software are similar despite having different purposes, user bases and trade channels. In my view, this offers a scope of protection that is far too broad. As such, I consider that these goods are dissimilar.

Downloadable software and application, operable on computers and mobile devices, which operates as a trading platform for various financial instruments, including equities, indices, commodities, options, exchange traded funds, cryptocurrencies, foreign exchange and derivative products; downloadable software and application, operable on computers and mobile devices, for providing investment services and information relating to financial trading.

36. The above goods are all software goods that allow the user to operate a trading platform, access investment services or obtain information regarding financial trading. In my view, these are alternative descriptions of the same type of software that is covered by Fintech’s software goods, namely “computer software related to financial information, investment, and trading, namely, electronic trading software and investment portfolio management software” and “software for providing electronic connectivity to financial exchanges and markets”. As a result, I consider these goods to be self-evidently identical. Even if I am wrong to find identity between these goods on the basis that they are not the same, they are similar to a high degree on the basis that their natures, methods of use, purposes, users and trade channels are all likely to overlap.”

35. It can therefore be seen from paragraph 34 of the Decision that the Hearing Officer found “software programs for spreadsheet management” to be similar to a medium degree. It is apparent from his footnote in that paragraph that he had an understanding of how spreadsheets and databases used for financial services would be used to track investments, and he expressly stated that that understanding would “carry through the body of this goods and services comparison”.
36. The Appellant argued that “software for creating searchable databases of information and data” would fall within the scope of “software programs for spreadsheet management” because spreadsheets are a form of database and “creating” them would fall within “managing” them.

37. In the first sentence of paragraph 34 of the Decision, the Hearing Officer stated that *“the above software is for the creation of databases and I do not consider that, upon the ordinary reading of the term, the goods can reasonably be said to relate to financial software”*. I find the conclusion that the goods cannot reasonably be said to relate to financial software to be at odds with his conclusion in paragraph 32 of the Decision where he found that *“software; software [downloadable]; computer software; computer application software; mobile application software”* was identical to *“software for providing electronic connectivity to financial exchanges and markets”* because they were *“broad software related goods”*. I agree with the Appellant that the term *“database”* could include spreadsheets, and since spreadsheets are commonly created in relation to financial data, the Hearing Officer erred in concluding that *“software for creating searchable databases of information and data”* cannot reasonably be said to relate to financial software where there was no limitation on the nature of the *“information and data”*.
38. However, the Hearing Officer went on in paragraph 35 to distinguish the goods on the basis that *“Even if the database ultimately created did relate to investment information, the aim of the above goods is to create a database meaning that there is no overlap in purpose”*. He therefore appeared to distinguish the goods in paragraph 35 on the basis that software for the creation of databases, including financial databases, was not similar to the actual databases themselves once they had been created.
39. Software which allows members of the general public or business users to create a database is commonly available – Microsoft’s Excel being one of the most well-known examples. This software could be used for creating a database containing information for any purpose, including financial information for the purpose of managing an investment portfolio. For example, a user would be able to create a database that recorded information such as the number of shares which they owned in different companies, and the share prices of those shares etc, which could then be searched against in order to assess the performance of their investment portfolio. That would mean that the user of the database creation software could be the same as the user of the *“electronic trading software”* or *“investment portfolio management software”*. When used in that way, the database creation software could also be described as being used as investment portfolio management software. The Hearing Officer appears to have focussed on the difference between *“creating”* and *“managing”*, without considering whether the two types of software could be one and the same, such as

Microsoft Excel. Given his comments in the footnote in paragraph 34 of the Decision, I consider that he should have taken judicial notice of the existence of this type of software and the possibility of the same software being capable of both creating a database of financial information and data, and managing an investment portfolio. Had he done so, he could have found that the respective goods were identical.

40. However, even where the respective goods were not the same software, the Appellant argued that the respective goods were similar. The Hearing Officer rejected the possibility of the goods being similar, firstly by stating that the respective goods did not overlap in purpose. However, he did not expand on this conclusion, other than to say that the purpose of *“software for creating searchable databases of information and data”* was *“to create a database”*, without stating what he considered the purpose of *“computer software related to financial information, investment, and trading, namely, electronic trading software and investment portfolio management software”* and *“software for providing electronic connectivity to financial exchanges and markets”* was.

