

O/1087/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3843735
IN THE NAME OF SIYAD NUR
TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASS 36

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 439177
BY BFS GROUP LTD

Background and pleadings

1. On 28 October 2022, Siyad Nur applied to register the trade mark displayed on the cover page of this decision in the UK, under number 3843735 (“the applicant’s mark”). Details of the application were published for opposition purposes on 11 November 2022. Registration is sought for the following services:

Class 36: Money transfer; money transfer services; electronic transfers of money; electronic money transfer services; money exchange and transfer; national money transfer services; electronic transfer of money; money transfer services utilising electronic cards; exchanging money; money (exchanging -); money brokerage; money order services; money exchange services; fund transfers; trusteeship of money; money ordering services; money transmission services; monetary transfer; funds transfer; fund transfer; exchange services (money -); money wiring services; money lending services; money deposit services; transfer (electronic funds -); fund transfer services; money exchange agency services; money order payment guarantee services; arranging monetary transfers; electronic funds transfer; monetary transfer services; transfer of funds; currency transfer services; electronic funds transfers; funds transfer services; funds transfer (electronic -); computerised transfer of funds; electronic fund-transfer services; credit fund transfer services; exchange of money (agencies for the -); collection of money owed from settlements; electronic transfer of funds; investment of money (services for -); virtual currency transfer services; foreign currency transfer services; management of transferable securities; automated funds transfer services; electronic funds transfer services; electronic stock transfer initiation services; advisory services relating to money management; recording the transfer of securities; recording the transfer of stocks; electronic transfer of crypto assets; recording the transfer of shares; electronic funds transfer by telecommunications; electronic transfer of crypto

assets; financial services in the field of money lending; cash, check (cheque) and money order services; payment and receipt of money as agents; issuing of vouchers for use as money; rental of money counting and sorting machines; management of portfolios of transferable securities; provision of electronic funds transfer services; electronic funds transfer for travel agents; acquisition and transfer of monetary claims; electronic transfer of funds for others; investment fund transfer and transaction services; investment services relating to transferable securities; financial transfers and transactions, and payment services.

2. On 13 February 2023, BFS Group Ltd (“the opponent”) opposed the application under s.5(2)(b) of the Trade Marks Act 1994 (“the Act”).¹ The opponent relies upon the following trade marks:



(i) REWARDS REWARDS

(series of two)

UK registration no. 3338039

Filing date: 12 September 2018

Registration date: 14 December 2018

(“the opponent’s first mark”)



(ii) BOOST BOOST

(series of two)

UK registration no. 3338034

Filing date: 12 September 2018

¹ The opposition was also initially brought under s.5(4)(a) of the Act. However, the opponent withdrew reliance on this ground on 24 July 2023 when filing its evidence.

Registration date: 14 December 2018

("the opponent's second mark")



(iii)

(series of two)

UK registration no. 3338037

Filing date: 12 September 2018

Registration date: 14 December 2018

("the opponent's third mark")

3. The opponent's marks stand registered for identical services in classes 35 and 36. For the purposes of the opposition, the opponent only relies upon some of those, namely:

Class 35: Organisation, operation and supervision of sales and promotional incentive schemes.

Class 36: Issue and redemption of tokens and vouchers; discount card services; credit, debit and charge card services; information and advisory services, all relating to the aforesaid services.

4. Each of the opponent's marks qualifies as an 'earlier mark' in accordance with s.6 of the Act. As they had not been registered for five years at the filing date of the applicant's mark, they are not subject to the proof of use requirements specified in s.6A of the Act. Consequently, the opponent may rely upon all the services identified above without showing that the marks have been used.

5. In its notice of opposition, the opponent contends that the applicant's mark is similar to each of its marks and that the parties' services are identical or similar. Based upon these factors, the opponent submits that there is a likelihood of confusion, including the likelihood of association.

6. Mr Nur filed a counterstatement denying the grounds of opposition. He denies that the competing marks and the parties' services are similar. He also disputes that there is a likelihood of confusion.

