

TRADE MARKS ACT 1938

**IN THE MATTER OF TRADE MARK Application
Nº: 1543952 to register a trade mark in the name of
Citicorp.**

**AND IN THE MATTER OF Opposition
Nº: 44507 by Link Interchange Network Limited.**

Decision

1. This is an opposition to registration of the trade mark CITIBANK FXLINK by Citicorp, 399 Park Avenue, USA, for 'Banking services; on-line foreign exchange transaction services; all included in Class 36'. The mark was applied for on 4th August 1993.
2. Registration is opposed by joint opponents Abbey National plc, Funds Transfer Sharing Limited and Girobank plc, who are the proprietors of registration number B1274743:



which was applied for on 1st October 1986 for: 'Banking services for the dispensing of cash; funds transfer and payment services; financial information services; all included in Class 36'.

3. The opponents say that the mark in suit is confusingly similar to their earlier link mark, and is to be registered for services identical with or of the same description as those for which the earlier trade mark is to be registered. Consequently, the applicants' mark applied is calculated to deceive and cause confusion and they say registration would be contrary to the provisions of ss. 11 and 12 of the Act.
4. The opponents also state that registration or use of the mark applied for would unfairly prejudice them in their business activities and, further, registration of the mark applied for should accordingly be refused in the exercise of the discretionary powers conferred on the Registrar. They asked for their costs, as do the applicants, who deny the grounds pleaded.
5. I heard submissions on the issues in a Hearing conducted by video link between Newport and London on 19th February 2001. Mr Mellor of Counsel, instructed by F J Cleveland, represented the applicants, while Ms McFarland, also of Counsel, instructed by D Young & Co., represented the opponents. By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed by Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act, however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provision of the old law.
6. After a careful consideration of the evidence, I have decided not to include a detailed formal summary. Rather I will refer to those parts of it that are relevant to the grounds pleaded.

7. There was a preliminary point which is best described in a letter written to the Registry on 9th February 2001, from the existing opponents' agents:

'We refer to the .. [instant] ... proceedings and hereby apply to substitute Link Interchange Network Limited (company number 3565766), whose registered office is at Arundel House, 1 Liverpool Gardens, Worthing, West Sussex BN11 1TA, as the opponent in these proceedings.

The basis for this request is that Link Interchange Network Limited is the current proprietor of rights in the LINK mark which forms the basis of this opposition, namely, UK registration 1274743, by virtue of an assignment dated 30 November 1998 and recorded at the Trade Mark Registry on 13 May 1999. A copy of the Registry Assignment Certificate is attached hereto in confirmation thereof.

On behalf of Link Interchange Network Limited, for whom we are the authorised representative, we hereby confirm the, following:

- 1) They have had sight of any forms or evidence filed in these proceedings (in this respect, it will be noted that the opponent's Rule 13 evidence includes a Declaration from Howard Aiken, the General Manager Commercial of Link Interchange Network Limited).
- 2) They stand by the grounds or statements made in the Notice of Opposition and supporting evidence and confirm that where the name of the original opponent appears, this should be read as though it is made in their name.
- 3) They are aware of, and accept, their liability for costs for the whole of the proceedings in the event of the opposition being unsuccessful, in an amount to be determined by the Registrar in the event that this is considered necessary, and are prepared to provide security for such costs. We are asked to indicate that Link Interchange Network Limited is a substantial company with significant financial assets and is, of course, based in this country.

For the purposes of these proceedings, the new opponent's address for service in the United Kingdom is c/o D. Young & Co., 21 New Fetter Lane, London EC4A 1DA. Form TM33 is filed herewith.

We submit that this request for substitution involves no material change to the substance of opposition number 44507 and can advise that we have no intention of seeking a postponement of the Hearing which is due to occur on Monday 19 February next..'

The letter was copied to the applicants.

8. In *Pharmedica GmbH's International Trade Mark Application* [2000] RPC 536 it was held by Pumfrey J that, as a statutory tribunal, the Registrar of Trade Marks had jurisdiction to regulate her own procedure to permit amendment to substitute a party in opposition proceedings, provided that she did so in accordance with statute and no new substantive jurisdiction was created. This led to a new practice direction (Journal 6314). At the hearing, Mr Mellor stated:

‘... I am being asked to consent to this, and I am simply not able to do so. .. First of all, bearing in mind this happened apparently two years ago, it is rather surprising that it has been raised at the last minute, and that has had the following consequence. I have not seen the assignments that are relied upon and normally, if this sort of application for substitution happens, one has a chance to look at the assignments and to check that all relevant rights have been passed. My friend says the facts are very plain. I simply do not know whether they are or not. It is as simple as that. She says there is no basis for saying there is any prejudice. I simply do not know. If all the relevant rights have been assigned, then there is not; if there is a hole in these assignments, then there is.

