

O/542/21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3430602

BY DATASWIFT LIMITED

TO REGISTER

The logo for Dataswift, featuring a stylized blue 'D' icon followed by the word 'Dataswift' in a bold, blue, sans-serif font.

AS A TRADE MARK IN CLASSES 35 AND 42

AND

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO 419057 BY
SOCIETY FOR WORLDWIDE INTERBANK FINANCIAL
TELECOMMUNICATION SCRL**

BACKGROUND AND PLEADINGS

1. On 23 September 2019, Dataswift Ltd (“**the Applicant**”) applied to register the figurative mark  in respect of services in Classes 35 and 42, as follows:

Applied-for services

Class 35: Business assistance, management, administrative services; Collection and systemisation of business data; Data management services; Computerised data verification; Data processing management; Data retrieval services; Database management

Class 42: IT services; Hosting services; Software as a service; Platform as a service; Hosting of platforms on the internet; Design and development of databases; Data warehousing; Data analysis; Data migration services; Data security services; Online data storage; Data encryption services; Data security consultancy; Electronic data storage and data back-up services; Computer services concerning electronic data storage

2. The application was published for opposition purposes on 11 October 2019. On 13 January 2020, the Opponent filed a Form TM7 notice of opposition against the application, invoking grounds based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“**the Act**”).¹ Each ground is claimed against the whole of the application.

The section 5(2)(b) claim

3. For its section 5(2)(b) claim, the Opponent relies on the following three marks in the table below:

The Opponent’s earlier marks	
SWIFT (‘the Opponent’s Word Mark’)	EUTM No. 3838381 Filing date: 17 May 2004 Registration date: 16 October 2006 Registered for goods and services in Classes 9, 16, 35, 36, 37, 38, 41 and 42

¹ An amended version of the Form TM7 was filed on 29 January 2020.

 <p>(‘the Opponent’s Device Mark’)</p>	<p>International Registration WE1048048</p> <p>Priority date: 16 November 2009 Date of designation of the EU: 11 May 2010 Date protection granted in the EU: 21 July 2011</p> <p>Registered for goods and services in Classes 9, 16, 35, 36, 38, 41 and 42</p>
 <p>(‘the Opponent’s gpi Logo Mark’)</p>	<p>EUTM No. 18092772</p> <p>Filing date: 10 July 2019 Registration date: 30 November 2019</p> <p>Registered for goods / services in Classes 9, 35, 36, 38 and 42</p>

4. The filing dates of all three of the trade marks relied on by the Opponent predate those of the contested application and qualify as “earlier marks” under section 6(1)(a) of the Act. The Opponent’s Word Mark and its Device Mark had been registered for more than five years on the date on which the contested application was filed and so are subject to the use provisions under section 6A of the Act. The Opponent’s Form TM7 contained statements of use of the Word Mark and Device Mark in respect of all the goods and services on which it relies, which, both for its section 5(2)(b) and 5(3) grounds, is all of the goods and services for which those earlier marks are registered. I shall refer to the earlier specified goods and services to the extent I consider necessary. The Opponent’s gpi Logo Mark had not been registered long enough to engage the use provisions.²
5. The Opponent’s claim under section 5(2)(b) is essentially that the marks are highly similar and that the services covered by the Applicant’s specification are the same as, or highly similar to, goods and services covered by the earlier marks, leading to a likelihood of confusion on the part of the public. The Form TM7 gives reasons in support of the claimed similarity between the marks and between the goods and services, which I shall refer to later.

² These opposition proceedings were launched before IP Completion Day (i.e. before 11pm on 31 December 2020). In line with the legal position as explained in Tribunal Practice Notice 2/2020, the transitional provisions provide that these proceedings should continue to be dealt with under the Act as it existed before IP Completion Day (i.e. the old law continues to apply), such that EUTMs and IR(EU)s continue to constitute earlier trade marks for the purpose of these proceedings.