7. Both parties filed evidence. A hearing was requested and held before me, by video conference, on 20 March 2024. The opponent was represented by Emma Pallister of HGF Limited. Mr Nur represented himself.²

Relevance of EU law

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, s.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.

Evidence

9. The opponent's evidence is given in the witness statement of Emma Pallister and six exhibits (EP1-EP6). Ms Pallister is a Chartered Trade Mark Attorney with the opponent's representatives. Her evidence, which results from internet research conducted on 17 July 2023, goes to the meaning of the word 'remit' and alleged overlaps between some of the parties' services.

10. Mr Nur filed evidence in the form of a witness statement and two exhibits (A-B). Through his evidence, he seeks to dismiss the relevancy of the meaning of the word 'remit'.

11. I have taken the evidence into account in reaching my decision and will refer to it below where necessary.

² Although Mr Nur attended the hearing, he also filed written submissions on 29 November 2023. I confirm that I have taken both into account.

Preliminary remarks

12. Within his counterstatement, Mr Nur submitted that he operates a payment institution, regulated by the Financial Conduct Authority, whereas the opponent is in the food sector. He also submitted that the opponent's marks are intended to be used for sales promotions and rewards. He argued that the parties are in entirely different sectors, which dispels any possibility of confusion. This line of argument was also advanced at the hearing. I also note that the opponent has provided printouts from Mr Nur's website in an attempt to show the services which he provides.³ For reasons which I will now explain, the parties' points about the actual services offered by the parties or the sectors they operate in will, as a matter of law, have no bearing on the outcome of this opposition.

13. A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered trade mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar services if there is a likelihood of confusion. Once a trade mark has been registered for five years, s.6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of services for which they are registered.

14. As outlined above, the opponent's marks had not been registered for five years at the date on which the applicant's mark was filed. Consequently, the opponent is not required to prove use for any of the services for which its marks are registered. The opponent's marks are entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of those marks for all the services listed in the register. The concept of notional use was explained by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 like this:

"22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a

³ Exhibits EP3 and EP4

case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place”.

15. So far as any use of the applicant's mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of the European Union (“CJEU”) stated (at paragraph 66 of its judgment) that, when assessing the likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, even though the parties have suggested the ways in which the mark will be used, and the services for which it will be used, my assessment later in this decision must take into account only the applied for mark – and its specification – and any potential conflict with the opponent's marks. Any differences between the actual services provided by the parties, or differences in their target sectors, are not relevant unless those differences are apparent from the applied-for and registered marks.

16. Further, I note that Mr Nur has provided a copy of the certificate of incorporation from Companies House for SAFARIREMIT LTD.⁴ Whilst this is noted, the name of this registered company will not factor into my assessment. Company names are distinct from trade marks and registering a company name does not automatically protect it under trade mark law. As explained previously, I must only take into account the applicant's mark and any potential conflict with the opponent's marks. I should add that the form in which a company name is registered does not assist in establishing how the average consumer will perceive the marks at issue.

⁴ Exhibit A

17. Moreover, Mr Nur has provided a printout from the register relating to a registration for the trade mark 'Worldremit'.⁵ It appears that Mr Nur relies on this in an attempt to demonstrate by comparison that the word element 'SafariRemit' in his mark would be seen as one word and, therefore, the meaning of the word 'Remit' in his mark is not relevant. However, comparing the applicant's mark to other marks not at issue in these proceedings is not helpful in establishing how the average consumer of the relevant services would perceive the applicant's mark. In any event, the registered mark Mr Nur refers to is also registered as one word, so the distinction he attempts to draw is not obvious. I must also clarify that the existence of other registered marks will not have any bearing on whether there exists a likelihood of confusion between the applicant's mark and the opponent's marks. This is because there is no evidence that the 'Worldremit' mark is in use and that consumers have become accustomed to differentiating between it and the opponent's marks.⁶

18. Within his written submissions, Mr Nur referred to a previous decision of this Tribunal (BL O/274/22). Whilst I note the findings of the Hearing Officer in that decision, it is well established that previous decisions are not binding on the Registrar. Each case must be assessed on its own merits.

