

O/1178/24

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO. 3858549
IN THE NAME OF AAO HOLDINGS LIMITED
IN RESPECT OF THE SERIES OF TWO TRADE MARKS



&



IN CLASSES 36 & 42

AND

THE CONSOLIDATED OPPOSITIONS THERETO UNDER NOS. 441190 & 441192
BY 21SHARES AG & AMUN HOLDINGS LTD

Background and pleadings

1. AAO Holdings Limited (“the applicant”) applied to register the series of two trade marks shown on the cover page of this decision in the UK on 12 December 2022. The application was accepted and published in the Trade Marks Journal on 3 March 2023 in respect of the following services:

Class 36: Financial, monetary and banking services; financial transaction and payment services; electronic funds transfer; providing secure payments for commercial transactions; money exchange; bank card, credit card, debit card and electronic payment card services; processing of credit card and debit card payments; current account services; virtual currency services; financial evaluation; financial analysis; financial management; advice, information and consultancy services for all of the aforesaid services: none of the aforesaid services relating to the establishment or exploitation or valuation of Intellectual Property assets.

Class 42: Software as a service (SaaS); software as a service (SaaS) for processing electronic payments and financial transactions; design and development of computer hardware and software; Providing temporary use of on-line non-downloadable software for processing electronic payments; advice, information and consultancy services for all of the aforesaid services; none of the aforesaid services relating to the establishment or exploitation or valuation of Intellectual Property assets.

2. On 5 June 2023, 21Shares AG filed an opposition against the above application. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition relies upon its earlier International Registration no. 1556929 for the mark detailed below, for goods and services in classes 9, 35, 36 & 42 as set out at Annex A to this decision:

21Shares

International Registration date: 12 August 2020

Designation date in the UK: 12 August 2020

Date UK protection was granted: 12 February 2021

3. By virtue of its earlier designation date of 12 August 2020, this mark constitutes an earlier mark in accordance with section 6 of the Act. As protection for this mark was granted less than five years prior to the filing date of the opposed application, it is not yet subject to use provisions in accordance with section 6A of the Act.

4. Also on 5 June 2023, Amun Holdings Ltd filed an opposition against the same application. This second opposition is also based on section 5(2)(b) of the Act. This opposition relies on UK registration no. 3815470 for the goods and services in classes 9, 35, 36 & 42 as set out at Annex B to this decision, for the mark below:



Filing date: 1 August 2022

Registration date: 4 November 2022

5. By virtue of its earlier filing date of 1 August 2022, the above mark constitutes an earlier mark in accordance with section 6 of the Act. As the above mark had been registered for a period of less than five years at the filing date of the opposed application, it is not yet subject to use provisions in accordance with section 6A of the Act.

6. Together, 21Shares AG and Amun Holdings Ltd are hereinafter referred to as “the opponents”.

7. In both oppositions, the opponents argue that the respective goods and services are identical or similar and that the marks are similar, and that as such the application should be refused in accordance with section 5(2)(b) of the Act.¹

8. In both oppositions, the applicant filed a counterstatement denying any similarity between the marks or the goods and services and denying any likelihood of confusion.

9. On 10 October 2023, the representative for the opponents wrote to the Tribunal explaining that the opponents are associated companies and requesting that the proceedings be consolidated. On 24 October 2023, the Tribunal wrote to the parties directing that, provided the opponents agree to be jointly and severally liable for any costs should they be unsuccessful, then the Tribunal would direct that the proceedings be consolidated in accordance with Rule 62(g) of the Act. The representative for the opponent wrote back to the Tribunal on 25 October 2023 agreeing to this, and on the 30 October 2023, the Tribunal wrote to the parties directing the consolidation of the proceedings. The two oppositions proceeded as one matter from that point onwards.

10. Neither side filed evidence in these proceedings, and neither side filed written submissions. No hearing was requested and so this decision is taken following a careful perusal of the papers.

11. Both sides are represented in these proceedings. The applicant is represented by Marks & Clerk LLP. The opponents are represented by Osborne Clarke LLP.

12. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Decision

Section 5(2)(b)

¹ Both oppositions originally also relied upon sections 5(3) and 5(4)(a) of the Act, but these grounds were deemed withdrawn when no evidence was filed in these proceedings.

13. Section 5(2)(b) of the Act is 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”.

14. Section 5A of the Act reads:

“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.”

15. 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.

The principles

(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 goods and services

16. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

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

18. 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. 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."

19. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("GC") stated that there is complementarity where:

"...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".

20. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark". With that in mind, the goods and services for comparison under this ground are as follows:

21. With the above in mind, the goods and services for comparison are as follows:

Earlier goods and services	Contested services
<p>International Registration no. 1556929</p> <p>Class 9: downloadable software and mobile applications for use in electronic commerce (e-commerce) with and for storing, sending, receiving, accepting and transmitting digital currency and managing digital currency payment and exchange transactions (see Annex A for remaining class 9 goods)</p> <p>Class 35: See Annex A</p> <p>Class 36: Financial services, namely, the offer and management of mutual investment funds; financial services, namely, investment management, financial planning services, investment transactions relating to funds, transferable securities brokerage and providing financial information, by electronic means; advisory services in investment and services relating thereto in the field of cryptocurrency, namely, advice on investments in cryptocurrency; investment management services and financial advice in the field of cryptocurrency; financial risk management; intermediation in investment funds; investment services for investment funds; financial investment services in the field of open-ended investment funds; management of financial assets; evaluation of financial assets; investment services, namely, management and brokerage in the field of cryptocurrency and investment transactions for others; investment consultancy; research on financial investments; tax assessments and advice; financial management of investment funds and investment companies; financial research; preparation of financial</p>	<p>Class 36: Financial, monetary and banking services; financial transaction and payment services; electronic funds transfer; providing secure payments for commercial transactions; money exchange; bank card, credit card, debit card and electronic payment card services; processing of credit card and debit card payments; current account services; virtual currency services; financial evaluation; financial analysis; financial management; advice, information and consultancy services for all of the aforesaid services: none of the aforesaid services relating to the establishment or exploitation or valuation of Intellectual Property assets.</p> <p>Class 42: Software as a service (SaaS); software as a service (SaaS) for processing electronic payments and financial transactions; design and development of computer hardware and software; Providing temporary use of on-line non-downloadable software for processing electronic payments; advice, information and consultancy services for all of the aforesaid services; none of the aforesaid services relating to the establishment or exploitation or valuation of Intellectual Property assets.</p>

reports for others and financial analysis related thereto; providing financial information on investment possibilities and financial analysis; online financial services, namely, transfer and transaction of investment funds, financial planning and financial research; provision of financial and investment services, namely, financial information based on different asset class indices; financial management and investment services in relation to transferable securities; advisory services with respect to finances and investment; rating services in connection with the financial performance of securities and investments and the provision of credit rating services; analysis of financial data and stock exchange research; exchanging money; foreign-exchange transactions online and in real time; cash management services, especially facilitating the transfer of electronic currency equivalents; digital money exchanging services for transferable equivalent units of electronic currency having a given current value; providing and updating a financial index; provision of financial indices in the nature of quantitative measurements for evaluating investments, market trends and financial instruments; providing financial indices based on selected groups of securities; providing and updating financial indices for securities.

Class 42: Providing temporary use of non-downloadable software, web applications and software platforms in the field of financial services, namely, providing non-downloadable software for the collection, analysis, organization, storage and transmission of data and information in the fields of asset management, financial information, financial administration, trading in transferable securities and investment management; providing temporary use of non-

downloadable software for electronic commerce (e-commerce) with and for storing, sending, receiving, accepting and transmitting encrypted currency and for managing digital currency payment and exchange transactions.

UK registration no. 3815470

Class 9: software relating to electronic funds transfer (See Annex A for remaining goods)

Class 35: See Annex A

Class 36: Financial services, namely, offering and managing mutual funds; financial services, namely, investment management, financial planning services, fund investment services, brokerage services and providing financial information by electronic means; investment advisory services in the field of cryptocurrency, namely advice on investments in cryptocurrency; investment management and financial advice in the field of cryptocurrency; financial risk management; brokerage of investment funds; investment services for investment funds; distribution of investment funds; management of financial assets; valuation of financial assets; investment services, namely, management and brokerage in the field of cryptocurrency and investment business for others; investment advice; financial investment research; financial management of mutual fund investment trusts; financial research; preparation of financial reports for others and related financial analysis; provision of financial information on investment opportunities and financial analysis; online financial services, namely mutual fund transfer and transaction services, financial planning and financial research; provision of financial and investment services, namely financial information based on various asset class indices; financial

services, namely, offering, operating and managing the issuance, subscription and distribution of securities products traded on a stock exchange, namely cryptocurrencies; financial and investment advisory services; rating services relating to the financial performance of securities and investments and provision of credit rating services; financial data analysis and stock research; currency exchange services; online real-time currency trading; cash management, namely, facilitating the transfer of electronic money equivalents; digital currency exchange transaction services for transferable electronic money equivalents with a certain cash value; providing information and analysis of economic market data for financial purposes; provision of a financial index; providing financial indices in the nature of quantitative measurements for evaluating investments, market trends and financial instruments; provision of financial indices based on selected groups of securities; provision of financial indices for securities stocks; financial exchange and administration of crypto assets.