6. The Opponent also claims that its earlier marks have been used on an extensive scale in the EU and in the UK and accordingly enjoy **enhanced distinctive character**, which operates to “heighten the likelihood of confusion and making it even more likely that consumers would associate the applied-for mark with the Opponent.”

The section 5(3) claim

7. Additionally, or alternatively, the Opponent claims that use of the Applicant’s marks in relation to all or any of services in the application would take unfair advantage of, and cause detriment to, the reputation of the Opponent’s Device Mark and the Opponent’s Word Mark.³ This position is based on the following claims detailed in the notice of opposition/statement of grounds:
- i. *Reputation:* the Opponent’s Word Mark and Device Mark have been used for years in the UK on an extensive scale, enjoy a significant **reputation for all their registered goods and services** and the marks are associated exclusively with the Opponent in the area of **finance and related software, technology and business services**.
 - ii. *Unfair advantage of the reputation of the earlier marks:* The services specified in the application are identical or highly similar to the goods and services covered by the Opponent’s marks with a reputation, and there is therefore a high likelihood that the relevant public will believe that the goods and services are from the same undertaking – this reflects the section 5(2)(b) claim, with the overlay that a likelihood of confusion is increased by the **investment made by the Opponent in marketing its marks** over a number of years. The Opponent claims that by arousing an association in the mind of consumers with the Opponent’s mark, where none exists, use of the applied-for mark would **free ride** on the Opponent’s reputation. The Applicant has not made the same level of investment in marketing its own brand and would unfairly take advantage of the repute the Opponent’s marks.
 - iii. *Detriment to reputation of the earlier marks:* The marks and services at issue are highly similar, and the Opponent has no control of the quality of services provided by the Applicant. The implications of poor quality services being provided under the applied-for mark could have a negative impact on the consumer’s view of the

³ The Opponent’s gpi Logo Mark is not relied on for the section 5(3) claim.

Opponent's trade mark, creating a real risk of damage to the Opponent's reputation for the quality of its own products and services.

- iv. *Detriment to distinctive character of the earlier marks:* The marks and services at issue are highly similar, and the Opponent has no control over the services provided by the Applicant. Use of the applied-for mark would **dilute and diminish** the distinctive character of the Opponent's marks with a reputation and consumers would accordingly be less capable of identifying them as an **exclusive indicator of origin**, and, as such, consumers would be **less likely to purchase** the Opponent's goods and services.

The section 5(4)(a) claim

8. Under section 5(4)(a) of the Act, the Opponent's claim is that when the Applicant applied to register its trade mark, use of the mark applied for, in respect of any of the services specified in the application, was liable to be prevented under the law of passing off. The Opponent claims unregistered rights based on significant goodwill attached to two of its

signs equivalent to its **Word Mark** and its **Device Mark** i.e. the word SWIFT and .

It claims use of the signs **throughout the UK** dating back to 1973, and that **longstanding use** has generated **goodwill** in respect of the goods and services listed in its Form TM7 as follows, which, I note, align almost exactly with the goods and services specified in Classes 9, 16, 35, 36, 38, 41 and 42 under the Opponent's Device Mark.

Goods and services for which goodwill is claimed:

Computer software relating to financial communication, software relating to encryption, to identification and customer relations, software relating to the equalization, compensation and reporting of financial transactions; downloadable electronic publications relating to financial communication, including publications containing guidelines and standards for the financial community.

Instructional and teaching material (except apparatus); printed goods, including directories, indexes, user manuals and publications containing guidelines and standards for the financial community.

Business advice, consultancy and information; professional business consultancy, including that provided to financial institutions; business management assistance and business management consultancy, including that provided to financial institutions; organization of exhibitions for commercial or advertising purposes, for the financial community; maintaining and updating of computer databases.

Financial affairs; monetary affairs; electronic exchange and money market transactions; financial information provided via a secure global electronic communication network, including information on exchange and money market transactions; providing financial information via a web site; advisory services in the field of financial transactions with regard to modelling, improving, harmonizing and recording standardized electronic messages.

