

O/0194/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. 3656855 AND 3656848

IN THE NAME OF ONEFOR HOLDING GMBH

FOR THE TRADE MARKS

OneFor

AND



IN CLASSES 9, 16, 35, 36, 38 AND 42

AND

THE OPPOSITIONS THERETO UNDER NUMBERS 428979 AND 428981 BY

TSC VENTURES DESIGNATED ACTIVITY COMPANY

AND

THE OPPOSITIONS THERETO UNDER NUMBERS 428980 AND 428982 BY

BLACKHAWK NETWORK, INC.

Background and pleadings

1. This decision concerns the opposition to two trade mark applications filed by OneFor Holding GmbH (“the applicant”). The first of these, number 3656855, is for the mark OneFor, in classes 9, 16, 35, 36, 38 and 42. Although the application was filed in the UK on 17 June 2021, it was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union and the EU filing date was 1 December 2020. The EU filing benefited from an International Convention priority date from a filing in Germany on 17 June 2020.



3. The applications were published on 10 September 2021 and subsequently opposed by TSC Ventures Designated Activity Company (“TSC”) and Blackhawk Network, Inc. (“Blackhawk”), together “the opponents”, under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). TSC relies upon the following earlier trade mark registrations for its section 5(2)(b) and 5(3) grounds in oppositions 428979 and 428981:

(i) 906979264



Filing date: 11 June 2008; registration date: 20 May 2009. Colours claimed: Grey, orange, blue, purple, light yellow, dark yellow, light pink and dark pink.

Relying on goods and services in classes 9, 16, 35 and 36.

(ii) 913263108

The logo for 'One4all' features the word 'One' in white, '4' in a multi-colored square (purple, blue, yellow, pink), and 'all' in white. The text is set against a white background with a subtle drop shadow.

Filing date: 17 September 2014; registration date: 10 February 2015. Colours claimed: Grey; orange; blue; purple; light yellow; dark yellow; light pink; dark pink.

Relying on services in classes 38, 39 and 42.

(iii) 915749849

The 'One4all' logo is presented on a red, rounded rectangular background with a slight gradient and a drop shadow. The '4' is the same multi-colored square as in the previous logo.

Filing date: 12 August 2016; registration date: 14 March 2017. Colours claimed: Red; White; Yellow; Light Blue; Purple; Pink; Orange; Light Grey; Light Red.

Relying on goods and services in classes 9, 16, 35, 36, 38 and 42.

4. Blackhawk relies upon the following earlier trade mark registrations for its section 5(2)(b) and 5(3) grounds in oppositions 428980 and 428982:

(i) 3483428

One4All Favourites

Filing date: 22 April 2020; registration date: 10 August 2020.

Class 36: *Issuing stored value cards.*

(ii) 3483585



Series of two marks

Filing date: 23 April 2020; registration date: 9 October 2020

Class 36: *Issuing stored value cards.*

5. The opponents have ticked the relevant boxes in the respective forms TM7 (notices of opposition) for sections 5(2)(b) and 5(3) of the Act, but have not made any specific pleadings nor filed a Statement of Grounds.¹

6. Under section 5(4)(a) of the Act, the opponents claim that they have used signs corresponding to their registrations throughout the UK since 1 January 2006 in relation to the same goods and services covered in the specifications of their registrations. The opponents claim that the applications are similar to the opponents' signs in which they have accrued goodwill. They claim that there will be misrepresentation and damage will follow, under the law of passing off.

7. The applicant filed defences and counterstatements, denying the grounds of opposition. The counterstatements contain submissions and a comparison of goods and services which I will bear in mind at the appropriate point in this decision.

¹ They are not required to: see the decision of Phillip Johnson, sitting as the Appointed Person, in *Delta Air Lines, Inc v Ontro Limited*, BL O/044/21, at paragraph 22.

8. The opponents are represented by Barker Brettell LLP and the applicant by Murgitroyd & Company Ltd. After the filing of the defences and counterstatements, the opponents requested that all four sets of proceedings be consolidated on the grounds of procedural economy because the opponents are economically linked; both opponents being owned by the same overarching entity, Blackhawk Network Holdings Inc. The request was granted and there was no objection from the applicant. Only the opponents filed evidence: one set headed up to cover all four oppositions, which was the reason given for their consolidation request. The applicant filed written submissions. Neither party requested a hearing, and only the opponent filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers, referring to them as necessary.

Relevant dates for sections 5(2)(b) and 5(3) of the Act

9. In its notices of opposition, TSC ticked 'yes' to the question as to whether its earlier marks had been registered for five years or more at the application or priority dates of the opposed applications. A further box was ticked to state that the three earlier marks had been used in the five years ending on the dates of application or priority dates of the opposed applications. The applicant put TSC to proof of use of the three earlier rights in its counterstatement. However, TSC's affirmative statements were erroneously made in respect of one of the three earlier rights: 915749849. As can be seen from paragraph 2 of this decision, the registration date of earlier mark 915749849 is 14 March 2017. The priority dates of the opposed applications are 17 June 2020 and 25 June 2020. This is less than five years. The point wasn't raised in the Tribunal and it wasn't until the opponents filed their written submissions in lieu of a hearing that it surfaced, with the opponents saying:²

² In fact, the opponents are also wrong about the period for proof of genuine use: see below.