Class 42: Providing temporary use of non-downloadable software for trading in crypto assets; providing temporary use of non-downloadable software for blockchain transactions; providing temporary use of non-downloadable software for the issuance of digital tokens; software as a service; platform as a service; providing temporary use of online non-downloadable software for use in electronically trading, storing, sending, receiving, accepting and transmitting digital currency, and managing digital currency payment and exchange transactions.

22. The contested services in classes 36 and 42 both include the limitation “*none of the aforesaid services relating to the establishment or exploitation or valuation of Intellectual Property assets*”. None of the earlier services appear to relate to specifically to these types of services, and as such I find this limitation will have little bearing on the comparison I am to make. I therefore do not intend to mention this limitation when conducting my comparison of the goods and services below, however, its impact on the scope of the applicant’s protection will nonetheless be borne in mind when completing the same.

Class 36

23. The contested services include *financial, monetary and banking services* in class 36. These include a wide range of services, including a number of the earlier services such as *financial services, namely, investment management, financial planning services, investment transactions relating to funds, transferable securities brokerage and providing financial information, by electronic means* covered by the earlier International Registration and *financial services, namely, investment management, financial planning services, fund investment services, brokerage services and providing financial information by electronic means* covered by the earlier UK registration. I therefore find these services to be identical in accordance with the principles set out in *Meric*.

24. The contested services include *financial transaction and payment services; electronic funds transfer and providing secure payments for commercial transactions*. The earlier services include *online financial services, namely, transfer and transaction of investment funds* as covered by the International Registration and *online financial services, namely mutual fund transfer and transaction services* as covered by the earlier UK registration. It is my view that the earlier services will be covered by the contested services outlined, and as such they are identical in accordance with the principles set out in *Meric*. However, if I am wrong, I consider they are all financial services concerning transfers and transactions, and it is my view that the nature, broad purpose, method of use and trade channels are all likely to be shared. I therefore consider the services similar to at least a medium degree.

25. The contested services include *money exchange*. The earlier services include *exchanging money* under the earlier International Registration. These are self-evidently identical. The earlier UK registration covers *currency exchange services*. It is my view these will be covered by the contested services *money exchange* and as such they are identical in accordance with the principles set out in *Meric*.

26. The contested services include *financial evaluation* and *financial analysis*. The earlier services under the earlier International Registration include *evaluation of financial assets* as well as *preparation of financial reports for others and financial analysis related thereto* and *providing financial information on investment possibilities and financial analysis*. It is my view that these services are identical, either self-evidently, or in accordance with the principles set out in *Meric*. The earlier UK registration also includes the services *preparation of financial reports for others and related financial analysis; provision of financial information on investment opportunities and financial analysis*. Again, I consider the contested services identical to the earlier services. However, if I am wrong to find the services for financial analysis identical to the contested financial evaluation services, I nonetheless find they will likely share a purpose (to examine the state of a person or entities finances), will share a very similar nature, and are likely to be offered by the same entities and thus share trade channels. There may be an element of competition between the services, with consumers choosing between services offering a financial evaluation or a financial analysis of their accounts for example, and if I am to take the services as not being identical, then I consider there may be a level of complementarity between the same, with the more in depth financial analysis being important to the offering of a financial evaluation service, to the extent the consumer is likely to believe they derive from the same entity. If I am wrong to find identity between the services, I consider these services similar to a high degree.

27. The contested services include *financial management*. It is my view these services are identical to the earlier *management of financial assets* covered by both earlier marks in accordance with the principles set out in *Meric*.

28. The contested services include *virtual currency services*. Virtual currency will include cryptocurrency. It is my view these services are identical to the earlier *investment management services and financial advice in the field of cryptocurrency*

covered by the earlier International Registration and *investment services, namely, management and brokerage in the field of cryptocurrency* covered by the earlier UK registration, in accordance with the principles set out in *Meric*.

29. The contested services include *current account services*. The earlier services cover a wide range of financial services, but it is my view that none of these are current account services as such. However I note, for example, that the earlier services include those such as *financial services, namely, investment management, financial planning services, investment transactions relating to funds, transferable securities brokerage and providing financial information, by electronic means* under the earlier International Registration and *financial services, namely, investment management, financial planning services, fund investment services, brokerage services and providing financial information by electronic means* covered by the earlier UK registration. Whilst the specific purpose of these services differs, they all have the same broad purpose of assisting consumers with managing their finances. Further, I consider they will often share trade channels, including for example, banks, who may offer these types of services alongside their current account services. They will share users to the extent they may all be used by both businesses and the general public, but I do not consider they will be complementary or in competition. However, overall, I consider these services to be similar to at least a low degree.