Software development, installation and maintenance services; data analysis services; secure transmission of messages relating to financial transactions and consulting relating thereto; data transmission between financial institutions and companies by means of a secure global electronic communication network; providing user access to a secure global electronic communication network; electronic transfer of information relating to transactions involving payments, securities, commercial paper and cash flow; rental of access to a secure global electronic communication network reserved for the financial community.

Training in the field of computer software, standards and installation services and to software maintenance, all relating to financial communication; organization of exhibitions and conventions for educational purposes, for the financial community; publishing services for printed matter, directories, indexes and user manuals relating to financial communication, publication of standard financial messages; including the on-line publication thereof; arranging of conventions for commercial or advertising purposes for the financial community.

Installation, implementation, integration, design and maintenance of computer software relating to financial communication and assistance services relating thereto; providing electronic encryption services; certification services for applications, software installation and maintenance services, connections and consultations for others, all in the field of financial communication; hosting of third-party computer software and services on-line; certification services based on digital signatures.

The Applicant's defence and counterstatement

9. The Applicant filed a Form TM8 notice of defence along with a counterstatement. I note the following points:

Proof of use

- i. The Applicant expressly indicated, in its response to Question 7 in the Form TM8, that it did not want the Opponent to provide proof of use, thereby **accepting the Opponent's statements of use**, with the consequence that the Opponent's Word Mark and Device Mark may be relied upon for all of the goods and services identified in the statement of use, which is to say all their registered goods and services.

Section 5(2)(b)

- ii. In response to the **section 5(2)(b) claim**, paragraph 4 of the counterstatement reads: "It is denied that the Application is similar to the Opponent's Marks...". Looking across various usages in the counterstatement, the above reference to "the Opponent's

Marks” appears intended to mean the marks themselves – but this point is not clear and it could be construed as a reference to the Opponent’s trade mark registrations as wholes.

- iii. At any rate, at paragraphs 6 and 7 of the counterstatement the Applicant **denies** that the parties’ marks have a **high degree of visual or aural similarity** and submitted that the marks “are **not sufficiently visually similar**” nor “**sufficiently aurally similar**”. It also denied that the parties’ marks have a high degree of conceptual similarity and submitted that “there **cannot exist any conceptual similarity.**” I’ll refer to more detailed points from the counterstatement later in this decision.
- iv. Paragraph 4 goes on to **deny** “That the **goods of the Application are identical or similar to those of the Opponent’s Marks.**” Here the reference to “the Opponent’s Marks” must refer to the Opponent’s registrations. Since there are no “goods of the Application”, I take this as intended to deny that the applied-for services are identical or similar to the goods and services relied on by the Opponent. However, at paragraph 11 of the counterstatement the Applicant “admitted that both the Application and the Opponent’s marks’ specifications relate generally to computer software” but “... **denied that such similarity is sufficient** for consumers to establish a likelihood association.” It did not explain this position, but simply stated the case-law principle that in assessing similarity, all relevant factors relating must be considered, “including their nature, and uses, method of use the device is there in competition or complementary.”⁴
- v. Paragraph 12 of the counterstatement states that “for the Opponent to succeed in its opposition, it **must provide evidence** that there is a likelihood of confusion by reference to the general public between the Application and the Opponent’s marks.” On this point I will comment below on the extent to which the assessment of a claim under section 5(2)(b) is notional in nature (and not necessarily evidence-based).
- vi. The same paragraph states “... As detailed above there is a lack of similarity between the Application and the Opponent’s marks. Due to this lack of similarity, there is **no likelihood of confusion** on behalf of the public in respect of the Application.” Since it is only in relation to the marks themselves that the counterstatement provides a

“detailed” position, the reference to “the Opponent’s marks” could be taken to refer to the similarity of the marks themselves, but my assessment of a likelihood of confusion will anyway take account of the Opponent’s position as to the similarity of the respectively specified goods and services.

- vii. I note that the counterstatement makes **no denial of the claim to enhanced distinctiveness**.