I am not in a position to consent, although I do accept that it may turn out to be largely an administrative matter..’.

And we decided to ‘park’ this matter for my later determination, while proceeding with the hearing. Mr Mellor’s surmise was that the matter may turn out to be administrative, and I think it is. The assignment to Link Interchange Network Limited was properly made, and the particulars as required by the practice direction were adhered to, except in respect of provision of Security for Costs. In context of item (3) in the opponents’ letter I have decided to wave the latter requirement in this case. The substitution is accepted.

9. Turning now to ss.11 and 12(1) of the Act, these read as follows:

‘11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.’

‘12.-(1) Subject to the provisions of subsection (2) of this section no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of-

(a) the same goods,

(b) the same description of goods, or

(c) services or a description of services which are associated with those goods or goods of that description.’

10. The reference in this latter section to a near resemblance is clarified by Section 68(2B) of the Act which says that: ‘[r]eferences in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion’, and that would be as regards origin of the goods or services.

11. In opposition proceedings it is normal to apply the following tests, from *Smith Hayden* (1946) 63 RPC 97, as amended by *Bali* [1969] RPC 472 (per Lord Upjohn at p 496). In this instance, these tests read as:

(Under s 11) ‘Having regard to the user of the mark LINK and device is the tribunal satisfied that the mark applied for, CITIBANK FXLINK, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?’

(Under s 12(1)) ‘Assuming user by the opponents of their LINK and device mark in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception among a number of persons if the applicants use their mark CITIBANK FXLINK and device normally and fairly in respect of any goods covered by their proposed registration?’

12. I wish to deal with s. 12 first. The applicants’ specification of goods can be compared to that of the opponents:

Banking services; on-line foreign
exchange transaction services

Banking services for the dispensing of cash;
funds transfer and payment services; financial
information services

Ms MacFarland stated:

‘We would particularly pray in aid the specification for Class 36 on our part, banking services for the dispensing of cash. That is without limitation as to whether it is UK cash, whether it is foreign exchange cash, or whatever. It is funds transfer in its broadest sense, and payment services, again in its broadest sense. That would inevitably include, for example, EFTPOS [see below, paragraph 14], ATM [Automated Teller Machines, i.e. ‘cash machines’] etc. Then financial information services, which is perhaps the broadest end of the scope of our specification. We have pitched that against the application and we see that inevitably the applicants have gone for a very broad scope, in which we say that they entirely subsume that which we have registered and that which we do, and that is because of banking services. Those two words, we say, are about as broad as you could possibly get within Class 36. That is effectively saying, “We will have the entire blanket, the full blown services, thank you very much, anything which may be arguably within or connected with banking is what we want” ’.

13. I think she is right. It is hard to escape the conclusion, without evidence to the contrary (which the applicants have not supplied) that ‘banking services for the dispensing of cash’ is a subdivision of ‘banking services’ in general, and that funds transfer and payment services are services that one would typically expect a bank to provide. Though Ms MacFarland included financial information services in this category as well, and I am cognisant of the fact that all banks supply what may be classified as such information today, and no doubt did (maybe to a lesser extent) in 1993, I do not think this is a traditional bank service as such. The latter, in my view, would relate to services involving money, in one form or another, on behalf of their clients.
14. In his Declaration Mr Aiken, the opponents’ Commercial General Manger, explained that though the primary field of operation under the Link logo in the UK is the provision of ATM services, LINK members have also operated pilot schemes for electronic funds transfer at point of sale services, which are commonly known by the abbreviation EFTPOS. He added:

‘This is a debiting system whereby authorisation for withdrawal of funds from the user’s account is provided through a central validation system which uses the Link card as a trigger. Over the past few years it has become commonplace for customers to be able to pay for their purchases in all kinds of retail establishments, including supermarkets, by means of the EFTPOS system using a debit card. When such payment is made, the customer may also be offered the facility of drawing an additional sum in cash at the time when the goods are being purchased. This is usually known as a “cashback” facility and is highly convenient for any customers since it removes the need to withdraw cash from a bank or ATM machine at a different location’.

