

O/760/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003643967 BY IG GROUP LIMITED
TO REGISTER THE FOLLOWING TRADE MARK:**

SERIX

IN CLASSES 9 AND 36

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 428286 BY SERILINE AB**

Background and Pleadings

1. On 19 May 2021, IG Group Limited ('the Applicant') applied to register the trade mark, shown on the cover of this decision, number UK00003643967. The application was published for opposition purposes in the *Trade Marks Journal* on 20 August 2021. Registration is sought in respect of the following goods:

Class 9:	<i>Computer software, electronic publications (downloadable) and information provided on-line from a computer database and/or the Internet; all of the aforesaid goods for use in connection with financial trading and exchange trading; none of the aforesaid goods for use in connection with identity verification.</i>
Class 36:	<i>Financial services; financial research, analysis, forecasting, appraisal and advisory services; financial information; preparation of financial reports and analysis; economic and financial research services; preparation and quotation of information concerning exchange rates; fiscal assessments and valuations; preparation and quotation of stock exchange prices and indices; information, consultancy and advisory services relating to all of the aforesaid services.</i>

2. On 18 November 2021, the application was opposed by Seriline AB ('the Opponent') based on on section 5(2)(a) of the Trade Marks Act 1994 ("the Act"). The Opposition is directed against all of the Applicant's goods and services. The Opponent relies on the following earlier registration for its section 5(2)(a) ground, relying upon relying upon all of the goods and services in its specification:

UK00918208761

SERIX

Filing date: 11 March 2020

Date registration completed: 7 July 2020

Registered for the following goods and services:

Class 9:	<i>Electronic ID cards; Identity cards, magnetic; Biometric identity cards; digital identity card; Identity cards, encoded; Terminals for visitor management; Software for visitor management; Software for identity verification; Interactive monitors for visitor management.</i>
Class 42:	<i>Access Control as a Service (ACaaS); Cloud services (SaaS) for managing of authentication and identity services.</i>
Class 45	<i>Identity validation services; Authentication services; Identity validation services.</i>

3. The Opponent claims that the parties' respective marks are identical and cover similar and identical goods, resulting in a likelihood of confusion between the marks.
4. The Applicant filed a Defence and Counterstatement in which it:
 - denies that the parties' respective goods and services are similar;
and
 - denies that there is a likelihood of confusion between the parties' marks.
5. Written submissions were filed during the evidence round by the Opponent only, although neither party has filed evidence. A hearing was neither requested nor considered necessary. Written submissions in lieu of a hearing have been filed by the Applicant only. I have read the submissions of both parties and will refer to them in my decision where appropriate.
6. The Opponent is represented by Daniel Dimov; the Applicant is represented by Withers and Rogers LLP.

7. The following decision has been made after careful consideration of the papers before me.

Decision

Section 5(2)(a) of the Act and related case law

8. Section 5(2) of the Act states:

'5(2) A trade mark shall not be registered if because—

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

[...]

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

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

10. In accordance with section 6 of the Act, the Opponent's mark is an earlier mark by virtue of its earlier filing date, which fell before the filing date of the applied-for mark.

11. Section 6A of the Act provides that where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the application date (or priority date) of the applied-for mark, the Opponent may be required to prove use of the earlier mark. In the instant case, section 6A is not engaged because the earlier mark had been registered for less than 5 years on the date on which the Applicant filed its application, i.e. 19 May 2021. The Opponent is therefore entitled to reply upon all of the goods and services that it seeks to rely upon.

12. It is a prerequisite of section 5(1) (and section 5(2)(a)) of the Act that the trade marks are identical.

13. In *S. A. Société LTJ Diffusion v. Sadas Vertbaudet SA*¹, the Court of Justice of the European Union ('CJEU') held that:

'54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.'