41. The Hearing Officer went on to conclude that the nature and methods of use of the respective software *“may overlap to some degree as both goods are items of software that will be used in the ordinary way”*, but he did not consider that users and trade channels would overlap. This was because he said that there was nothing before him to suggest that *“those looking to create searchable databases will also use the specific software of Fintech”*, or that *“they are provided by the same undertakings”*. As explained above, since software for creating databases or spreadsheets for use in investment portfolio management falls within *“software for creating searchable databases of information and data”*, then the purpose of creating such software is closely linked to the use of that software for investment portfolio management, and the users of such software, and the undertakings providing such software, could well be the same.

42. I therefore find that the Hearing Officer erred in not finding any similarity between *“software for creating searchable databases of information and data”* and *“computer software related to financial information, investment, and trading, namely, electronic trading software and investment portfolio management software”*.

43. The Appellant sought to rely on new evidence at the hearing before me to show that software such as Microsoft Excel is used by individual investors to monitor their own investment performance. I do not consider it necessary for me to consider this new evidence. Firstly, the Hearing Officer’s comment in his footnote in paragraph 34 of the

Decision suggested that he would have been familiar with such software, and I can take judicial notice of the existence and use of such software in the manner suggested by the Appellant. Secondly, as I explain in paragraph 50 below, it was only necessary for the Hearing Officer to have found some degree of similarity rather than having to have found that the respective software was identical.

44. The approach taken by the Hearing Officer for these goods can be contrasted with the approach he took when comparing “*software programs for spreadsheet management*”, which he found to be similar to a medium degree to the same goods from the Earlier Mark which he considered above. His reasoning was set out in paragraph 34 of the Decision. In respect of these goods, he did find some overlap in purpose when considering software relating to finance, and that the goods would be produced by the same undertakings and accessed by the same users. This was in addition to his finding that there would be some overlap in the nature and method of use on the basis that both sets of goods are items of software that will be used in the ordinary way.
45. Once he had reached those findings in respect of “*software programs for spreadsheet management*”, he should have found at least some degree of similarity for “*software for creating searchable databases of information and data*”.
46. The Appellant also argued that the Hearing Officer’s logic was also inconsistent when he considered the similarity between the goods and services of the Earlier Mark with “*telecommunication services*” in the Respondent’s Mark. In the invalidity proceedings, the Hearing Officer found as follows in paragraph 45 of the Decision:

“Class 38

Telecommunications services; provision of access to computer databases; providing access to databases on computer networks; provision of access to a worldwide computer network; providing internet chatrooms and online forums; electronic messaging services.

45. The only comments I have in respect of the goods and services comparison (aside from bare denials of similarity) from TTA come in relation to the class 38 services. In these submissions, TTA refute Fintech’s submissions that its class 38 services are complementary to Fintech’s software and financial goods and services. Insofar as it applies to the above services, I agree. I say this because I do not consider that the above services can be said to reasonably cover financial related goods or services so see no reason as to why they share any purpose with Fintech’s goods or services. Further, the above services differ in nature, method of use and trade channels with Fintech’s goods and services. In addition, I do not consider that there is any complementary or competitive relationship between the above services and the goods or services of Fintech. Lastly, given the broad user base for both parties’ goods and services, I accept that there is likely to be some overlap in user. However, this alone is not, in my view, sufficient to warrant a finding that the above services are similar to any degree with Fintech’s goods or services. They are, therefore, dissimilar.”

47. However, in the opposition proceedings, the Hearing Officer said the following in respect of his comparison of “telecommunication services” in Class 38 of the Respondent’s Mark, which had survived the invalidity attack, with the Class 9 goods in the Appellant’s Mark:

“Class 9

Computer programs [downloadable software]; computer software applications, downloadable; downloadable applications for use with mobile devices; computer software platforms, recorded or downloadable; computer programs, recorded; computer software; downloadable mobile applications computer software platforms; interactive computer software enabling exchange of information.

