

O/289/19

TRADE MARKS ACT 1994

IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. 1367389
AND THE REQUEST TO PROTECT IN THE UK
THE TRADE MARK:

ENNOVA

AND

OPPOSITION THERETO UNDER NO. 412108

Background and pleadings

1. On 3 July 2017, ENN Group Co., Ltd (“the holder”) applied to protect in the UK international trade mark number 1367389 (“the contested mark”), shown below:

ENNOVA

The application was published for opposition purposes on 5 January 2018 in respect of the following services:

Class 35: Advertising; layout services for advertising purposes; marketing; business management of performing artists; relocation services for businesses; web indexing for commercial or advertising purposes; business auditing; sponsorship search; retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.

2. The application is opposed by Enova International, Inc. (“the opponent”). The opposition is based upon ss. 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under s. 5(2)(b), the opponent relies upon the following trade marks:

i) UK trade mark number 3076087 **ENNOVA** (“the 087 mark”)

Filing date: 8 October 2014; date of entry in register: 9 January 2015

Opposed services: Business auditing.

All of the services for which the mark is registered are relied upon, namely:

Class 36: Insurance; financial affairs; monetary affairs; real estate affairs; money lending; financial services connected with instalment loans, temporary loans, and payday loans; financing services connected with instalment loans for the purchase of home office furniture, office furniture, appliances, business equipment, electronics, house wares, furnishings, and jewelry, for businesses and consumers; money lending; short term consumer loan services; short term

loans; payday advances; payday loan services; lending on mortgages; providing deferred deposits and money orders; electronic funds transfer; financial overdraft protection; financial investigation services; financial analysis and financial consulting services; financial research; financial management; financial valuations; credit card and debit card services; charge card services; money exchange services; cheque verification; financial clearing; home banking; Internet banking; information and advisory services relating to all of the aforementioned services, including the provision of such information and advisory services on-line or via mobile communications devices.

- ii) UK trade mark number 3142447 **ENOVA DECISIONS** (“the 447 mark”)
Filing date: 30 December 2015; date of entry in register: 13 May 2016.

Opposed services: Advertising; layout services for advertising purposes; marketing; web indexing for commercial or advertising purposes; business auditing.

Registered in classes 9, 16, 35, 36, 42 and 45

Goods and services relied upon:

Class 9: Computer software for processing and analysing market information.

Class 35: Data management services for the understanding and predicting of consumers, businesses and market trends and actions; outsource service provider in the field of business analytics; collection and systemization of information into computer databases; information and data compiling and analysing relating to business management; business data analysis; compiling and analysing statistics, data and other sources of information for business purposes; business management consulting with relation to strategy, marketing, sales, operation, product design particularly specializing in the use of analytic and statistic models for the understanding and predicting of consumers, business and market trends and actions; business consulting services, namely, aggregating and providing data and information to assist others with the

evaluation of customer qualification for particular offers, programs, incentives and rate structures; consultation services in the field of company, business sector and industry data and research; profit survey and analysis; providing business intelligence services; advice and information about customer services and product management and prices on internet sites in connection with purchases made over the internet; assistance, advisory and consultancy with regard to business planning, business analysis, business management, business organization, marketing and customer analysis; arranging and conducting marketing promotional event for others; advice in the field of business management and marketing; business marketing consulting services; market research by means of computer database; general business networking referral services, namely, promoting the goods and services of others by passing business leads and referrals among group members; all the aforesaid provided in the fields of financial and monetary affairs, and banking.

Class 36: Financial and monetary services; provision of computerized financial information; business credit verification services.

Class 42: Data mining.

Class 45: Fraud and identity theft protection services.

3. The opponent claims that the marks are highly similar and the goods and services similar, which will give rise to a likelihood of confusion.

4. Further, the opponent claims under s. 5(4)(a) that it has used the sign **ENOVA** throughout the UK since 2007 in respect of software, financial services and analytics services. Under this ground, the opposition is directed against “advertising; layout services for advertising purposes; marketing; web indexing for commercial or advertising purposes; business auditing”. The opponent claims that it has acquired a significant goodwill and that use of the contested mark for the opposed services will amount to a misrepresentation, which will damage the opponent’s goodwill through, for example, dilution of its brands, diversion of sales and “the type of damage inherently caused by consumers being confused as to the origin of the services”.

5. The holder filed a counterstatement in which it denies all of the grounds of opposition. I note in particular that it denies that the goods and services are similar and puts the opponent to proof of its goodwill.