Section 5(3)

- viii. In response to the **section 5(3) claim**, the counterstatement restates that the Application lacks similarity to the Opponent’s marks and that there is therefore no risk that the public will consider the Applicant to be economically linked with the Opponent, or that the marks are used by the same undertaking.

- ix. It states that “in addition, there is no argument that the Applicant has taken any unfair advantage or exploited the opponent in any way.” (Again, I shall say more about the notional considerations I must bear in mind in determining the grounds of opposition.) The counterstatement continues: “**the clear differences between the Application and the Opponent’s Marks will rid any association between the marks**, therefore any efforts of the Opponent would not have any impact on the Applicant. The Applicant has not and **will not ‘free ride’** or receive any positive influence from any efforts of the Opponent, and the Applicant **will not cause any detriment** to the opponent, again **due to a lack of similarity and a lack of confusion.**”

- x. I note that the counterstatement makes **no denial of the reputation** of the marks claimed by the Opponent.

Section 5(4)(a)

- xi. In response to the section 5(4)(a) ground, the counterstatement contains no denial as such, but it does require the Opponent to prove the following matters:
 - a. “that the Opponent has generated goodwill in the term “SWIFT” attached to the Application services under Classes 35 and 42”.
 - b. “that the purchasing public (of the Application services) identifies the term ‘SWIFT’ as specifically distinctive of the Opponent’s goods/services”.

- c. “that the use of the Application in relation to the services for which it is applied for could constitute a misrepresentation; that the Applicant’s services relate to the Opponent’s goodwill.”
- d. “that this alleged misrepresentation could damage the Opponent’s goodwill.”

Papers filed, hearing and representation

10. Both parties filed evidence, as I indicate below. An oral hearing took place before me by video-conference on 28 April 2021. Victoria Jones attended as counsel for the Opponent, instructed by Marks & Clerk LLP; the Applicant’s legal representatives are Lawdit Solicitors Limited and at the hearing Michael Coyle of that firm attended for the Applicant. Skeleton arguments were filed in advance. I have read all the papers filed and will refer to aspects of the evidence and of the parties’ submissions or claims where I consider it warranted to do so.

EVIDENCE

11. The **Opponent’s evidence in chief** comprised a Witness Statement of Mr Patrick Krekels, with Exhibits 1-20, 22-23 and 26-28. Mr Krekels is the General Counsel for the Opponent. He provides evidence in this witness statement of the Opponent’s business, its customers and of use of the earlier marks in the United Kingdom.
12. The **Applicant’s evidence** comprises a Witness Statement of Irene Ng dated 27 November 2020, with Exhibit IN1. Ms Ng is the Chief Executive Officer of the Applicant. Her witness statement addresses the nature of the Applicant’s business and its use of the Mark.
13. Mr Krekels filed a further Witness Statement with Exhibits PK1 – PK9, as **evidence in reply** to the evidence from Ms Ng.
14. Ms Ng’s evidence indicates that the Applicant is a personal data management company, formed in October 2015, that seeks to “develop ways in which people can donate their data rather than having it simply taken”.⁵ The Applicant’s business anticipates a data economy where the value of data is of benefit to everyone, where personal data is an asset class, owned by individuals, transactable with organisations, standardised for exchanges, yield-generating as a market, and regulated for stewardship. The Applicant

5 Paragraph 1, 5 and 6 Ms Ng’s witness statement and page 27 Exhibit IN1, dated March 2020.

seeks to enable organisations and governments to implement and benefit from this new economy through the development of technology, tools and infrastructure.