30. The contested services include *bank card, credit card, debit card and electronic payment card services; processing of credit card and debit card payments*. Again, I do not consider these to be covered as such by the earlier specifications. However, again I consider that the earlier services include a wide range of financial services, including *financial services, namely, investment management, financial planning services, investment transactions relating to funds, transferable securities brokerage and providing financial information, by electronic means* under the earlier International Registration and *financial services, namely, investment management, financial planning services, fund investment services, brokerage services and providing financial information by electronic means* covered by the earlier UK registration. It is my view that these services will share trade channels with the contested card payment services, namely banks, and also share users at a general level, either being business users or the general public. The specific purpose and nature will differ, although they

all broadly relate to the managing of consumers finances. Overall, I consider these to be similar to at least a low degree.

31. The contested services include *advice, information and consultancy services for all of the aforesaid services*. This relates to all of the contested class 36 services filed. The earlier services include *financial services, namely, [...] providing financial information, by electronic means* under the earlier International Registration and *financial and investment advisory services* under the earlier UK registration. It is my view that these general financial advice and information services will be identical to the contested services for advice, information and consultancy services in relation to the contested class 36 services outlined. However, if I am wrong in this finding, it is in any case my view that where the contested advice, information and consultancy services is in relation to those services I have found to be identical to the earlier services, these will also be at least similar to a medium degree. Whilst the nature of the services will differ, they will likely to be provided by the same entities as those providing the earlier services that were compared to the terms they relate to, they will to an extent share a broad purpose, and trade channels. In many cases they are also likely to be complementary, with the earlier services at least being important to the contested services. Where these relate to services for which at least a low degree of similarity has been found, I also find these to be similar to the compared earlier services to a low degree, due to the shared trade channels, consumers and similar general purpose of the same.

Class 42

32. The contested services include *software as a service (SaaS); software as a service (SaaS) for processing electronic payments and financial transactions; and providing temporary use of on-line non-downloadable software for processing electronic payments*. These are all identical, either self-evidently, or in accordance with the principles set out in *Meric*, to the broad term *software as a service* covered by the earlier UK application. Further, the contested *software as a service (SaaS)* is identical to the more specific *providing temporary use of non-downloadable software for electronic commerce (e-commerce) with and for storing, sending, receiving, accepting and transmitting encrypted currency and for managing digital currency payment and*

exchange transactions covered by the earlier International Registration, in accordance with the principles set out in Meric. In addition, I consider the terms '*financial transactions*' and '*electronic payments*' in the contested services outlined will include transactions and payments involving digital currency. I therefore also find the services *software as a service (SaaS) for processing electronic payments and financial transactions*; and *providing temporary use of on-line non-downloadable software for processing electronic payments* to be identical to the more specific services as set out under the earlier International Registration as outlined.

33. Where they relate to the identical services identified above, I consider that the contested services *advice, information and consultancy services for all of the aforesaid services* will be complementary to the earlier services, in the sense that the services are at least important to the advice, information and consultancy services in respect of the same, and the consumer is likely to consider they will be offered by the same entities. I also consider there will be shared trade channels and users, although the nature, specific purpose and method of use may differ, and they are unlikely to be in competition. I therefore consider these services to be similar to the earlier services to a medium degree.

34. The contested services include the *design and development of computer software*. I consider that entities offering computer software goods such as those covered in class 9 under both the earlier International Registration and the UK registration, are likely to also be engaged in the services for the design and development of computer software. For example, where the software goods in class 9 are offered to business users, services for tweaks or developments to the design of the product may be offered as required to fit with a particular businesses preference or need. It is my view there will therefore be a level of complementarity between these goods and services, in the sense that the services are at least important to the goods and vice versa, and the consumer is likely to believe they will be offered by the same entities. It is possible there may also be a level of competition between the goods and services, with businesses choosing to purchase a readymade software product to roll out to consumers, or to engage an entity to design and develop a bespoke product. However, the nature and method of use will differ. Overall, I consider these goods and services similar to a medium degree. I also note the contested *advice, information and*

consultancy services in relation to the design and development of the computer software may well share trade channels with the earlier computer software goods, and be engaged with by the same users. Overall, I find these services to be similar to the earlier services outlined to a low degree.