14. The following principles are derived from the decisions of the Court of Justice of the European Union² ("CJEU") 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C120/04; *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

¹ Case C-291/00

² Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

upon the imperfect picture of them they have kept in their 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 the marks

15. The marks are unequivocally identical:

Opponent's (earlier) mark	Applicant's (contested) mark
SERIX	SERIX

Comparison of goods and services

16. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

17. I must therefore be mindful of the fact that the appearance of respective goods in the same class is not a sufficient condition for similarity between those services, and neither are they to be found dissimilar simply because some services may fall in a different class.

18. I must also bear in mind the decision of the General Court ('GC') in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05:

"29. ... 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".

19. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to a parties' goods and services must be taken into account:

"[23] "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".

20. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281³, identified the following factors for assessing similarity of the respective goods and services:

- (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;

³ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

(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.

21. 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 [or services]. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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”.

22. The Tribunal may group goods (or services) together for the purposes of assessment:

Separate Trade Mark BL O-399-10 (AP):

“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.”

23. The goods and services to be compared are as follows:

Opponent's (earlier) mark:	Applicant's (contested) mark:
Class 9	Class 9

<p><i>Electronic ID cards; Identity cards, magnetic; Biometric identity cards; digital identity card; Identity cards, encoded; Terminals for visitor management; Software for visitor management; Software for identity verification; Interactive monitors for visitor management.</i></p> <p>Class 42 <i>Access Control as a Service (ACaaS); Cloud services (SaaS) for managing of authentication and identity services.</i></p> <p>Class 45 <i>Identity validation services; Authentication services; Identity validation services</i></p>	<p><i>Computer software, electronic publications (downloadable) and information provided on-line from a computer database and/or the Internet; all of the aforesaid goods for use in connection with financial trading and exchange trading; none of the aforesaid goods for use in connection with identity verification.</i></p> <p>Class 36 <i>Financial services; financial research, analysis, forecasting, appraisal and advisory services; financial information; preparation of financial reports and analysis; economic and financial research services; preparation and quotation of information concerning exchange rates; fiscal assessments and valuations; preparation and quotation of stock exchange prices and indices; information, consultancy and advisory services relating to all of the aforesaid services.</i></p>
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Class 9

24. I note that the Applicant has sought to limit its class 9 specification by including the following clauses:

- *‘all of the aforesaid goods for use in connection with financial trading and exchange trading;’*

and

- *'none of the aforesaid goods for use in connection with identity verification.'*

25. In my view, the latter limitation excludes the Opponent's goods because all of its goods and services are connected with identity verification. The Applicant's limitation therefore prevents a finding that the respective goods and services are identical. The Tribunal must nevertheless consider whether there is any similarity between the parties' specifications.

26. The former limitation will, however, be of no consequence because the Opponent has not sought to qualify its goods or services in terms of the *field of business*⁴ in which they will be used. Although the Opponent's terms make clear that the function of its goods and services is to facilitate identity verification/authentication, identity/authentication verification is, in my view, evidently an important matter in the context of transactions in financial trading.⁵

27. Contested goods: *Computer software [...] provided on-line from a computer database and/or the Internet; all of the aforesaid goods for use in connection with financial trading and exchange trading; none of the aforesaid goods for use in connection with identity verification.*

I compare these goods against the Opponent's class 9 terms *Software for identity verification*. Both sets of goods will share a nature, and share a purpose to the broad extent that both are computer software, i.e. sets of instructions (programmes) according to which a computer or electronic device is able to operate. The specific purposes will, however, diverge: the Opponent's software is specifically intended to facilitate the verification of identity; whereas the Applicant's goods are intended for use in relation to financial and exchange trading, and are explicitly unconnected with identity verification. I consider users of the respective goods to overlap; users of the Applicant's software in connection with financial and exchange trading will almost always be users of some sort of identity verification

⁴ Although the Opponent's terms clearly indicate the *function* of the goods or services i.e. identity verification.