Evidence of use – Relevant Period

The opposed trade mark applications each have the priority filing date of 17 June 2020. As a consequence, "the relevant period" for evidence use in respect of Party A's earlier registrations that were granted over 5 years prior to that date will be **17 June 2015 to 17 June 2020**.

Party B's submissions of 14 September 2022, at paragraph 9, incorrectly identified the relevant period as 10 December 2016 to 10 December 2021, and these submissions subsequently reference the period as "2016 – 2021". This is incorrect and, as a consequence, any criticism of the evidence made by Party B that parts of the evidence of use falls outside of the relevant period must be dismissed.

Evidence of use – applicable earlier registrations

Given the relevant period, only the following earlier rights relied upon by Party A required the submission of evidence:

- UK registration no. 00906979264 One4all logo in Classes 9, 16, 35 and 36 (granted 20 May 2009); and
- UK registration no. 00913263108 One4all logo in Classes 38, 39 and 42 (granted 10 February 2015).

The remaining earlier rights were granted less than 5 years before the priority filing date of the opposed applications of Party A and, as a consequence, are not subject to proof of use requirements:

- UK registration no. 00915749849 One4all logo in Classes 9, 16, 35, 36, 38 and 42 (granted 14 March 2017); and
- UK registration no. 00003483428 One4All Favourites in Class 36 (granted 10 August 2020); and
- UK registration no. 00003483585 One4all Favourites logo in Class 36 (granted 09 October 2020)

As a consequence, any submissions filed by Party B, claiming that the evidence of use does not support UK registration no. 00915749849 as a basis for the opposition are irrelevant. That registration was granted less than 5 years prior to the filing dates, and priority filing dates, of the opposed applications and, as a consequence, there is no requirement to submit evidence of use to support that registration.

10. Apart from the opponents' own erroneous calculation of the proof of genuine period (as to which, see below), they are correct that 915749849, 3483428 and 3483585 are not subject to proof of genuine use.³ There is no legal basis under section 6A of the Act to consider whether 915749849 meets the requirements of genuine use, and therefore no legal basis for the applicant's request for proof of genuine use of that mark.

³ Of course, as they are relied upon for section 5(3) of the Act, there is a requirement to show evidence of a reputation at the priority dates of the applications.

11. The relevant dates for proof of genuine use of earlier marks 906979264 and 913263108 are:

- a) for the first application: 18 June 2015 to 17 June 2020; and
- b) for the second application: 26 June 2015 to 25 June 2020.

12. The relevant dates for assessment of the sections 5(2)(b) and 5(3) claims are 17 June 2020 in respect of the first application, and 25 June 2020 for the second application. I will deal with the relevant dates for the section 5(4)(a) claims later in this decision.

Evidence

13. The opponents' evidence comes from Jock Jordan, who is TSC's Director.⁴ Despite the consolidation request on the basis that the evidence would cover both opponents' oppositions to both applications, and the heading up of his witness statement with all four opposition numbers, Mr Jordan states:

"3. Since it is only the Opponent TSC Ventures Designated Activity Company who is required to demonstrate proof of use, this Witness Statement will solely be referencing TSC Ventures Designated Activity Company's use of the marks ONE4ALL relied on in their opposition and no references will be made to Blackhawk Network, Inc's use of the ONE4ALL marks, as relied upon in their opposition."

14. This has implications for Blackhawk's oppositions insofar as they are based upon sections 5(3) and 5(4)(a) of the Act. It also means that Blackhawk's earlier marks cannot lay claim to have acquired enhanced distinctive character for the purposes of the assessment of likelihood of confusion under section 5(2)(b) of the Act.

⁴ Witness statement dated 22 June 2022 and exhibits.

Section 5(2)(b) of the Act

15. Section 5(2)(b) states:

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

(a) ...

(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.”

16. Section 5A states:

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

17. As above, 915749849 is not subject to the proof of use provisions. This mark has a wider specification than the other earlier marks of both opponents and is registered for goods and services in the same classes as the opposed applications. It is also registered for a trade mark which is not significantly different to TSC’s other earlier marks, nor to those of Blackhawk, which are registered for a very narrow specification (*issuing stored value cards*).⁶ In the first instance, I will assess the section 5(2)(b) ground on the basis of TSC’s mark 915749849.

⁵ This section also applies to the grounds raised under sections 5(3) and 5(4)(a) of the Act.

⁶ The specifications of the other earlier marks are set out in the annex to this decision.

18. 915749849 is an earlier mark within the meaning of section 6 of the Act, having been filed earlier than the applications. Since it is not subject to the proof of use provisions, TSC is able to rely upon all the goods and services identified in its statement of grounds (the entire registration).

19. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are gleaned from the decisions of the Court of Justice of the European Union (“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 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.⁷

The principles

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

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

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

⁷ 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.