6. Given their filing dates, the opponent's trade marks are earlier trade marks in accordance with s. 6 of the Act. As neither mark had been registered for more than five years at the date on which the contested mark was published, neither is subject to the proof of use provisions contained in s. 6A of the Act. As a consequence, the opponent may rely upon all of the goods and services in its earlier registrations without demonstrating that it has used the marks.

7. Only the opponent filed evidence. Neither party requested a hearing but the opponent filed written submissions in lieu, which I will take into account. The applicant has been represented throughout by Appleyard Lees IP LLP and the opponent by Squire Patton Boggs (UK) LLP. This decision is taken following a careful reading of all of the papers.

Evidence

8. The opponent's evidence consists of the witness statement of Kirk Chartier, the Chief Marketing Officer for the opponent. I will summarise only the pertinent evidence.

9. Mr Chartier explains that the opponent is a company based in the US which offers consumers and small businesses credit and financing products. He states: "My Corporation trades in the United Kingdom and has done so since 2007. In the United Kingdom my Corporation's products are provided under the Trade Marks QuickQuid and Pounds to Pocket".¹ He provides prints from the opponent's website which appear to show that QuickQuid was launched in the UK in 2007 and that Pounds to Pocket has been active since at least 2012, though the prints themselves are undated.² The earlier mark only appears on the first page of the exhibit, apparently a landing page describing

¹ Chartier, §4.

² Exhibit XXX1.

the company and the world markets in which it operates. Information about the UK brands includes links to the relevant UK websites (QuickQuid.co.uk and PoundstoPocket.co.uk).

10. Mr Chartier also exhibits pages from CashEuroNet UK, QuickQuid and Pounds to Pockets' own websites, though these are again undated. The websites include statements that the companies are part of Enova International, which is described as "a pioneer of online lending" and having provided loans to individuals for over ten years. The opponent's other brands, which appear to focus on particular territories, are listed.

11. Extracts from a market insight report dated 2017 are included.³ One of the opponent's brands is in the top three lenders. It is described as follows: "CashEuroNet UK, a subsidiary of the US firm Enova International, which operates as QuickQuid and Pounds to Pocket in the UK".⁴ There is also evidence that CashEuroNet UK LLC generated significant revenue in the UK between 2009 and 2015, along with further information about the opponent company.⁵

12. Extracts from an investor presentation document show that Enova was the number one online short-term lender in the UK between 2015 and 2017, with over \$100 million UK revenue.⁶

13. Advertising sums are provided, which include the spending figures between January and June 2017.⁷ They amount to hundreds of thousands of pounds each month. The advertising is said to take place in the UK via the opponent's subsidiary CashEuroNet UK LLC.⁸

³ XXX4.

⁴ p. 4.

⁵ p. 42.

⁶ XXX5

⁷ XXX7.

⁸ Chartier, §11.

14. Five press articles dated between 15 November 2014 and 29 April 2017 are exhibited, from thisismoney.co.uk and, it appears, the *Telegraph*.⁹ “Enova” is variously mentioned as the owner and operator of UK brands/“lending sites” QuickQuid, Pounds to Pocket and On Stride Financial.

15. There is information regarding UK traffic to the opponent’s website www.enova.com.¹⁰ It covers the period 1 January 2017 to 31 July 2018, with no breakdown by month. It indicates 8,741 sessions from UK users with a bounce rate of 59.57% and 2.07 pages per session. Session duration is 76.34 but the unit of measurement is not given.

Section 5(2)(b)

16. Section 5(2)(b) of the Act reads 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”.

17. 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-

⁹ XXX8

¹⁰ XXX9.

342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly 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

18. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

19. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

20. It is permissible to group terms together in making the comparison if the considerations are similar: *Separode Trade Mark* BL O/399/10.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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 fur 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”.

22. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase”.

Advertising; marketing

23. The 447 mark’s specification includes the service of “business marketing consulting services; all the aforesaid provided in the fields of financial and monetary affairs, and banking”. The applied-for specification is not limited to any particular field and therefore covers advertising and marketing services in the same fields as the opponent’s business marketing consultancy services. The purpose of an advertising service is to devise and disseminate advertisements for products or services. Marketing is a broader service, including market research as well as advertising. Both terms are wide enough to cover the provision of advice about appropriate advertising/marketing strategies. Business marketing consultancy services will involve the same advice. I consider that the services are identical based on the principle in *Meric*. Even where the later mark’s services do not concern business marketing or advertising, they are still likely to be highly similar, the principal difference being in the type of advertising/marketing recommended, rather than a significant difference in the services themselves.