...

126. For the sake of completeness, I will consider the above terms of Fintech against “telecommunications services” in TTA’s specification. The above goods of TTA [sic] are not limited in any way and can, therefore, realistically be said to cover software that relates to telecommunication. As a result, it is my view that there is some degree of similarity between TTA’s services and the above services [sic] of Fintech. I appreciate that the goods and services clearly differ in nature, method of use and purpose. However, I am of the view that a user of software that relates to telecommunication is also likely to seek those telecommunication services themselves. Further, those goods and services are likely to be provided by the same undertakings. As such, I consider that these goods and services overlap in user and trade channels and, in my view, this is sufficient to warrant a finding that the goods and services are similar to a low degree.”

48. Firstly, there was no explanation from the Hearing Officer as to why, on the one hand, he found that “telecommunication services” cannot reasonably be said to cover financial related goods or services, even though those “telecommunication services” were not limited in any way, while on the other hand finding that because the Appellant’s Class 9 goods were “not limited in any way” they could “realistically be said to cover software that relates to telecommunication”. As the same logic applies to both situations, the Hearing Officer should have found that telecommunication services included telecommunication services which related to finance. He should then have considered the similarity between telecommunication services relating to finance with “software for providing electronic connectivity to financial exchanges and markets”, which was covered in Class 9 in the Earlier Mark. I agree with the Appellant that those goods could extend to telecommunications connectivity and could therefore be complementary to and share the same purpose as the Respondent’s “telecommunications services”. The same applies to the other access to database services covered by the Respondent’s Class 38 specification. The users of such finance-related telecommunication and access to database services could well be the same as the users of the financial database/spreadsheet software discussed above, and those goods and services could

come from the same undertakings, given the way in which financial transactions relating to investment portfolios are conducted electronically.

49. Again, the Appellant sought to introduce new evidence to demonstrate the close proximity of software and SaaS services in finance and investment portfolio management and telecommunications. However, I can take judicial notice of the fact that financial transactions relating to investment portfolios are conducted electronically using downloadable and non-downloadable software without the need for additional evidence demonstrating that.

Conclusion

50. I find that the Hearing Officer erred in finding no similarity between the Appellant's goods and services covered by the Earlier Mark and the terms of the Respondent's Mark which survived the invalidity attack. Had he found some degree of similarity, even if only low, he would then have concluded that there was a likelihood of confusion between the Respondent's Mark and the Earlier Mark. This is because he specifically stated in paragraph 84 of the Decision that his findings of a likelihood of indirect confusion in relation to those goods and services of the Respondent's Mark for which he had found some degree of similarity were the same even in respect of those goods or services which he had found to be only similar to a low degree. The reasoning he gave for reaching a finding of indirect confusion would apply equally to the retained goods and services.
51. I will therefore allow the appeal in respect of the invalidity action, such that the Respondent's Mark is invalid in respect of all of the goods and services covered by it.
52. Since the Respondent's Mark should have been declared invalid in its entirety, there would have been no retained goods or services left on which the Respondent could have relied on in its opposition against the Appellant's Mark.
53. Accordingly, I will also allow the appeal against the Hearing Officer's decision to partially allow the Respondent's opposition against the Appellant's Mark, which shall proceed to registration for all of the goods and services applied for.

Costs

54. The Hearing Officer found that the Appellant had achieved the greater degree of success, albeit only slightly, and awarded the Appellant its costs subject to a 30%

reduction to reflect the Respondent's success in its partial defence of the invalidity application and its success in partially opposing the Appellant's Mark. Since the appeal has been successful, the Hearing Officer's costs order should not have been subject to the 30% reduction, such that the Appellant should have been awarded costs of £1,750 in respect of the proceedings before the Hearing Officer. The Appellant is also entitled to a contribution towards its costs of the Appeal, in respect of which I will award £1,200. I therefore order the sum of £2,950 to be paid by the Respondent to the Appellant within 21 days of the date of this decision.

Simon Clark
The Appointed Person
9 October 2024

Representation:

Appellant: Matthew McAleer of Lane IP Limited

Respondent: Did not appear