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

20. The parties' goods and services are shown in the table below (the specifications are the same in the two opposed applications):

Earlier mark 915749849	The applications
<p>Class 9: Electronic publications, smart cards, electronic multi retail vouchers, electronic credit cards, electronic debit cards, encoded cards, cards bearing stored information; telecommunications apparatus and equipment; recording, testing and regulating equipment; computer software and programs; data and databases recorded on data carriers; mobile apps.</p>	<p>Class 9: Debit cards and credit cards [encoded or magnetic]; software for processing electronic payments made by and for others; authentication software.</p>
<p>Class 16: Printed cards, printed matter, printed multi retail vouchers, printed publications, purchase cards and gift vouchers, magazines, stationery, diaries, pre-printed forms, identity cards, non encoded and non magnetic, instructional and teaching material, greetings cards.</p>	<p>Class 16: Cash cards and credit cards [not encoded or not magnetic].</p>
<p>Class 35: Organisation, operation and supervision of sales and promotional incentive schemes; provision of information relating to accounts; preparation of statements of account; data processing services; computerised record keeping, accounting and</p>	<p>Class 35: Business management; business administration, in particular data research in computer files, business investigations, commercial and business information, market research, market analysis; office functions, in particular office functions</p>

database management services; management of telephone call centres for others; registration services for electronic payment cards, financial cards, purchase cards and gift vouchers; user incentive schemes relating to gift vouchers; provision of promotional services; business planning, assistance and management services; business administration services; procurement services; business investigations and surveys; book-keeping and accounting services; tax assessment preparation; provision of information related to tax, tax consultancy and planning services; business consultancy and advisory services; provision of statements of account, credit card registration services for companies, business administration services; document reproduction services; computerised record-keeping, accounting and database management services; registration services for credit cards, charge cards, cash cards, cheque guarantee cards, debit cards, payment cards, financial cards and purchase cards; user incentive schemes relating to use of gift voucher cards; consultancy, information and advisory services relating to all the foregoing.

for payment and receivables management, including as back-up service determination of payment data.

Class 36: Banking, financial and monetary services; provision of financial services to support gift vouchers, foreign currency services; value added tax refund services; insurance services; valuation and financial appraisal services; administration of financial affairs; financial settlement services; trustee services; cash management services; cash dispensing services; financial card services; credit card, charge card, cash card, cheque guarantee card, purchase card, payment card and debit card services; rental, hire and lease equipment for processing foreign cards and data relating thereto; investment and savings services; financial advice relating to taxation; financial planning and investment advisory services; financial research; collateral agency services, namely those concerning additional and separate security for repayment of money borrowed; investment custody services; issuing of printed and electronic gift and multi retail vouchers; consultancy, information and advisory services relating to the foregoing.

Class 36: **Finance services; monetary affairs;** real estate affairs; **insurance;** electronic funds transfer services; electronic payment services with electronic processing of payment data; credit card and debit card transaction processing; bill payment services; mobile electronic payment services; finance services, in particular electronic capital transfer; providing electronic mobile payment services for others; electronic foreign exchange payment processing; payment processing services, namely, providing virtual currency transaction processing services for others; clearing and reconciling financial transactions via a global computer network; finance services, in particular the provision of financial information, financial analysis, financial consultancy, financial services for the processing of debt purchases for third parties; monetary affairs, in particular collection of outstanding debts [collection transactions], payment and receivables management, review of the creditworthiness and soundness of commercial enterprises and private individuals, providing information in the area of debt collection and financial receivables in call centers, credit assessment and credit rating and risk assessment on the basis of

<p>Class 38: Telecommunications, communications, telephone, fax, telex, message collection and transmission, and electronic mail services; transmission and reception of data and of information; electronic message delivery services; data interchange services; transfer of data by telecommunication; broadcasting or transmission of radio or television programmes; video text services; television screen based text transmission services and view data services; video conferencing services; telecommunication of information including web pages; providing user access to the Internet; providing telecommunications connections to the Internet or databases; computer-aided transmission of messages and images; advice, information and consultancy services related to the aforementioned.</p>	<p>mathematical-statistical calculations [scoring], including the preparation of score cards.</p> <p>Class 38: Electronic transmission of payment data.</p>
<p>Class 42: Application service provider; technological services; research services; design services; provision of on-line information, advice and consultancy relating to application</p>	<p>Class 42: Scientific and technological services and design relating thereto, in particular design of score cards; providing temporary use of online non-downloadable software for processing</p>

service provider services, technological services, research services, design services.	digital or electronic payments; providing temporary use of online non-downloadable authentication software for controlling access to and communication with mobile terminals, computers and computer networks.
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21. In its counterstatements, the applicant admits that certain of its goods and services are identical. I have emboldened these in the above table. The applicant admits that its class 9 goods are identical to those of the class 9 specification corresponding to TSC's earlier mark 906979264. The same goods are covered by TSC's 915749849, with the addition of *mobile apps*. The applicant's class 9 goods are therefore identical.

22. In class 35, the applicant admits that its *business management* and *business administration* are identical.

23. In class 36, the applicant admits that its *finance services; monetary affairs* and *insurance* are identical to the TSC's financial and monetary services and insurance services.

24. The applicant submits that none of the other goods or services covered by its applications are similar to the goods and services of the earlier marks.