35. The contested services include those for the *design and development of computer hardware*. I see no obvious points of similarity between these services and the earlier goods and services. They do not appear to be complementary, in competition, or to share a nature, purpose, method of use or likely to share trade channels. Whilst users may be shared, this will only be at a general level. I find these services to be dissimilar to the earlier services. For the same reasons, I find the also contested *advice, information and consultancy services* in relation to the services to be dissimilar to the earlier services.


Comparison of marks

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

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

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

38. The respective trade marks are shown below:

Earlier trade marks	Contested trade marks
	

39. The first earlier mark contains the two elements ‘21’ and ‘Shares’, written in plain text. In the context of financial goods and services, the word “shares” is not particularly distinctive. In addition, 21 is placed at the beginning of the mark where elements tend to have more visual and aural impact.² I therefore consider “21” to be the most dominant and distinctive element of the earlier mark, with shares playing a lesser role in the overall impression of the same.

40. The second earlier mark comprises what appears to be a heavily stylised number 21, followed by ‘.co’, presented in a peach colour. The stylised no. 21 appears to be the most dominant and distinctive element of the mark, with the .co element at best holding only a very low level of distinctive character due to it simply referencing a web domain, and therefore playing a lesser role in the overall impression of the mark. Whilst the colour and shading used are not negligible, they play a smaller role still in the same.

41. The contested marks both include the heavily stylised and multicoloured no. 21, followed by the words ‘twentyone’, which are presented without a space or dash between them. It is my view that the number 21 is so heavily stylised, it is unlikely it would be considered a number if it were not presented by the words “twentyone”, and it would instead likely be considered a cluster of shapes. The first mark in the series is presented on a simple black box with the wording in white, whereas the second

² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

mark in the series does not include the black background, and the text is in black. In both cases, the number 21 uses a combination of pink, green and blue. It is my view that the consumer will be initially drawn to the immediately recognisable wording 'twentyone', which I find plays the most significant role in both marks in the series. The number 21, not being immediately recognisable as a number, plays a secondary role, and the chosen colour combination an even smaller role still. At best, the use of the black box plays a very minimal role in the overall impression of the first earlier mark.

Visual comparison

42. It is my view that the earlier marks bear no visual resemblance to the contested marks. Whilst I note they all contain the number '21' in some capacity, as I have noted above, the number is so heavily stylised in the contested mark it is only recognisable as a number due to its presentation next to the words "twentyone". I do not consider this sufficient to render the marks visually similar.³

Aural comparison

43. Both of the earlier marks and both of the contested marks will coincide aurally through the use of the same three syllables and known words twenty-one. Whilst I note it is the number that will be verbalised in this way in the earlier marks and the word element in the later marks, this has no impact on the aural similarity of these elements. The use of the word 'shares' (which will be verbalised in the known way), and '.co', (which in my view will be verbalised as 'dot-co') both act as points of aural difference. Overall, I consider the marks aurally similar to a relatively high degree.

44. I note here for completeness, that it is my view that only the word element twenty-one will be pronounced in the contested marks. As I have set out above, the additional element will, in my view, only be noticeable as the number 21 once the word element has been read, or verbalised. I therefore consider it very unlikely that the consumer will pronounce the contested marks as "twenty-one twenty-one". However, if I am

³ See paragraph 13 of *The Royal Academy Of Arts v Errea Sport S.P.A.* BL O/010/16, in which it is noted that just because two marks may share representations of the same thing, this does not automatically result in a finding of visual similarity between them.

wrong in this finding, it is my view that the marks will still remain aurally similar to a medium degree by virtue of the same two words and three syllables twenty-one appearing in the same position in each.

Conceptual comparison

45. It is my view that for the most part, the numbers 21 (or words twentyone) will not convey any additional meaning to the consumer outside of the fact that they are both the number 21. However, the inclusion of the same number in each mark will still act as a point of conceptual similarity to this extent.

46. The additional element 'shares' in the first earlier mark will likely convey to the consumer the idea of company shares, i.e. parts of a company's capital. It is my view that at least a significant portion of consumers will see the mark as the number 21 followed by a reference to company shares. However, I note there may also be a portion of consumers who view the mark as a whole as referencing '21 shares', i.e. 21 shares of something, or 21 shares of a company. In both cases, the use of the word 'shares' helps to differentiate the marks conceptually to an extent, but they are nonetheless conceptually similar to a relatively high degree.

47. It is my view that the element '.co' in the second earlier mark will be viewed simply as reference to a website, and whilst this will act as a point of conceptual distinction, overall the marks are conceptually similar to a relatively high degree.