Layout services for advertising purposes; web indexing for commercial or advertising purposes

24. These services strike me as aspects of advertising services at large, as advice on layout or indexing forms part of the advertising service. On that basis, the services are, as subsets of advertising services, also provided under the earlier 447 mark's "business marketing consulting services; all the aforesaid provided in the fields of financial and monetary affairs, and banking". They are identical under *Meric*.

Business auditing

25. The 447 mark includes, in class 36, "financial and monetary services", whilst the 087 mark is protected for "financial affairs". Both of these earlier terms run the gamut of financial services. There is some similarity of purpose at a very general level, as the contested services are also concerned with financial matters (i.e. accounts). However, the specific purpose will differ and their nature is unlikely to coincide. There is no competition and the services are not complementary. The users will, though, overlap and it seems likely that there will be common channels of trade. They are similar to a low degree.

The average consumer and the nature of the purchasing act

26. It is necessary for me to determine both who the average consumer is for the respective parties' services and the manner in which these services are likely to be selected by the average consumer in the course of trade. 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”.

27. I have no submissions from the parties on the identity of the average consumer. The average consumer of the parties’ services in class 35 is a business user. The average consumer of the opponent’s services in class 36 may be either a business user or a member of the public. Across both groups, the average consumer is likely to make the selection of the services through primarily visual means, including websites, brochures and advertisements in print and online. Oral recommendations may play a part and there may, therefore, be an aural component to the purchase.

28. The services at issue involve finances, have potentially long-term implications, or may have an impact on the reputation of a company. The consumer in either group is likely to be fairly careful in the selection, considering, for example, not just price or value for money but also the provider’s suitability, reliability and experience in the field. The average consumer will pay a reasonably high level of attention in selecting the services at issue.

Distinctive character of the earlier trade marks

29. The distinctive character of the earlier marks must be assessed, as the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion (*Sabel* at [24]). In *Lloyd Schuhfabrik*, 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-2779, 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)".

30. The earlier "ENOVA" is an invented word which is inherently distinctive to a high degree. "ENOVA DECISIONS" contains the same invented word and the ordinary dictionary word "DECISIONS". However, the presence of the word "DECISIONS" does not reduce the distinctiveness of "ENOVA". This mark is also distinctive to a high degree.

31. There is no evidence of the mark "ENOVA DECISIONS" having been used. Although the opponent has filed evidence which shows that it undeniably operates a very successful business in the UK, it does not do so under the brand "Enova" but under brands such as QuickQuid. The only evidence of the use of the earlier "ENOVA" mark is in describing the opponent company. Even if that use were use as a trade mark, the evidence does not establish that the earlier mark has enjoyed significant exposure to the public which would result in an enhancement of its distinctive character.

Comparison of trade marks

32. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

33. 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”.

34. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

35. The trade marks to be compared are as follows:

Earlier trade marks	Contested trade mark
(i) ENOVA (ii) ENOVA DECISIONS	ENNOVA

36. The first earlier mark consists of the five-letter word “ENOVA”, presented in capital letters. There are no other elements to contribute to the overall impression, which is contained in the word. The second of the opponent’s marks consists of the words “ENOVA DECISIONS”. Although both words will contribute to the overall impression, the word “ENOVA” is the most distinctive component and will therefore have a greater impact on the consumer.

37. The later mark consists of the six-letter word “ENNOVA”, also presented in capital letters. The record shows that this is a figurative mark. However, while the mark is presented in a particular typeface, it is unremarkable. I doubt that it will have any impact on the average consumer. The overall impression is of the word “ENNOVA”.

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38. Visually, both marks share the letters “E-N-O-V-A”. The only difference is the addition of a second “N” in the later mark. They are visually similar to a very high degree.

39. The earlier mark may be articulated either as “EE-NOVA” or as “EN-OVA”. In the later mark, the double “N” means it is more likely to be verbalised as “EN-OVA”. The marks may, therefore, be aurally identical or aurally similar to a medium degree, with only the second syllable being identical.

40. Conceptually, neither mark has a meaning. The conceptual position is, therefore, neutral.

ENOVA DECISIONS v ENNOVA

41. There are visual differences because of the additional letter “N” in the later mark and because of the presence of the word “DECISIONS” in the earlier mark. However, the

words “ENNOVA” and “ENOVA” are very similar. The two marks have a medium degree of visual similarity.