25. The law requires that goods/services be considered identical where one party's description of its goods/services encompasses the specific goods/services covered by the other party's description (and vice versa).⁸ I find that the following goods and services are identical, either on this basis, or because the term is the same or almost so in both parties' specifications:

- Class 16: the applicant's *Cash cards and credit cards [not encoded or not magnetic]* are identical to "printed cards, printed matter";

⁸ *Gérard Meric v OHIM*, Case T-33/05, General Court.

- Class 35: the applicant's *office functions, in particular office functions for payment and receivables management, including as back-up service determination of payment data* are identical to "business administration" "computerised record keeping, accounting and database management services" and "book-keeping and accounting services";
- Class 36: All of the applicant's class 36 services are covered by "banking, financial and monetary services". Further, and noting that what follows "in particular" is a subset of the term that precedes "in particular",
 - *electronic funds transfer services; electronic payment services with electronic processing of payment data; bill payment services; mobile electronic payment services; finance services, in particular electronic capital transfer; providing electronic mobile payment services for others; electronic foreign exchange payment processing; payment processing services, namely, providing virtual currency transaction processing services for others; clearing and reconciling financial transactions via a global computer network;* are identical to "banking, financial and monetary services";
 - *credit card and debit card transaction processing* is identical to "financial card services; credit card, charge card, cash card, cheque guarantee card, purchase card, payment card and debit card services";
 - *finance services, in particular the provision of financial information, financial analysis, financial consultancy, financial services for the processing of debt purchases for third parties* are identical to "banking, financial and monetary services" and "consultancy, information and advisory services relating to the foregoing" ("foregoing" includes these services relating to banking, financial and monetary services);
 - *monetary affairs, in particular collection of outstanding debts [collection transactions], payment and receivables management, review of the creditworthiness and soundness of commercial enterprises and private individuals, providing information in the area of debt collection and financial receivables in call centers, credit assessment and credit rating and risk assessment on the basis of mathematical-statistical calculations*

[scoring], including the preparation of score cards is identical to “monetary services”;

- Class 38: the applicant’s *Electronic transmission of payment data* is identical to “transmission ... of data”;
- Class 42: the applicant’s *technological services* are identical to “technological services”; the applicant’s *design relating [to scientific and technological services], in particular design of score cards*, is identical to “design services”.

26. The remainder of the applicant’s services are not manifestly identical, requiring an assessment to be made as to whether the respective goods and services are similar and, if they are, how similar. In comparing the parties’ specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the 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.”

27. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

28. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court of the European Union (“GC”) stated that “complementary” means:

“82 ... there is a close connection between [the goods], 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...”.⁹

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

“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.”

30. I have found that all of the applicant’s goods and services are clearly identical to those of earlier mark 915749849, except for:

- Class 36: real estate affairs; and
- Class 42: scientific services; providing temporary use of online non-downloadable software for processing digital or electronic payments; providing temporary use of online non-downloadable authentication software for controlling access to and communication with mobile terminals, computers and computer networks.

31. The earlier mark (nor any of the other earlier marks) does not cover real estate services or affairs. In *Bankia SA v OHIM*, case T-323/14, the GC held that financial and banking services are not similar to estate agency services. The court held that the nature, purpose and method of the services is different; that estate agency services are not generally provided in the same places as financial and banking services; and although the purchase of properties often involves the use of financial services the relationship between the services is not such that consumers expect the providers of

⁹ In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods and services.

the services to be the same or economically connected. Consequently, the services are not complementary within the meaning of the case law. None of the other goods and services of the earlier mark are similar to real estate affairs.

32. Although the earlier mark does not specify scientific services, it covers technological and research services. Research services is a very broad term, which includes scientific research; and scientific services include research. On this basis, there is identity. Even if there is not strict identity, scientific services and research services are highly similar. I note that in *K.A. Schmearsal Holding GmbH & Co. KG v EUIPO*, at paragraph 58, the GC stated that “Scientific and technological services and research and design relating thereto’ may, for their part, be defined as being services intended, more broadly, to conceptualise various projects in a technically in-depth manner.”¹⁰ The purpose of both is to make scientific findings, the users of both will be consumers looking for solutions, improvements and knowledge advancement in a scientific field, they may both take place in laboratories at the same premises (such as universities), and they are complementary.

33. The earlier mark covers “application service provider”. Applications, or ‘apps’, are software. The applicant’s providing temporary use of online non-downloadable software for processing digital or electronic payments; providing temporary use of online non-downloadable authentication software for controlling access to and communication with mobile terminals, computers and computer networks are another way of describing software as a service. The earlier services are unrestricted as to the type of application. It seems to me that the services are identical. If that is not right, the services are highly similar, having significant overlap in nature, purpose, users, channels of trade and a potentially competitive relationship.

The average consumer and the purchasing process

34. As the caselaw cited above indicates, it is necessary to decide who the average consumer is for the parties’ goods and services and how they purchase them.

¹⁰ Case T-527/18.

“Average consumer” in the context of trade mark law means the “typical consumer.”¹¹ The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.