Average consumer and the purchasing act

48. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

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

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

50. The average consumers of the goods in class 9 will include both members of the general public and professionals. In respect of software for use in relation to currency and financial transactions, members of the general public are likely to pay a slightly above medium degree of attention on the basis that the security of their own personal money or investments may be at stake. Professionals dealing with this software in relation to business accounts are likely to pay a slightly higher level of attention, that being between medium and high, considering that business transactions may have higher stakes and deal with larger sums of money than personal transactions. I find this to also be the case in relation to the finance related software services in class 42.

51. In relation to the services such as credit card, debit card, and current account services for example, both professionals and the general public will consider factors such as benefits, charges and security when considering these. Again, I find that the general public will likely pay a slightly above medium level of attention to these services, whereas professional consumers would likely pay a slightly higher level of attention when considering these in relation to business transactions due to the impact they may have on the business either immediately or over time. The level of attention paid by professionals will likely fall between medium and high.

52. In respect of the rest of the various finance related services in class 36, I consider that factors such as security, benefits, costs, ease of use and reputation will be considered before engaging these services, and both members of the general public and professionals will likely pay between a medium and high level of attention when engaging these.

53. Generally, the goods and services will be purchased visually, with the consumer considering visual advertising and websites. However, I note that there may also be verbal recommendations made, and services may be engaged over the phone, and so and I cannot discount the verbal comparison.

Distinctive character of the earlier trade mark

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

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

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 *Windsurfing Chiemsee*, paragraph 51).”

55. The opponent has not filed any evidence of use in these proceedings, and as such I only have the inherent position to consider.

56. The two earlier marks relied upon both contain the number 21 along with another element that appears to be either be somewhat descriptive of the goods or services

(‘shares’), or at best to hold a very low level of distinctive character (‘.co’). I note that even where ‘shares’ does not directly indicate the goods or services protected by the mark, it will still allude to other types of financial goods or services that may be offered by the opponent, and therefore in my view still holds only a low degree of distinctive character in respect of all of the financial goods and services. However, the number 21 does not appear to be descriptive or allusive of the goods or services, and in both earlier marks this element holds a medium level of distinctive character. The stylisation of the earlier UK mark also adds to its overall distinctive character, rendering this mark inherently distinctive to slightly above a medium degree as a whole, whilst I find the earlier International Registration inherently distinctive to a medium degree as a whole.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

57. Prior to reaching a decision under section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 15 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctiveness of the common elements is key.⁴ I must keep in mind that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods and services are obtained will have a bearing on how likely the consumer is to be confused.

⁴ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

58. There are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.⁵

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

60. In order for an opposition based on section 5(2)(b) of the Act to succeed, there must be at least some similarity between the goods and services.⁶ Both oppositions therefore fail in relation to the dissimilar services applied for below:

Class 42: Design and development of computer hardware; advice, information and consultancy services for all of the aforesaid services; none of the aforesaid services relating to the establishment or exploitation or valuation of Intellectual Property assets.

61. In respect of the remaining contested services, I found these to range from similar to a low degree to identical to those protected by the opponents' earlier marks. I found the earlier marks to be visually dissimilar to the contested marks, but to be aurally and conceptually similar to a relatively high degree.⁷ I found the earlier International Registration to be inherently distinctive to a medium degree, and the earlier UK trade mark to be inherently distinctive to an above medium degree. I found the number 21 to be the most dominant and distinctive element in each earlier mark, itself having a medium degree of inherent distinctiveness. I also found the word element "twentyone" to play the biggest role in the overall impression of the contested marks. I found the

⁵ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

⁶ See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

⁷ I keep in mind in this assessment that I found if I was wrong to consider the initial heavily stylised '21' would not be verbalised in the contested marks, then these would instead be aurally similar to the earlier marks a medium degree.

average consumers of the goods and services would include both members of the general public and professionals, all paying either a slightly above medium degree of attention, or between a medium and high degree of attention. I found the visual aspect of the marks would be most important in the purchasing process, but that I could not dismiss the aural comparison.

62. With consideration to all of the above factors, it is my view that there will be no likelihood of direct confusion between the marks. I find that the differences between the marks are too significant for these to go unnoticed or be misremembered entirely by consumers, particularly considering they will be paying at least a slightly above-medium level of attention. I will therefore go on to consider if I find there to be a likelihood of indirect confusion between the marks.

63. In *L.A. Sugar* (cited above) Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur as below:

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).”

64. I note that the examples above were intended to be illustrative and are not exhaustive. I also keep in mind *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands*,

LLC & Ors [2021] EWCA Civ 1207, in which Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

65. I also keep in mind at this stage the factors considered and summarised in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), particularly that where an element of a mark is similar to or identical to an element in another mark, and it retains an independent distinctive role within the marks, it is possible that this may result in the average consumer being confused as a result of the identity or similarity of that element to the corresponding element in the earlier mark.