19. Finally, at the hearing, Mr Nur raised the issue of proof of use. He submitted that, as it had now been five years since the opponent's marks were registered, the opponent should be asked to provide evidence of use. Ms Pallister responded by stating that the opponent's marks were still not subject to proof of use at the date of the hearing. I agree. As per s.6A of the Act, the proprietor of a registered mark is only required to demonstrate use of that mark if it has been registered for five years or more at the filing date (or priority date, if applicable) of the later mark. The date that the hearing takes place is irrelevant in determining whether a mark is subject to the use provisions.

⁵ Exhibit B

⁶ *Zero Industry Srl v OHIM*, Case T-400/06, paragraph 73

Section 5(2)(b) – legislation and case law

20. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

21. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

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

“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 are complementary.”

23. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ('Treat')* [1996] RPC 281 for assessing similarity were:

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

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

24. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

25. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods or services is to assess whether the relevant public are liable to believe that responsibility for the goods or services lies with the same undertaking or with economically connected undertakings.

26. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated that:

“29. In addition, the goods [or services] can be considered as identical when the goods [or services] 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 [or services] designated by the trade mark application are included in a more general category designated by the earlier mark.”

27. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J (as he then was) stated that:

"[...] 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."

28. In *Separode Trade Mark*, BL O/399/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated that:

"The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."

Issuing of vouchers for use as money

29. I agree with Ms Pallister that the above services fall within the scope of the opponent's *issue and redemption of tokens and vouchers*. These services are to be regarded as identical in accordance with *Meric*.

Money lending services; financial services in the field of money lending

30. A credit card is a payment card which allows its user to make purchases or withdraw cash on credit, accruing debt which must be repaid later. It is, essentially, a money lending service. Therefore, the applied-for services are identical to the opponent's *credit [...] card services* under the principle outlined in *Meric*. If that is not correct, it remains the case that the respective services are highly similar, given the clear overlaps in nature, purpose, trade channels and users, as well as the competition that exists between them.

Money transfer; money transfer services; electronic transfers of money; electronic money transfer services; money [...] transfer; national money transfer services; electronic transfer of money; money transfer services utilising electronic cards; fund transfers; money transmission services; monetary transfer; funds transfer; fund transfer; money wiring services; transfer (electronic funds -); fund transfer services; arranging monetary transfers; electronic funds transfer; monetary transfer services; transfer of funds; currency transfer services; electronic funds transfers; funds transfer services; funds transfer (electronic -); computerised transfer of funds; electronic fund-transfer services; credit fund transfer services; electronic transfer of funds; automated funds transfer services; electronic funds transfer services; electronic funds transfer by telecommunications; provision of electronic funds transfer services; electronic transfer of funds for others; financial transfers and transactions, and payment services; electronic funds transfer for travel agents

31. There is an overlap in nature and purpose between the above services and the opponent's *credit, debit and charge card services* insofar as they are all financial and, more specifically, involve the transfer of money. The respective services are likely to reach the market through the same trade channels and target the same users. They may also be provided by the same undertakings; for instance, financial institutions such as high street banks and credit card companies are likely to provide both credit card services as well as the transfer of funds. There is evidence from two major UK banks which supports my own impression of this.⁷ There is also a degree of

⁷ Exhibits EP5 and EP6

complementarity between the respective services. This is because the transfer of funds is important to the provision of the opponent's services and consumers are likely to believe that responsibility for them lies with the same undertaking. In light of all this, I find that there is between a medium and high degree of similarity between the respective services.