35. The parties’ specifications include a number of broad terms, in relation to which the average consumer could be a business consumer or a member of the general public. There do not appear to be any goods or services which would entail less than a medium degree of attention, and some will cause a reasonably high degree of attention to be paid, given the infrequency of selection and the importance to, e.g. the operation of a business or the selection of financial services. Both groups of consumers are likely to make their purchases on a primarily visual basis, having seen websites and/or physical premises. There may also be an aural dimension to the purchase, when seeking advice, consultancy or receiving recommendations.

Comparison of marks

36. The marks to be compared are:

Earlier mark 915749849	The applicant’s marks
	<p data-bbox="1034 1447 1209 1487">OneFor</p> 

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

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

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

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

39. The overall impression of the first application resides in the conjunction of the words One and For. The second application also contains these words, with ONE appearing above FOR on a black square. The overall impression is dominated by the words, with the square serving as a background to enable the white words to be seen. The earlier mark comprises the conjoined words and numeral One4all superimposed upon an irregular rectangle. One4all dominates the overall impression of the mark.

40. The earlier mark includes a claim to various colours. This does not much affect the visual comparison because the applicant's marks could be used in colour. However, the arrangement of colours in the numeral 4 is arbitrary and the same arrangement in the later marks would not be notional and fair use. This acts as a point of visual difference.

41. The first application is presented in upper and lower case. The O and the F are in upper case, which reinforces the impression that the mark comprises the words One and For. The only point of visual similarity between the earlier mark and the first application is the word One, also presented with a capital O in the earlier mark. There is a low to medium degree of visual similarity between these marks. There is less visual similarity between the earlier mark and the second application. This is because the words in the latter are presented above each other and the shape of the backgrounds are different, although still quadrilateral. I note that the 'e' in the second application is a lower case 'e', whilst the other letters in the mark are upper case. However, I am doubtful that this plays much of a part in the consciousness of the average consumer, who is likely simply to read the words ONE FOR. Therefore, the common lower case 'e' in the earlier mark and the second application does not increase the visual similarity beyond a low degree.

42. The backgrounds and colours will not be seen in oral use of the marks. Although the words in the second application are not on one line, the natural reading of the mark will be the top word followed by the bottom word. Importantly, the articulation of the numeral 4 will sound exactly the same as the word FOR in the later marks. This means that the only aural difference between the marks is the word 'all', which acts as the third syllable in the earlier mark. The first two syllables of the parties' marks sound identical. There is a medium to high degree of aural similarity.

43. I take it as a notorious fact that the numeral 4 is commonly used in place of, or as shorthand for, the word FOR. It depends on context, but the appearance of 4 in between words where it would make sense to use the word FOR, means that 4 will be understood as meaning FOR. That is the case here: the earlier mark will be perceived as the phrase 'One for all'. As a concept, the mark will be understood as something which has universal application or can be used universally. The 'universal' meaning is not present in the later marks. These consist of an unfinished phrase 'One For', leaving the notion of what the something is for as unanswered. The backgrounds will be seen simply as backgrounds and do not affect the conceptual comparison. The marks have a medium degree of conceptual similarity.

Distinctive character of the earlier mark

44. 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.¹² I will begin by considering the inherent distinctive character of the earlier mark before looking at the use that TSC has made of its mark.

45. Financial, businesses and information technology goods and services which can be used by or for all, or for all applications or for all places, is not a very distinctive idea. However, the earlier mark is not of the very lowest distinctiveness as the words do not describe specific use of the goods or services. The dominant part of the mark, which is the part which is common to the contested marks, has a low to medium degree of inherent distinctiveness.

46. Distinctive character is a measure of how strongly the earlier mark identifies the goods or services for which it is registered, determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identify the goods or services as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

“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).

¹² *Sabel BV v Puma AG*, Case C-251/95.

47. The evidence from Mr Jordan, for TSC, concerns only gift cards. He states that TSC has used the earlier mark in the UK since 2006. Mr Jordan provides the following data:

Year	Volume	Value (£ sterling)
2016	1,235,824	135,488,296
2017	1,396,904	159,589,086
2018	1,563,851	179,967,351
2019	1,784,166	201,777,983
2020	2,916,385	257,609,218
2021 (to 6 th November 2021)	1,051,296	81,756,670

48. The 'value' is presumably how much money customers buying a gift card load onto it, or the value of a pre-paid card. If that is right, the 'value' figures by themselves do not show how distinctive the mark has become. However, Mr Jordan gives some figures regarding the size of the market in the UK for gift cards. He states that in 2021, the Gift Card and Voucher Association estimated the UK market for gift cards to be around £6.9 billion, an increase of almost £1 billion since 2019. TSC's value figures appear to comprise a sizeable proportion of those figures. I place no weight on the 'prompted' and 'unprompted' brand awareness figures which Mr Jordan provides. There is no information as to how the research has been conducted to result in prompted and unprompted awareness. Some of the research included in Exhibit BB07 comprises the results of surveys. The filing of such evidence requires the Tribunal's permission.¹³ I do note, however, coverage of the mark in the UK national press prior to the relevant date.¹⁴

49. I would have thought that the 'volume' figures represent how many gift cards were sold, but the figures in the table above do not match the following table:

¹³ Tribunal Practice Notice 2/2012 refers.