EFTPOS is thus an example of ‘funds transfer and payment services’ and indicative of the ‘Switch/Connect’ card type facilities that are now commonplace. Comparing the latter to ‘on-line foreign exchange transaction services’ I struggle to believe that the two are similar. If they are, it seems to me that they are on the borderline of similarity.

15. However, in the light of the view I have taken on banking services, I think the matter falls to be decided by a comparison of the marks themselves, and for this purpose I adopt the well known test propounded by Parker J in *Pianotist Company’s Application* (1906) 23 RPC 774. The relevant passage reads:

‘You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case.’

16. The surrounding circumstances includes *inter alia* user by the opponents of their LINK and device mark in a normal and fair manner *for any of the goods covered by their registration* and use the applicants’ mark normally and fairly in respect of *any goods covered by their proposed registration*. As I have already noted, the goods are identical. But the effect of this needs to be clear: Ms MacFarland commented that:

‘..notional and assumed use would envisage that ... CITIBANK FXLINK could be used prominently on the High Street in respect of ATM facilities and/or EFTPOS facilities or any other electronic transfer facilities..’

I think I agree. The monopoly the applicants have asked for must result in such a stark identity between the goods at issue: I must consider the case where members of the public use ‘hole in the wall’ machines carrying the marks at issue. Ms MacFarland also argued that the word element of the mark would dominate, and this must be so; the other elements are abstract or, at best allusional. But, I have not lost sight of the fact that the marks must be considered as a whole.

17. It is clear that a less distinctive mark should enjoy a smaller compass of protection. The English word ‘link’ has a number of common meanings - including ‘link’ in a chain, a road

connection and others - but the essential idea is that of connection of something with something else. In view of this, it is hardly surprising that the word has a number of uses; however, evidence is required in deciding whether these reduce the distinctiveness of the opponents' registration. And a great deal of evidence was submitted by the applicants intending to lead to the conclusion that it did.

18. This material is largely appended to the Statutory Declaration of Mr Peter Joseph Houlihan and, in my view, proves little. This information is either well after the relevant date, takes simple advantage of the meaning of the word to connect, encompasses products which are wholly unrelated to the opponents' mark, apply to use outside the UK or give no indication of the extent of any use in the UK or all five.
19. None of this proves anything, in my view, about the distinctiveness of LINK in respect of 'Banking services for the dispensing of cash; funds transfer and payment services; financial information services; all included in Class 36' as of August 4th 1993. Though I do not believe that the mark is the most distinctive ever - it is an English word with a familiar meaning - I do not see it as clearly descriptive of the specified services: it is a valid allusional mark that 'works' on more than one level - for example, it may suggest a network of cash machines, whereby customers of different banks are able to access their cash via ATM's operated by banks other than their own, each of which forms a link in the chain, as it were (of which the symbol in the mark, referred to by Ms MacFarland as 'two interlinked circles' may make a reference); thus it connects a consortium that would be entirely unrelated but for the LINK network. Then again, the system represented by the LINK symbol puts the same customers in touch with their money, i.e. connects them with it, or allows them to transfer it from place to place. But I do not see that LINK is descriptive of the network itself, or of the activity of making use of it.
20. A main theme of Mr Mellor's submissions was that use of the word link in the opponents' mark was descriptive and, in this respect, was no different from that use in his own clients mark. - The registrability of either came from elsewhere - from CITIBANK and the FX prefix in the latter, and the 'link symbol' in the former. It is clear from the preceding paragraph that I do not agree. And there is nothing in the evidence submitted by the applicants that leads me to another conclusion. Would consumers in the summer of 1993 describe themselves as 'linking' with the funds in their bank accounts when extracting money from ATMs? Would this process be considered a link with their bank? It seems to me that if lack of distinctiveness in the word 'link' is one of the submissions on which the applicants are to base the acceptability of their own application, in the teeth of this opposition, the onus is on them to prove this point, and I think, based on the material I have seen, that they have failed.
21. Against this background, applying the principles delineated in *Pianotist* above, I have come to the conclusion that confusion is possible. The function of the opponents' mark is to indicate to their customers whether they can get cash from specific ATMs, that is, it identifies the network to its users. The customers know that an ATM carrying the mark is part of a group of companies, one of which maybe their own bank. They would expect, therefore, that ATMs so identified would also carry a proprietary house mark as well as the LINK symbol. I think there is a resonance, here, between this case and *Bulova Accutron Trade Mark* [1969] 4 RPC 102. In that case, the judge stated:

‘As I have already said, if what had to be considered was a side by side comparison, the additional word would have had a vital significance, but where imperfect recollection is relevant what has to be considered is how far the additional word is significant to prevent imperfect recollection and the resultant confusion. Particularly having regard to the fact that BULOVA is the house name of the applicants and has a significance other than as a trade mark, its addition before the word ACCUTRON does not in my judgment serve to prevent the deception or confusion which would in the view of the Court of Appeal have been caused but for that adoption.’

22. I note that members of the consortium have used the mark in this manner (PJH7 of Mr Houlihan’s Declaration), and though this evidence is well after the relevant date, and proves little, it seems to me indicative of the manner in which the opponents might use the mark - as an indicator of the LINK network, with the house mark of a member of it. The CITIBANK part of the applicants’ mark is liable to be considered in the same manner. Despite the presence of the FX- prefix in the applicants mark, I think there is enough here to conclude that a number of persons will be given cause to wonder whether it might not be the case that the two services originate from the same source - there is enough for them to entertain a reasonable doubt (*Application by Ladislav Jellinek* (1946) RPC LXII).
23. I have come to this finding, however, by way of my conclusion above that the applicants’ specification included the opponents ATM and EPTOS services, all being subsumed under the general banner of ‘banking services’. This represents the applicants best case. If one considers the ‘on-line foreign exchange transaction services’, and takes into account the other matter in both marks, I do not consider that confusion is likely. It seems that the solution to this case is an amendment to the specification.
24. Before I address that, it follows from this conclusion that I do not think it necessary to consider the s. 11 ground. In passing, I do not believe that the decision above will be altered if I do; though the evidence of user on behalf of the opponents is poor, I think I can safely assume that they used their mark on ATMs before the relevant date, and that would lead to much the same result as under s. 12.
25. A penultimate point on the evidence submitted. All of this material - from both sides - on use of the word ‘link’, either in terms of the opponents’ mark or elsewhere, is well after the relevant date. Mr Mellor stated:

‘..you can at least make the comparison at 1997/1 998 because you have got the two sides of the balance. On the one side, by the time you get to 1997, you have got increased use of the LINK symbol on ATMs, and you can balance that against the sort of use of LINK by other businesses that we see in these phone directories, and of course against those two elements you then balance the use that my clients have made of their mark CITIBANK FXLINK by the time you get to 1997, so in a way the problem over the dates in the evidence, they all, in my submission, balance each other out.’

This is not an approach I believe I could have adopted in this case. The lack of material evidence before 4th August 1993 provides me with no basis on which to measure the relevant weight of either sides evidence some 3 to 4 years later. There can be no assumption that the evidence has proportionately increased in weight in a manner that will allow me to extrapolate back to August 1994. Mr Mellor states in his skeleton argument:

‘At the relevant date (4th August 1993) we are not told how many ATMs were in the LINK network. Mr Aiken says (para 5) that by March 1997 there were 11,901 ATMs. Working back in time, in his Exhibit HA-2, there is a Nationwide leaflet, dated November 1996, which mentions “..8,000 machines that display the LINK symbol.” Clearly, the number in the system in 1993 is very likely to have been considerably smaller than 8,000. Mr Aiken could have told us the correct number in August 1993, but chose not to do so’.

This is a much more realistic approach: inadequate evidence from both parties is simply that and nothing else.

26. Turning back to a change to the applicants’ specification for their goods, should the applicants elect, within one month of the end of the appeal period for this decision, to file a TM21 amending their specification in the following manner:

‘On-line foreign exchange transaction services and associated banking services, all included in Class 36, excluding automatic teller machine (ATM) services and electronic funds transfer at point of sale services (EFTPOS) services’

the application will be allowed to progress. If the applicants do not file a TM21 restricting the specification as set out above the application will be refused in its entirety.

27. The opponents have made their case and, as I see no reason to exercise the Registrar’s discretion except to the extent indicated. Neither side is wholly successful, and I regard the matter as a ‘score draw’. I have therefore declined to make any costs award in this case.

Dated this 4TH day of May 2001

**Dr W J Trott
Principal Hearing Officer
For the Registrar
the Comptroller-General**