Money deposit services

32. It is my understanding that these services allow individuals to deposit money into a bank account. There is an overlap in nature and purpose with the opponent's *credit, debit and charge card services* in that debit card services operate on the basis of funds being added into an account so that the card may be used for purchases. The respective services share users. They are likely to reach the market through shared trade channels and may be provided by the same undertakings. For example, it is not uncommon for financial institutions such as banks to offer money deposit and debit card services. There is a degree of complementarity between the respective services since the depositing of money is important to the operation of debit card services, and consumers are likely to believe that responsibility for both lies with the same undertakings. Taking all the above into account, I find that there is between a medium and high degree of similarity between the respective services.

Money order services; money ordering services; cash, check (cheque) and money order services; money order payment guarantee services

33. In the absence of any evidence or submissions explaining the meaning of these terms, it is my understanding that a money order is a means by which you can send money, as an alternative to cash or cheques. There is an overlap in nature and purpose with the opponent's *credit, debit and charge card services* insofar as they are financial services relating to payments. Users overlap and, given the same financial institutions are likely to provide both, there is also an overlap in trade channels. The respective services are not important to one another and, as such, they are not complementary. There is a degree of competition between them in that a consumer may use their debit or credit card to make a payment (for, for instance, a household

bill) or, instead, do so by money order. All in all, I find that there is a medium degree of similarity between the respective services.

Advisory services relating to money management

34. These services and the opponent's *credit, debit and charge card services* are likely to share users. Further, financial institutions such as banks and credit card companies are likely to offer advice to their customers regarding the management of their money as well as credit and debit card services. Therefore, there is an overlap in trade channels. Balancing these similarities against the differences in nature and purpose, as well as there being no competition or complementarity between them, I find that the respective services are similar to between a low and medium degree.

Money exchange [...]; exchanging money; money (exchanging -); money exchange services; exchange services (money -); money exchange agency services; exchange of money (agencies for the -); foreign currency transfer services

35. There being no evidence on the point, it is my understanding that the above services all relate to the changing of money from one currency to another. Although they are broadly financial, the nature, purpose and method of use of these services and *credit, debit and charge card services* are different. However, in my experience, it is not uncommon for the same financial institutions to offer the opponent's services as well as money exchanging services. Therefore, there is an overlap in trade channels. Users are also likely to overlap. In certain circumstances, there is also an element of competition between them. This is because a consumer may decide to exchange currency over using their debit or credit card for purchases abroad, or vice versa. In light of all this, I find that there is a low degree of similarity between the respective services.

Investment of money (services for -); management of transferable securities; electronic stock transfer initiation services; recording the transfer of securities; recording the transfer of stocks; recording the transfer of shares; management of portfolios of transferable securities; investment fund transfer and transaction services; investment services relating to transferable securities; virtual currency transfer

services; electronic transfer of crypto assets; electronic transfer of crypto assets; collection of money owed from settlements; acquisition and transfer of monetary claims; payment and receipt of money as agents

36. Although these services and the opponent's *credit, debit and charge card services* coincide in that they are financial services, the nature and purpose of the respective services differ. However, there may be a general overlap in user. Further, the same financial institutions which offer the opponent's services may also offer the applicant's services, meaning that the respective services reach the market through overlapping trade channels. There is no competition between the respective services and they are not complementary. In light of this, I find that the respective services are similar to a low degree.

Money brokerage

37. A money broker is defined as meaning a person or organisation that arranges the lending and borrowing of money between banks or other financial organisations.⁸ Aside from being broadly financial, there is no overlap in nature or intended purpose with the opponent's *credit, debit and charge card services*. There is no evidence that such services are typically provided to the general public, or other businesses that may utilise credit or debit accounts. In the absence of such evidence, it is my view that the respective services have different users and reach the market through different trade channels. The respective services are not in competition. Further, they are not important to one another in such a way that they can be said to be complementary. It is my view that the respective services being financial in nature is not sufficient to give rise to any material similarity between them. Overall, I find that they are dissimilar.