¹⁴ Exhibits BB07 and BB12.

Year	Units sold
2016	1,857,869
2017	2,179,889
2018	2,340,671
2019	2,473,647
2020	1,641,593
2021	1,522,227

50. Mr Jordan explains that, up until 2019, TSC's gift cards were only sold by Post Offices. From 2019 onwards, TSC expanded its outlets to include Tesco and Morrisons supermarkets. The following amounts were spent on marketing, including through magazines, posters, point-of-sale positioning and ATM advertisements:

Year	Point of Sale	Corporate	Internet	Black Hawk Network Spend	Total
2016	£50,602,254	£12,756,832	£4,784,413		£68,143,499
2017	£61,775,369	£14,863,781	£6,417,640		£83,056,790
2018	£67,884,635	£17,572,732	£7,072,896		£92,530,263

2019	£71,187,635	£20,894,179	£8,933,253		£101,015,067
2020	£47,398,817	£34,777,954	£14,790,187	£26,874,328	£123,841,286
2021	£46,032,802	£29,092,110	£16,447,409	£58,801,791	£150,374,112

51. Examples of advertisements are given in Exhibit BB04. They appear to be proofs, which are dated prior to the relevant date, such as this one from 2017:

One4all Rewards

A perfect reward for staff & customers

Accepted in over 50,000 outlets nationwide & online

Customised card designs | Employee incentives
Trade marketing campaigns | Fast & Free delivery

www.one4allrewards.co.uk | t: 0207 608 2008
e: corpsales@one4allgiftcard.co.uk

Gift Prepaid Limited is authorised by the Financial Conduct Authority under the Electronic Money Regulations 2011 (register reference 900230) for the issuing of electronic money.

Page 2

52. Exhibit BB06 comprises a list of over 120 stores and outlets which accepted TSC's gift cards between 2016 and 2021. Many UK high street stores are listed. Exhibit BB11 is a report covering 1 December 2016 to 31 December 2021 of the performance of TSC's social media platforms showing the earlier mark. Mr Jordan provides the following table as a summary of the key data in the report:

UK Channels	Followers	Reach	Impressions	Engagements
Facebook	28,573	9,345,926	52,082,456	1,216,091
Instagram	5,682	N/A	17,433,030	13,715
Twitter	33,546	N/A	7,630,585	333,599

53. In 2020, TSC's gift card was the winner for the best new product, service or innovation and a finalist for best Covid response initiative at the Gift Card & Voucher Association Awards.

54. The evidence shows a significant level of consistent use, including in major UK retail establishments, and a healthy market share. I find that the distinctiveness of the earlier mark had been enhanced to a high level by the relevant date, but only in respect of gift cards.

Likelihood of confusion

55. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. I have found that all of the applicant's goods and services are identical or highly similar to those covered by the earlier mark with the exception of *real estate affairs*, for which there is no similarity. If goods or services are not similar, there can be no likelihood of confusion, *per Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*¹⁵ The section 5(2)(b) ground of opposition fails against *real estate affairs*. Neither opponent is in any better a position if the other earlier marks are considered. Blackhawk only has cover for issuing stored value cards, which are not similar to real estate services. The other two earlier marks pleaded by TSC do not include real estate affairs or any goods or services which would survive the proof of use test other than gift cards, which are not similar to real estate affairs.

56. I have found that the inherent distinctiveness of the earlier mark is low to medium, but enhanced in relation to gift cards. The only affect this has upon the global assessment of the likelihood of confusion is in relation to the applicant's class 16 cash cards. A cash card in class 16 includes gift cards. There is otherwise no apparent similarity between gift cards and the applicant's goods and services (and there are no submissions from the TSC on the point). The evidence has no effect on Blackhawk's

¹⁵ "22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar."

case under section 5(2)(b) because Mr Jordan expressly states that the evidence concerns TSC's use of its marks, not Blackhawk.

57. I bear in mind that the marks are similar visually only to a low, or low to medium degree and are predominantly purchased visually, with at least a medium, and in some cases a reasonably high, degree of attention paid to the purchase. That said, the common, similar element is dominant in both marks and the backgrounds, whilst not negligible, are somewhat banal and unmemorable. The substitution of 4 for the word FOR is ripe for imperfect recollection. Direct confusion occurs where marks are mistaken for one another, flowing from the principle 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 which has been retained in the mind.¹⁶ A similar concept arises from the marks, even if the additional 'all' in the earlier mark adds a further conceptual layer. The conceptual difference is not pronounced. I note that in *Nokia Oyj v OHIM*, Case T-460/07, where there was a pronounced conceptual difference, the GC stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

58. In *Diramode S.A. v Richard Turnham and Linda Ann Turnham*, BL O/566/19, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, having quoted from the CJEU's judgment in *Wolf Oil Corp. v. EUIPO*, Case C-437/16 P, observed;

“28. The Court thus emphasised that there is no rule to the effect that visual and aural similarities are automatically neutralised by conceptual differences. It insisted upon the need for two distinct stages in the analysis of the overall likelihood of confusion, with the first being directed to ‘a *finding of the conceptual differences between the signs at issue*’ and the second being

¹⁶ *Lloyd Schuhfabrik Meyer*, at [26].

directed to ‘assessment of the degree of conceptual differences’ with a view to determining whether they ‘may lead to the neutralisation of visual and phonetic similarities’.”