66. I consider again, all of the factors in this case, and whether there may be a proper basis for a likelihood of confusion in this instance. I consider firstly, the opposition based on the International Registration. The most dominant and distinctive element of the earlier mark is the number 21. I also note that ‘shares’ will appear descriptive of goods and services relating to finance. I also consider that the dominant and distinctive element of the contested marks is the wording twentyone. Whilst this is visually different to 21 presented in number format, this element is aurally and conceptually identical. Further, the earlier mark is presented in plain black font, and the word twentyone in the contested marks is not tied to a particularly distinctive font or stylisation. I consider that consumers will not have the opportunity to compare the marks side by side, and it is my view that even where paying a higher than medium degree of attention, the average consumer may fail to recall whether the plain text element 21 was presented in number or word format within the earlier mark, with this simply being recalled conceptually as the same number in each mark. Further, for this reason, it is also my view that it would be a perfectly logical and likely for the consumer to assume that an entity using the element ‘21’ or ‘twentyone’ may present this same number across various marks in number and word format somewhat interchangeably, with it conveying the same meaning and being aurally identical in each. It is therefore

my view that, whilst recognising they are not the same marks, a consumer coming across the earlier mark 21Shares, having previously come into contact with the contested marks, is likely to assume that this is an alternative mark deriving from the same entity, used as a sub brand or in relation to a to a slightly different strand or product of its finance business. I consider this to be a proper basis for a finding of a likelihood of indirect confusion in relation to all of the similar services in this instance.

67. Whilst I consider that many of the factors above also relate to the opposition based on the earlier UK mark, I also note that the distinctiveness of this mark is, in part, owed to the unique and distinctive stylisation used in relation to the number 21. It is my view that in this instance, the use of this alternative and very different stylisation, will mean that consumers are more likely to recall the presentation of the number 21 in the earlier marks, and are less likely to assume that the earlier mark will derive from the same entity as the contested marks. Instead, it is my view that considering all of the differences between the marks, whilst one mark would very likely bring the other to mind, the use of 21 or twentyone in each would be more likely to be put down to coincidence. I therefore do not find a likelihood of confusion based on the earlier UK mark.

Final Remarks

68. Opposition no. 441192 based on UK registration no. 3815470 has failed in its entirety. However, opposition no. 441190 based on International Registration no. 1556929 has succeeded in respect of all goods and services other than those set out below:

Class 42: Design and development of computer hardware; advice, information and consultancy services for all of the aforesaid services; none of the aforesaid services relating to the establishment or exploitation or valuation of Intellectual Property assets.

69. Subject to any successful appeal, the application will therefore proceed to registration in relation to these services only.

COSTS

70. The opponents in the proceedings have agreed to be jointly and severally liable for any costs should they be unsuccessful within these proceedings. I note in one set of proceedings, the opponents have been entirely unsuccessful. However, in the other matter, the opponents achieved a significantly higher portion of success than the applicant. Whilst I note the application has ultimately been nearly entirely refused, I also consider that the applicant was, prior to the consolidation of the matters, still put to the expense of defending a second separate, and ultimately unsuccessful, set of proceedings. In the circumstances, I direct that both parties bear their own costs in these proceedings.

Dated this 13th day of December 2024

R. Le Breton

For the Registrar

Annex A

Class 9: Mobile applications and software in the field of financial services, namely, downloadable software for the collection, analysis, organization, storage and transmission of data and information in the fields of asset management services, providing financial information, financial administration, trading of securities and investment management; downloadable software and mobile applications for use in electronic commerce (e-commerce) with and for storing, sending, receiving, accepting and transmitting digital currency and managing digital currency payment and exchange transactions; electronic downloadable publications, namely, publications in the form of articles, brochures and prospectuses containing lists of investment securities and an index based on securities prices; electronic downloadable financial publications, namely, data sheets, informational brochures and reports in the field of investment securities and a securities price index; downloadable electronic files containing a securities price index.

Class 35: Providing services with respect to marketing research for private and institutional financial investors and finance professionals in the field of cryptocurrency; business management consulting in the field of cryptocurrency; providing information and analyses in the field of economic market data for commercial purposes; providing information and advice on business development for financial professionals; providing advice in business management and providing commercial information to businesses; market analysis; providing information and analyses in the field of economic market data for financial purposes.