Trusteeship of money

38. A trustee is defined as a person, often one of a group, who controls money for another person or an organisation.⁹ The nature and purpose of holding money on trust

⁸ <https://dictionary.cambridge.org/dictionary/english/money-broker>

⁹ <https://dictionary.cambridge.org/dictionary/english/trustee>

as a service is different from the opponent's *credit, debit and charge card services*. Users may overlap, in a general sense, but there is no evidence that the same financial institutions which offer the opponent's services also offer trusteeship services. Given their expertise in financial matters, it is certainly possible. However, without any evidence of this, I am unable to conclude that it is typical in trade. There is no competition between the respective services and they are not complementary in the sense outlined in the authorities. Taking all of this into account, I find that there is no similarity between the respective services.

Rental of money counting and sorting machines

39. The above services and the opponent's *credit, debit and charge card services* have different natures, purposes and methods of use. There is no evidence which demonstrates that the respective services are offered by the same undertakings. It is my impression that they are provided by distinct undertakings through different trade channels. It is possible that users may overlap insofar as some members of the general public or business owners may use both. However, they are likely to be more commonly provided to different users. The applicant's services are likely to target financial institutions and other organisations which handle large amounts of money. These are unlikely to be the typical user of the opponent's services. The respective services are not in competition. Moreover, I do not consider them to be important to one another in such a way that they are complementary. Overall, notwithstanding the limited overlap in user, I find that the respective services are dissimilar.

40. I have considered the other services relied upon by the opponent but none improves its position.

41. Some degree of similarity between services is necessary to engage the test for likelihood of confusion; if there is no similarity at all, there is no likelihood of confusion to be considered under s.5(2)(b).¹⁰ My findings above mean that the opposition must fail in respect of the following services:

¹⁰ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

Class 36: Money brokerage; trusteeship of money; rental of money counting and sorting machines.

The average consumer and the nature of the purchasing act

42. As the case law indicates, I must determine who the average consumer is for the parties' services and the manner in which they are likely to select those services. The average consumer has been described in the following terms:¹¹

“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 [...] 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

43. The average consumer of the services which I have found to be identical or similar may be a member of the general public or a business user. The frequency with which the services are purchased is likely to vary. For example, debit card services and money transfer services may be purchased relatively frequently, whereas management of financial portfolios may be purchased less frequently. On the whole, I do not consider the services to be extremely expensive. However, none of the services are casual purchases, given that they are all financial in nature. The average consumer is likely to consider factors such as the reputation of the provider, exchange rates, charge rates, security and efficiency when making a selection. In my view, the average consumer is likely to demonstrate at least a medium level of attention. When purchasing services relating to investments, the average consumer may exhibit a slightly higher level of attention since they may be opening themselves up to financial losses. Business users are also likely to pay a slightly higher level of attention because they will recognise that the selection may be important to the success of their business.

¹¹ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), paragraph 60

The services are likely to be purchased direct from the provider (mainly banks and other financial institutions) after being presented to the average consumer in advertising, on websites, or in physical premises where information will be displayed in brochures, pamphlets or on signage. Therefore, I find that the purchasing process is predominantly visual in nature. However, I do not discount an aural element to the purchasing process as the average consumer may receive verbal recommendations or wish to discuss the services with the provider.

Distinctive character of the earlier marks

44. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

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

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

45. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the

services, to those with high inherent distinctive character, such as invented words. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

46. Although the distinctive character of a mark may be enhanced as a result of it having been used in the market, the opponent has not filed any evidence of use. As such, I have only the inherent position to consider.

47. The opponent's first mark is figurative and consists of the words 'safari REWARDS'. The former is much larger than the latter. The words are presented in an unremarkable font. Each letter in the word 'safari' is presented in a different colour/shade of grey, whereas the word 'REWARDS' is presented in black or dark grey. The word 'safari' will be understood by consumers in accordance with its ordinary dictionary meaning, i.e. an organised journey to look at wild animals. It is not descriptive or allusive of the services relied upon. The word 'REWARDS' will be understood by consumers as money or other advantages that are given for something. It is allusive (if not descriptive) of the services relied upon. It is my view that the distinctive character of the opponent's first mark predominantly lies in the word 'safari'. The word 'REWARDS', the font and the colours/shades also contribute to the distinctiveness of the mark, but to a lesser extent. Overall, I find that the opponent's first mark has a medium level of inherent distinctive character.