59. I find that there is a likelihood of direct confusion in respect of all of the goods and services in the applications, other than real estate services. Even if the differences between the marks are recalled sufficiently that the marks are not directly confused, the common dominant elements and the identity and high degree of similarity will lead to a belief on the part of the average consumer, even those paying a relatively higher degree of attention, that the marks emanate from the same or an economically linked undertaking. This type of confusion was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *Back Beat Inc v L.A. Sugar (UK) Limited*, BL O/375/10:

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

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite

distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

60. That the three categories in that case are non-exhaustive was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others*.¹⁷ The assumption will be that the parties’ marks are brand variants, brand updates or indicate expansions to what goods and services are offered. In finding indirect confusion between marks that consist of more than one component, the components do not have to be the same to conclude that there is a likelihood of confusion.¹⁸ I have not forgotten that I should not simply take one component of the applicant’s marks and compare it with the earlier mark. My conclusion is based upon imperfect recollection of the common, dominant component, which has a similar conceptual hook and is prone to imperfect recollection. For the applicant’s cash cards, the likelihood of both types of confusion is increased because of the high level of distinctiveness of the earlier mark for gift cards.

Section 5(2)(b) outcome

61. The section 5(2)(b) ground succeeds in relation to all the applicant’s goods and services except for *real estate affairs*.

¹⁷ [2021] EWCA Civ 1207.

¹⁸ *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch)

Section 5(3) of the Act

62. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

63. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12 P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation

and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

64. Question 3 in the section of the form TM7 (notice of opposition) covering section 5(3) claims poses the following question: "Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?"

65. The opponents both answered this question in the same way: by ticking the box 'yes'. No additional explanation was provided. This part of the opponents' pleadings is clearly based upon the proposition that there is a likelihood of confusion amongst the public in that the marks are used by the same or related undertakings. The next part of the form TM7 asks: "Is there any other basis for your claim of unfair advantage? If so, please explain what the advantage would be to the holder of the later mark, and why it is unfair." Neither opponent answered this question, nor the questions which followed about detriment to repute and distinctive character.

66. This means that the opponents' section 5(3) case is entirely based upon there being confusion. I have found no likelihood of confusion in relation to *real estate affairs*. Consequently, this ground is not made out in relation to *real estate affairs* and does not take the opponents any further than the section 5(2)(b) claim. In fact, the ground is far narrower because the opponents can only rely on their earlier marks to the extent that there is a qualifying reputation. TSC has a reputation only for gift cards. Blackhawk is not even on the page as far as section 5(3) is concerned because it has been expressly excluded from the evidence by TSC's witness and has filed no evidence of its own. The opponents' section 5(3) ground fails.

Section 5(3) outcome

67. The section 5(3) ground fails.

Section 5(4)(a)

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

“(4) 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, where the condition in subsection (4A) is met,

(aa) [...]

(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.”

69. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

70. The three elements which the opponent must show are well known. In *Discount Outlet v Feel Good UK* [2017] EWHC 1400 (IPEC), Her Honour Judge Melissa Clarke, sitting as a Deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“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).”

71. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 at 223:

“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.”

72. In a case where the contested mark is unused, it is the date when the application was made for the contested mark which is the relevant date for the purposes of section 5(4)(a) of the Act. However, if the contested mark has been used prior to the date of application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about. If an applicant for registration was not passing off when it commenced use of the sign, a continuation of the same trade under the same sign is unlikely to amount to passing off at the application date.¹⁹ The applicant has not filed evidence that it has used its marks, which means that the relevant dates are 17 June 2020 and 25 June 2020. The opponents must show that

¹⁹ *Advanced Perimeter Systems Limited v Multisys Computers Limited* [2012] R.P.C. 14, Mr Daniel Alexander KC, sitting as the Appointed Person.

they had sufficient goodwill at those dates to bring the claim. There has been no evidence from Blackhawk, and Mr Jordan expressly excludes Blackhawk from his evidence. Blackhawk's section 5(4)(a) ground fails.

73. I consider that TSC has shown evidence of a substantial goodwill in the business distinguished by its signs in relation to gift cards. There is no evidence in relation to the other goods and services of the earlier marks' specifications.

74. Although the average consumer test is not strictly the same as the 'substantial number' test, in the light of the Court of Appeal's judgment in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments. TSC's passing off case is much narrower than its section 5(2)(b) case. For section 5(2)(b) it is able to rely upon notional and fair use across the width of its specifications for earlier mark 915749849, but for its passing off ground its goodwill is in its business only in relation to gift cards. There is no similarity between gift cards and the applicant's goods and services except for the applicant's cash cards in class 16. Although lack of similarity based upon the comparison of goods and services caselaw for section 5(2)(b) is not fatal to a passing off case, the distance between the parties' commercial activities is far from unimportant.²⁰ Other than for the applicant's class 16 cash cards, the section 5(4)(a) ground fails. It succeeds in relation to cash cards, for which there would be misrepresentation and damage.