Class 36: Financial services, namely, the offer and management of mutual investment funds; financial services, namely, investment management, financial planning services, investment transactions relating to funds, transferable securities brokerage and providing financial information, by electronic means; advisory services in investment and services relating thereto in the field of cryptocurrency, namely, advice on investments in cryptocurrency; investment management services and financial advice in the field of cryptocurrency; financial risk management; intermediation in investment funds; investment services for investment funds; financial investment services in the field of open-ended investment funds; management of financial assets; evaluation of financial assets; investment services, namely, management and

brokerage in the field of cryptocurrency and investment transactions for others; investment consultancy; research on financial investments; tax assessments and advice; financial management of investment funds and investment companies; financial research; preparation of financial reports for others and financial analysis related thereto; providing financial information on investment possibilities and financial analysis; online financial services, namely, transfer and transaction of investment funds, financial planning and financial research; provision of financial and investment services, namely, financial information based on different asset class indices; financial management and investment services in relation to transferable securities; advisory services with respect to finances and investment; rating services in connection with the financial performance of securities and investments and the provision of credit rating services; analysis of financial data and stock exchange research; exchanging money; foreign-exchange transactions online and in real time; cash management services, especially facilitating the transfer of electronic currency equivalents; digital money exchanging services for transferable equivalent units of electronic currency having a given current value; providing and updating a financial index; provision of financial indices in the nature of quantitative measurements for evaluating investments, market trends and financial instruments; providing financial indices based on selected groups of securities; providing and updating financial indices for securities.

Class 42: Providing temporary use of non-downloadable software, web applications and software platforms in the field of financial services, namely, providing non-downloadable software for the collection, analysis, organization, storage and transmission of data and information in the fields of asset management, financial information, financial administration, trading in transferable securities and investment management; providing temporary use of non-downloadable software for electronic commerce (e-commerce) with and for storing, sending, receiving, accepting and transmitting encrypted currency and for managing digital currency payment and exchange transactions.

Annex B

Class 9: Software relating to the trading and administration of crypto assets; software relating to blockchain; software relating to the issuance of digital tokens; downloadable computer software for managing cryptocurrency transactions using blockchain technology; software for virtual and augmented reality; software for use in relation to virtual worlds; software relating to electronic funds transfer; software for trading and administration of non-fungible tokens (NFTs); software for use in relation to the metaverse; computer software for use in searching an open-source blockchain-based computing platform that provides access to financial applications and financial services; computer software for use in controlling, managing and sending global payments.

Class 35: Updating of a financial index; providing business and market research services to private and institutional financial investors and financial professionals in the field of cryptocurrency; business management consultancy in the field of cryptocurrency; provision of information and analysis in the field of economic market data for business purposes; providing business development information and advice to financial professionals; business advice and information; market analysis; economic forecasting and analysis; updating of financial indices for securities stocks.

Class 36: Financial services, namely, offering and managing mutual funds; financial services, namely, investment management, financial planning services, fund investment services, brokerage services and providing financial information by electronic means; investment advisory services in the field of cryptocurrency, namely advice on investments in cryptocurrency; investment management and financial advice in the field of cryptocurrency; financial risk management; brokerage of investment funds; investment services for investment funds; distribution of investment funds; management of financial assets; valuation of financial assets; investment services, namely, management and brokerage in the field of cryptocurrency and investment business for others; investment advice; financial investment research; financial management of mutual fund investment trusts; financial research; preparation of financial reports for others and related financial analysis; provision of financial information on investment opportunities and financial analysis; online financial services, namely mutual fund transfer and transaction services, financial

planning and financial research; provision of financial and investment services, namely financial information based on various asset class indices; financial services, namely, offering, operating and managing the issuance, subscription and distribution of securities products traded on a stock exchange, namely cryptocurrencies; financial and investment advisory services; rating services relating to the financial performance of securities and investments and provision of credit rating services; financial data analysis and stock research; currency exchange services; online real-time currency trading; cash management, namely, facilitating the transfer of electronic money equivalents; digital currency exchange transaction services for transferable electronic money equivalents with a certain cash value; providing information and analysis of economic market data for financial purposes; provision of a financial index; providing financial indices in the nature of quantitative measurements for evaluating investments, market trends and financial instruments; provision of financial indices based on selected groups of securities; provision of financial indices for securities stocks; financial exchange and administration of crypto assets.

Class 42: Providing temporary use of non-downloadable software for trading in crypto assets; providing temporary use of non-downloadable software for blockchain transactions; providing temporary use of non-downloadable software for the issuance of digital tokens; software as a service; platform as a service; providing temporary use of online non-downloadable software for use in electronically trading, storing, sending, receiving, accepting and transmitting digital currency, and managing digital currency payment and exchange transactions.