⁵ E.g. to prevent fraudulent transactions.

software. Trade channels will likely be shared; the same undertaking may provide both sets of goods. I do not find the respective goods to be in a competitive relationship. I now consider whether there is complementarity between the goods. The Opponent has argued that ‘without identity verification, the software for financial trading and exchange will not be able to accomplish its purpose as anyone will be able to impersonate the users of the software and obtain, transfer, or use their funds without their authorization [sic]’.⁶ I agree that some sort of identity verification software is necessary to enable software for financial trading and exchange to be used effectively and to be legally compliant, and the applicant’s goods are at the very least important for the opponent’s. I also consider that the average consumer might presume both sets of software to originate from the same undertaking. I therefore find the parties’ goods to be complementary. In the light of the foregoing, I find the respective goods to be similar to at least a medium degree. In my view, comparison of the Applicant’s term with any other of the Opponent’s goods or services will not yield any greater level of similarity.

28. Contested goods: [...] *electronic publications (downloadable) and information provided on-line from a computer database and/or the Internet; all of the aforesaid goods for use in connection with financial trading and exchange trading; none of the aforesaid goods for use in connection with identity verification.*

‘Electronic publications’ are documents rendered in an electronic format. The Applicant’s term covers any information rendered in an electronic format, whether online and/or downloadable. I recognise that some electronic publications may use identity verification software for access. However, I do not consider this factor alone sufficient to find that the Applicant’s goods to have any level of similarity with any of the Opponent’s goods or services.

Class 36

29. Contested services: *financial services*

⁶ Opponent’s written submissions, paras [6] – [7].

I compare these services against the Opponent's *Identity validation services* in class 45. The purpose of the Applicant's services is to assist businesses and individuals in financial matters by providing advice, information and expertise. The purpose of the Opponent's services, however, is to facilitate the verification of identity i.e. to check that an individual or business is who it claims to be. The purposes of the respective services are therefore distinct. In my view, user overlap is unlikely. I consider that users of the Opponent's *Identity validation services* will be businesses whose fields of activity require that they are able to verify the identity of their clients/customers, whereas users of the Applicant's services will be the aforementioned clients/customers. I consider trade channel overlap to be unlikely; it would be unusual (although not impossible), in my view, for the same undertaking to offer both *financial services* and *Identity validation services*. The respective services are not in a competitive relationship; neither service is substitutable for the other. I do not find complementarity, either; although *identity validation services* will be necessary in order for the provider of *financial services* to deliver those services compliantly, the average consumer would not presume both sets of services to originate from the same undertaking. I therefore find the respective services to be dissimilar.

30. I also compare the Applicant's *financial services* against the Opponent's *Software for identity verification*. The purposes of the respective services and goods will differ; the Opponent's goods providing the electronic infrastructure to facilitate the verification of identity. As noted above, consumers of the Applicant's services will be businesses and individuals seeking assistance with financial matters. In my view, the Opponent's goods will be purchased by businesses whose fields of activity require that they are able to verify the identity of their clients/customers. For the same reasons set out above at [30], I do not find any level of similarity between the parties' respective services and goods.

31. Contested services: *financial research, analysis, forecasting, appraisal and advisory services; financial information; preparation of financial reports and analysis; economic and financial research services; preparation and quotation of information concerning exchange rates; fiscal assessments and valuations;*

preparation and quotation of stock exchange prices and indices; information, consultancy and advisory services relating to all of the aforesaid services.

I do not consider these services to have any level of similarity with any of the Opponent's goods and services.

Average consumer and the purchasing act

32. In *Hearst Holdings Inc*⁷ Birss J. (as he then was) described the average consumer thus:

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

33. The average consumer of the goods that come into play in this opposition (i.e. *Computer software [...] provided on-line from a computer database and/or the Internet and Software for identity verification; all of the aforesaid goods for use in connection with financial trading and exchange trading; none of the aforesaid goods for use in connection with identity verification*) will be businesses. In my view, both sets of goods may be purchased online or from physical shops. In addition, they may be purchased following visual pitches and presentations given to businesses, or following interaction at a trade show. The purchasing act will be primarily visual to the extent that the prospective purchaser would likely first encounter the goods online or in a catalogue or trade publication, or within a visual presentation or at a trade stand, for example. There will also be an aural aspect to the purchasing process; I consider that most transactions would conclude only after discussion of the purchaser's business needs with the provider of the goods.