48. The opponent's second mark is figurative and comprises the words 'safari BOOST'. The word 'safari' is presented in orange/grey on a white background and is the largest element. The word 'BOOST' is presented in white on an orange/grey background device. It is underneath the word 'safari' and much smaller by comparison. The words are presented in a basic font. Again, the word 'safari' will be understood in accordance with its ordinary meaning. It has no descriptive or allusive qualities. The word 'BOOST' will be perceived as meaning an increase or improvement of something. It is allusive of the services relied upon. It is considered that the word 'safari' provides the biggest contribution to the distinctiveness of the mark. The word 'BOOST', the font and the colours also contribute but to a lesser extent. I find that the opponent's second mark possesses a medium level of inherent distinctive character.

49. The opponent's third mark is figurative and consists of the words 'safari XTRA' in a standard font. The word 'safari' is the largest and is presented in blue/grey on a white background. The word 'XTRA' is much smaller and is presented in white on a blue/grey background device. Again, the word 'safari' will be understood in accordance with its ordinary meaning. It has no descriptive or allusive qualities. The word 'XTRA' is likely to be seen as an informal spelling of the word extra, meaning something above what is normal. It is allusive of the services. To my mind, the word 'safari' provides the largest contribution to the distinctiveness of the mark. The word 'XTRA', the font and colour also contribute but to a lesser extent. I find that the opponent's third mark enjoys a medium level of inherent distinctive character.



Comparison of trade marks

50. It is clear from *Sabel* 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 *Bimbo* 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.”

51. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

52. The competing marks are as follows:

The opponent's marks	The applicant's mark
	

Overall impressions

53. The opponent's marks are all figurative and comprise the word 'safari' in addition to the words 'REWARDS', 'BOOST' and 'XTRA'. The word 'safari' dominates the overall impression of all the marks. This is because it is the largest and most distinctive element. The other words in the marks are much smaller, less distinctive and play lesser roles. The font and colours/shades are likely to be seen as decorative and play much lesser roles in the overall impression.

54. The applicant's mark is figurative and comprises the word 'SafariRemit' in a dark blue, basic font, as well as two arrow devices. Although the device appears at the beginning of the mark, a position which tends to have most impact,¹² the eye is naturally drawn to elements of marks which can be read.¹³ As such, it is my view that the word element dominates the overall impression of the mark. Mr Nur argues that this would be seen as one word. I disagree. Although consumers normally perceive a trade mark as a whole, they will break the mark down into verbal elements which

¹² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

¹³ *Wassen International Ltd v OHIM*, Case T-312/03

suggest a concrete meaning or resemble words known to them.¹⁴ Both 'Safari' and 'Remit' are ordinary, easily recognisable words. There is also a natural break between them created by the different use of capitalisation. It is my view that the word element will be seen as consisting of two words, i.e. 'Safari Remit'. Of the two, the word 'Safari' is most dominant. This is because, unlike the word 'Remit', it does not describe or allude to the services. The device, whilst still contributing, plays a lesser role. The font and colours play a much lesser role.

Visual comparison

55. The competing marks are all visually similar because they share the word 'safari'/'Safari'. This word dominates the overall impressions of the opponent's marks and is the most dominant element in the applicant's mark. The competing marks are visually different in that the opponent's marks contain additional words which are not present in the applicant's mark, and vice versa. Moreover, the applicant's mark contains a device, which is not replicated in the opponent's marks. Finally, the competing marks diverge in their presentation, namely the different use of colour/shades and font. Bearing in mind my assessment of the overall impressions, I find that there is between a low and medium degree of visual similarity between the competing marks.