42. The words “ENOVA” and “ENNOVA” will be verbalised as outlined above. The earlier mark contains an additional word of three syllables. Where “ENOVA” and “ENNOVA” are pronounced identically, there is a medium degree of aural similarity overall. Where those words have slightly different pronunciations, the marks as wholes have a fairly low degree of aural similarity.

43. The earlier mark contains the concept of “decisions”, which is of limited distinctiveness but nevertheless has no counterpart in the later mark. To that extent, there is a conceptual difference between the marks.

Likelihood of confusion

44. In deciding whether there is a likelihood of confusion, the factors considered above have a degree of interdependency and must be weighed against one another in a global assessment (*Canon* at [17]; *Sabel* at [22]). The various factors must be considered from the perspective of the average consumer, and a determination made as to whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

45. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

46. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting 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.

47. Considering the earlier “ENOVA” mark first, the marks are similar to a very high degree and the earlier mark has a high level of distinctive character. The services only have a limited degree of similarity. However, I am satisfied that the average consumer, paying a reasonably high level of attention but not immune to the effects of imperfect recollection will, in this case, directly confuse the marks. The similarities between the marks are such that these are not mitigated by the lower level of similarity between the services or the slightly higher level of attention. There is a likelihood of confusion.

48. Turning to the opponent’s “ENOVA DECISIONS” mark, it is important that I bear in mind not only the level of distinctiveness of the earlier mark but also the distinctiveness of the common element. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, 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, stating:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it”.

49. There is plainly a lesser degree of visual and aural similarity between these marks. There is, too, a conceptual difference. However, the common element (“ENOVA/ENNOVA”) is highly similar and that element is both highly distinctive and more dominant in the earlier mark. Even where there is only a low degree of similarity between the services, there is a likelihood of indirect confusion: the consumer is susceptible to misremembering the “ENOVA/ENNOVA” element and, while likely to notice the differences, will assume that the marks are different marks, or the latter is a sub-brand, used by the same economic undertaking. It follows that where the services are identical, confusion is only more likely. There is a likelihood of confusion.

Section 5(4)(a)

50. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

51. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, HHJ Clarke, sitting as a Deputy Judge of the High Court stated that:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)”.

52. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

53. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Daniel Alexander Q.C., sitting as the Appointed Person, considered the matter of the relevant date in a passing off case. He said:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made’”.

54. There is no evidence that the contested mark was in use prior to the date of application. That being the case, the relevant date is 3 July 2017.

55. The House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing

which distinguishes an old-established business from a new business at its first start”.

56. I have no doubt that the opponent ultimately owns a significant business in short-term loans. However, the question is whether the sign “ENOVA” is distinctive of that goodwill. In my view, it is not. All of the evidence is that the opponent trades in the UK under the brands QuickQuid and Pounds to Pocket. The evidence of customer-facing websites only indicates that the UK brands are part of the larger US company. The use of the earlier sign is very much inferior to the other marks and I doubt that it will have had much impact, if any, on the consumer. In any event, the website prints are not dated and it is impossible to know whether the company name featured at the relevant date. The market insight and investor reports do not establish that the relevant public has been exposed to the sign “ENOVA” in a way which would cause them to associate that sign with the goods and services: that sign has not, on the evidence before me, acquired a reputation among a relevant class of persons. The opposition under s. 5(4)(a) falls at the first hurdle and is dismissed accordingly.

57. Had the opponent established that it had goodwill associated with the sign (in relation to its short-term loans business; there is no evidence of other services), I would have found that there would be misrepresentation, for essentially the same reasons as given under s. 5(2)(b): the similarity between the signs is such that even a reasonably attentive consumer, in a field of activity with only limited overlap, would think that the services were those of the opponent. Damage of the most obvious types, namely diversion of sales or loss of control of the opponent’s reputation, is easily foreseeable. The opposition would have succeeded in full under this ground.

Conclusion

58. The opposition has been successful. The application will be refused for all of the opposed services. It will proceed to registration for the following, unopposed services only:

Class 35: Business management of performing artists; relocation services for businesses; sponsorship search; retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.

Costs

59. The opponent has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. Only the opponent filed evidence, which was light; its written submissions did not cover two pages. I take those factors into account. I award costs to the opponent on the following basis:

Official fee:	£200
Filing the notice of opposition and considering the counterstatement:	£200
Filing evidence and submissions in lieu:	£600
Total:	£1,000

60. I order ENN Group Co., Ltd to pay Enova International, Inc. the sum of **£1,000**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28th day of May 2019

**Heather Harrison
For the Registrar
The Comptroller-General**