⁷ *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).

Factors influencing the purchasing process will include, *inter alia*, compatibility with existing hardware and/or software, and business needs. In my view these goods would be purchased with a high level of attention.

Distinctive character of the earlier mark

34. 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).

35. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of

the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

36. The earlier mark is the word mark 'SERIX'. This word does not appear in the English dictionary and will, to my mind, be perceived as an invented word. The mark neither describes nor alludes to the goods that come into play in this opposition. I therefore find that the mark has a high level of inherent distinctive character.

37. No evidence has been submitted. I am therefore unable to make a finding in respect of enhanced distinctive character.

Likelihood of confusion

38. There are two types of confusion that I may find. The first type is 'direct confusion', which occurs when the average consumer mistakes one mark for another. The second type is 'indirect confusion', where the average consumer notices the differences between the marks but, due to the similarities between the common elements, they presume that the goods or services originate from the same or an economically-related undertaking.⁸

39. I have found the respective parties' marks to be identical. I have found the Applicant's class 9 goods *Computer software [...] provided on-line from a computer database and/or the Internet; all of the aforesaid goods for use in connection with financial trading and exchange trading; none of the aforesaid goods for use in connection with identity verification* to be similar to the Opponent's goods to at least a medium degree, and I have found the Opponent's mark to be highly distinctive. I have found that the average consumer will pay a high level of attention when purchasing the goods.

40. Taking account of these factors, I find that the average consumer, paying even a high level of attention, would confuse the marks. The identity of the marks and

⁸ L. A. Sugar Limited v Back Beat Inc, BL O/375/10

the similarity of the goods and services would, in my view, lead the average consumer to mistake one mark for the other. There is a likelihood of direct confusion in respect of the Applicant's class 9 goods *Computer software [...] provided on-line from a computer database and/or the Internet; all of the aforesaid goods for use in connection with financial trading and exchange trading; none of the aforesaid goods for use in connection with identity verification*. Where the parties' respective goods and services have been found to be dissimilar, the Opposition cannot succeed.

Conclusion

41. The Opposition has been partially successful. Subject to any successful appeal:

- the Application is refused in respect of the following goods only:

Class 9

Computer software [...] provided on-line from a computer database and/or the Internet; all of the aforesaid goods for use in connection with financial trading and exchange trading; none of the aforesaid goods for use in connection with identity verification

and

- the Application may proceed to registration in respect of the following goods and services only:

Class 9

[...] electronic publications (downloadable) and information provided on-line from a computer database and/or the Internet; all of the aforesaid goods for use in connection with financial trading and exchange trading; none of the aforesaid goods for use in connection with identity verification.

Class 36

Financial services; financial research, analysis, forecasting, appraisal and advisory services; financial information; preparation of financial reports and analysis; economic and financial research services; preparation and quotation of information concerning exchange rates; fiscal assessments and valuations; preparation and quotation of stock exchange prices and

indices; information, consultancy and advisory services relating to all of the aforesaid services.

COSTS

42. The Applicant has enjoyed the greater degree of success. The Opposition has been successful only in respect of roughly 6% of the Applicant's specification. The Applicant is entitled to contribution towards its costs, based upon the published scale⁹. I award the Applicant the sum of **£470** calculated as follows:

Consideration of the Opposition and preparation of Defence and Counterstatement:	£200
Preparation of written submissions:	£300
Sub-total:	£500
Less 6% to take account of the Opponent's partial success:	£30
Total:	£470

43. I therefore order Seriline AB to pay to IG Group Limited the sum of £470. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of September 2022

N. R. Morris
For the Registrar,
the Comptroller-General

⁹ Tribunal Practice Notice 2/2016