Aural comparison

56. All the words in the competing marks will be given their ordinary English pronunciations. The word 'XTRA' will be articulated as the word 'EXTRA'. Neither the device in the applicant's mark nor the stylisation in the competing marks has any impact on the way in which the marks will be pronounced. The competing marks all share the three syllables of the dominant word 'safari'/'Safari'. The words 'REWARDS', 'BOOST', 'EXTRA' in the opponent's marks, respectively, and the word 'REMIT' in the applicant's mark constitute points of aural difference. Overall, I find that there is a medium degree of aural similarity between the competing marks.

¹⁴ *Usinor SA v OHIM*, Case T-189/05

Conceptual comparison

57. The word 'safari'/'Safari' will be understood as an organised journey to look at wild animals. This word is present in both parties' marks and dominates the respective overall impressions. The word 'REWARDS' in the opponent's first mark will be understood as meaning money or other advantages that are given for something; the word 'BOOST' in the opponent's second mark will be understood as meaning an increase or improvement of something; and the word 'XTRA' in the opponent's third mark will be seen as an informal spelling of the word extra, meaning something above what is normal. These words are likely to be perceived as alluding, if not describing, a feature of the services offered under the opponent's marks. The opponent has provided printouts from Collins Dictionary and Cambridge Dictionary which define the word 'Remit' as meaning to send money to someone.¹⁵ Although the word has several other meanings, it is my view that, in the context of the services at issue, the word in the applicant's mark is most likely to bring this meaning to mind. This is descriptive of the applied-for services. The device in the applicant's mark is likely to be seen as representing two arrows. This reinforces the meaning of the word 'Remit' in that the arrows are likely to be seen as representing the directions of transfer. The competing marks coincide in the meaning of the word 'safari'/'Safari' and differ in all other respects. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of conceptual similarity between the competing marks.

Likelihood of confusion

58. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's marks, the average consumer for the services and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to

¹⁵ Exhibits EP1 and EP2

make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

59. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related.

60. Earlier in this decision, I concluded that:

- The parties' services are identical or similar to at least a low degree.
- The average consumer may be a member of the general public or a business user, who will demonstrate at least a medium level of attention (which may be higher for some services and in respect of business users).
- The purchasing process is predominantly visual in nature, though aural considerations have not been discounted.
- The opponent's marks possess a medium level of inherent distinctive character.
- The overall impressions of the opponent's marks are dominated by the word 'safari', whilst the words 'REWARDS', 'BOOST' and 'XTRA', the font and colours/shades play lesser roles.
- The overall impression of the applicant's mark is dominated by the word 'Safari', whilst the word 'Remit', the device, font and colours play lesser roles.
- The competing marks are visually similar to a between a low and medium degree, and aurally and conceptually similar to a medium degree.

61. The competing marks coincide in their shared use of the word 'safari'/'Safari'. This is the most dominant element in the opponent's marks and the applicant's marks. However, the applicant's mark contains elements which are not present in the opponent's marks and vice versa. Although they play lesser roles in the respective overall impressions, they are not negligible and are unlikely to be overlooked by the average consumer. Taking all of the above factors into account, it is my view that the differences between the competing marks are likely to be sufficient for the average consumer, even when paying no more than a medium level of attention, to distinguish between them and avoid mistaking them for one another. Accordingly, notwithstanding the imperfect recollection of the average consumer and the interdependency principle, I find that there is no likelihood of direct confusion, even in respect of identical services.

62. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr 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 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).”

63. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.¹⁶

64. I recognise that indirect confusion has its limits and that such a finding should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark.¹⁷ It has also been emphasised that, where there is no direct confusion, there must be a proper basis for finding indirect confusion.¹⁸ Whilst the average consumer is likely to notice and recall the differences between the competing marks, they will also identify the identical word ‘safari’/‘Safari’. This element dominates the overall impressions of the opponent’s marks and the applicant’s mark. Although, being an ordinary dictionary word, it is not so distinctive that the average consumer will assume that only the opponent would be using it in a trade mark, it is my view that the differences between the competing marks may be seen as sub-brands used by economically linked undertakings. This is because the different words which are added to the common element, namely ‘REWARDS’, ‘BOOST’, ‘XTRA’ and ‘Remit’, are descriptive or allusive

¹⁶ As was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 12.