Section 5(4)(a) outcome

75. TSC's opposition under section 5(4)(a) succeeds only in relation to cash cards in class 16.

²⁰ *Harrods Limited v Harrodian School Limited* [1996] RPC 697.

Overall outcome

76. The oppositions partially succeed. The applications are refused for all goods and services except for *real estate affairs*, for which they may proceed to registration.

Costs

77. The opponents have had the most success, except in relation to real estate affairs, and are entitled to a contribution towards their costs, reduced on a broad brush basis to take account of the measure of success on the part of the applicant. The oppositions succeeded (partially) on the basis of one of TSC's earlier rights and TSC's goodwill (although the section 5(4)(a) was only successful against a tiny fraction of the applications). However, the opponents requested consolidation and therefore the award is a joint cost award.

78. Awards of costs are based upon the scale in Tribunal Practice Notice 2/2016. I have made the minimum award for the opponents' written submissions in lieu of a hearing as many of the 22 pages consisted of lengthy reproduction of the parties' specifications, without any submissions of substance as to similarity between goods and services, and standard caselaw used in decisions of this Tribunal. The award covers the parts of the submissions which addressed the specific issues of these proceedings. The notices of opposition filed by the two opponents were very similar to each other, so the award reflects the repetition and fact that there were no statements of grounds or free text inserted into the boxes on the forms to explain further the opponents' claims. Blackhawk's oppositions could not have succeeded under the section 5(3) and 5(4)(a) claims because the evidence expressly did not cover use by Blackhawk of its marks or signs. The reimbursement of its fees is therefore reduced to £100 for each of its oppositions, which is what Blackhawk would have paid to file an opposition under section 5(2)(b) only.

79. I award costs as follows:

Statutory fees for the oppositions x 4	£600
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Preparing statements and considering the counterstatements	£600
Preparing evidence	£600
Written submissions in lieu of a hearing	£300
Less 5% for the applicant's success x 2	£210
Total	£1890

80. I order OneFor Holding GmbH to pay to TSC Ventures Designated Activity Company ("TSC") and Blackhawk Network, Inc. the sum of **£1890**. 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 24th day of February 2023

Judi Pike
For the Registrar

Annex: the earlier marks other than 915749849

906979264

Class 9: Electronic publications, smart cards, electronic multi retail vouchers, electronic credit cards, electronic debit cards, encoded cards, cards bearing stored information; telecommunications apparatus and equipment; recording, testing and regulating equipment; computer software and programs; data and databases recorded on data carriers.

Class 16: Printed cards, printed matter, printed multi retail vouchers, printed publications, purchase cards and gift vouchers, magazines, stationery, diaries, pre-printed forms, identity cards, instructional and teaching material, greetings cards.

Class 35: Organisation, operation and supervision of sales and promotional incentive schemes; provision of information relating to accounts; provisions of statements of account; data processing services; computerised record keeping, accounting and database management services; call centre services; registration services for electronic payment cards, financial cards, purchase cards and gift vouchers; user incentive schemes relating to gift vouchers; provision of promotional services; business planning, assistance and management services; business administration services; procurement services; business investigations and surveys; book-keeping and accounting services; tax assessment preparation; provision of information related to tax, tax consultancy and planning services; business consultancy and advisory services; provision of statements of account, registration and administration services for companies; document reproduction services; computerised record-keeping, accounting and database management services; registration services for credit cards, charge cards, cash cards, cheque guarantee cards, debit cards, payment cards, financial cards and purchase cards; user incentive schemes relating to use of gift voucher cards; consultancy, information and advisory services relating to all the foregoing.

Class 36: Banking, financial and monetary services; provision of financial services to support gift vouchers, foreign currency services; value added tax refund services; insurance services; valuation and financial appraisal services; administration of

financial affairs; financial settlement services; trustee services; cash management services; cash dispensing services; financial card services; credit card, charge card, cash card, cheque guarantee card, purchase card, payment card and debit card services; rental, hire and lease equipment for processing foreign cards and data relating thereto; investment and savings services; financial advice relating to taxation; financial planning and investment advisory services; financial research; collateral agency services, namely those concerning additional and separate security for repayment of money borrowed; safe custody services; issuing of printed and electronic gift and multi retail vouchers; consultancy, information and advisory services relating to the foregoing.

913263108

Class 38: Telecommunications, communications, telephone, fax, telex, message collection and transmission, and electronic mail services; transmission and reception of data and of information; electronic message delivery services; data interchange services; transfer of data by telecommunication; broadcasting or transmission of radio or television programmes; video text services; television screen based text transmission services and view data services; video conferencing services; telecommunication of information including web pages; providing user access to the Internet; providing telecommunications connections to the Internet or databases; computer-aided transmission of messages and images; advice, information and consultancy services related to the aforementioned.

Class 39: Travel agency services, booking agency services, arranging, booking and reserving holidays, travel and tours by land, sea and air; delivery services; information, advice and consultancy services relating to the aforementioned.

Class 42: Application service provider; technological services; research services; design services; provision of on-line information, advice and consultancy relating to all the services in this class.

3483428 and 3483585

Class 36: Issuing stored value cards.