¹⁷ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

¹⁸ See the Court of Appeal’s comments in *Liverpool Gin Distillery*, paragraph 13.

of the services at issue. The use of these different words may be seen by the average consumer as denoting particular parts of the 'safari'/'Safari' service offering. For instance, the applicant's mark may be seen as the part which deals with transferring payments, the opponent's first mark the part which offers rewards for using the services, and the opponent's second and third marks the parts which offer something over and above the ordinary services. The difference between the fonts is likely to go unnoticed. The different colours and the inclusion of the device in the applicant's mark (which reinforces the descriptive meaning of the word 'Remit') are likely to be seen as indicative of alternate brands using different decorative elements. Taking all of the above into account, I am satisfied that the average consumer, even paying a higher level of attention, is likely to assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the identical word 'safari'/'Safari'. Consequently, I find that there is a likelihood of indirect confusion, even in relation to services which are only similar to a low degree.

Conclusion

65. The opponent's claim under s.5(2)(b) has been partially successful. Subject to a successful appeal against this decision, the applicant's mark will be refused in respect of the following services:

Class 36: Money transfer; money transfer services; electronic transfers of money; electronic money transfer services; money exchange and transfer; national money transfer services; electronic transfer of money; money transfer services utilising electronic cards; exchanging money; money (exchanging -); money order services; money exchange services; fund transfers; money ordering services; money transmission services; monetary transfer; funds transfer; fund transfer; exchange services (money -); money wiring services; money lending services; money deposit services; transfer (electronic funds -); fund transfer services; money exchange agency services; money order payment guarantee services; arranging monetary transfers; electronic funds transfer; monetary transfer services; transfer of funds; currency transfer

services; electronic funds transfers; funds transfer services; funds transfer (electronic -); computerised transfer of funds; electronic fund-transfer services; credit fund transfer services; exchange of money (agencies for the -); collection of money owed from settlements; electronic transfer of funds; investment of money (services for -); virtual currency transfer services; foreign currency transfer services; management of transferable securities; automated funds transfer services; electronic funds transfer services; electronic stock transfer initiation services; advisory services relating to money management; recording the transfer of securities; recording the transfer of stocks; electronic transfer of crypto assets; recording the transfer of shares; electronic funds transfer by telecommunications; electronic transfer of crypto assets; financial services in the field of money lending; cash, check (cheque) and money order services; payment and receipt of money as agents; issuing of vouchers for use as money; management of portfolios of transferable securities; provision of electronic funds transfer services; electronic funds transfer for travel agents; acquisition and transfer of monetary claims; electronic transfer of funds for others; investment fund transfer and transaction services; investment services relating to transferable securities; financial transfers and transactions, and payment services.

66. The applicant's mark may proceed to registration in the UK for the following services, against which the opposition has failed:

Class 36: Money brokerage; trusteeship of money; rental of money counting and sorting machines.

Costs

67. Both parties have succeeded in part. However, the opponent has clearly enjoyed the greater measure of success. As such, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023, with an

appropriate reduction to reflect Mr Nur's degree of success. In the circumstances, I award the opponent costs on the following basis:

Preparing a statement and considering Mr Nur's counterstatement	£285
Preparing evidence and considering Mr Nur's evidence	£570
Preparing for and attending a hearing	£475
Official fees ¹⁹	£100
Total	£1,430

68. I order Siyad Nur to pay BFS Group Ltd the sum of £1,430. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 15th day of November 2024

James Hopkins
For the Registrar

¹⁹ Although the opponent paid £200 in official fees for the filing of its Form TM7, this was based on it raising grounds under ss.5(2)(b) and 5(4)(a) of the Act. As it later withdrew its claim under s.5(4)(a), I consider it appropriate to only award it costs in respect of its claim under s.5(2)(b).