15. Mr Krekels' evidence includes the following points, none of which appears contested by the Applicant:
- i. The Opponent was founded in 1973, with the aim of solving the communication issues surrounding cross-border payments.
 - ii. It operates in more than 200 countries and facilitated over 5.6 billion messages in 2014.
 - iii. Its main business lies in the provision of a secure and market leading interbank financial transaction messaging network under its SWIFT trade mark.
 - iv. The network is used by all major banks and financial institutions in the UK and facilitates payments sent by the Opponent's customers and is designed to increase security around completion of payments and transactions sent between different banks to the benefit of banks and their customers.
 - v. The public end-user is exposed to the SWIFT mark by being required to provide a SWIFT reference number or code as part of the service transaction.
 - vi. Integral to the network is ensuring the processing, management, storage and security of data concerning transactions facilitated and processed via the network; such services are part and parcel of the core business interest of the Opponent under its SWIFT trade mark.
 - vii. The Opponent's product and service offering includes not only IP-based financial messaging and related services and software and hardware, but also cloud-based software interfaces and platforms,⁶ the provision of business consultancy services, business administration services, database management services, encryption services and data security,⁷ and business intelligence services, involving the use of data for the purposes of analysis of latest and historic market trends and intelligence to help guide business and policy decisions.
 - viii. Its product and services are named to incorporate SWIFT with other elements such as SWIFTNet, SWIFTNet Link, SWIFTRef, SWIFTSmart, SWIFT gpi, SWIFT index, mySWIFT, SWIFTSmart, SWIFT Scope.⁸

6 Exhibit PK2

7 For instance, Exhibit 28 highlights the SWIFT Customer Security Programme (CSP) to support customers in the fight against cyber-attacks.

8 Exhibit 13, 15, and 23.

- ix. The SWIFT brand is highly regarded in its sector, the strength of its reputation indicated by its role engaging with bodies such as regulators and the Bank of England over matters of regulation, systems and government policies.
- x. The Opponent's achieved revenues of around £93 million in 2019. The Opponent spent over 400,000 Euros in each of the years 2016 – 2018 on events in the UK where the SWIFT brand was promoted.⁹ The Opponent also facilitates a global financial services networking event (SIBOS), including seminars on business management and analysis, including of operations and infrastructure.¹⁰
- xi. The Opponent has won various awards for its services, including winner of the payment services and data services categories of the Central Banking Awards in 2020 and the award for Outstanding Contribution to Treasury Innovation, at the Treasury Management International Awards 2019.¹¹

NOTIONAL NATURE OF THE LEGAL CONSIDERATIONS

16. In view of various references in the Applicant's counterstatement, in Ms Ng's witness statement and in the Applicant's skeleton argument, it is worth noting, as Ms Jones correctly observed at the hearing, that since these are opposition proceedings and not infringement proceedings, the task of the tribunal is to consider the Applicant's specification of services and notional use of that specification (rather than the Applicant's business in actual practice) and to compare that with the Opponent's specification, or its prior rights. This is particularly important where a specification is expressed in broad terms. In the present case the Applicant's includes terms such as, for example, IT services: hosting services, design and development of databases, which are not expressed to be limited or narrowed down to a particular service or field of operation. To that extent, while background information about the Applicant's business focus and the development of its mark may (quite understandably) be of uppermost significance in the mind of the Applicant, it is of limited relevance that, whereas the Opponent's services focus on banking transactions and the financial sector, the Applicant's mark is currently in use or intended to be in use for a consumer-focused data management offering. As for the Opponent's services, the specification is again the key element for 5(2) and 5(3),

9 Mr Krekels first witness statement paragraph 26.

10 Exhibit 20

11 Mr Krekels first witness statement paragraph 34 and Exhibit 27.

but the actual use of the marks by the Opponent is relevant when it comes to assessing enhanced distinctiveness, reputation for 5(3) and goodwill for 5(4)(a).

APPROACH IN THIS DECISION

17. At the hearing, Ms Jones focused on the Opponent's Word Mark "SWIFT" on the basis that it is closest in similarity to the contested mark, and also because it is relied on in relation to all three grounds of opposition. I agree that the SWIFT Word Mark itself is clearly the closest of the three earlier registrations relied on. The other marks themselves are less similar because they involve significant figurative elements different from any present in the contested mark; however, I note that there are some differences in the specifications of the goods and services under each of the earlier registrations, and that certain specified terms in those specifications may be more similar to the contested goods and services. I too will focus on the SWIFT word mark and will address the others only if necessary,

DECISION OF THE CLAIMS

The section 5(2)(b) grounds

18. 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".
19. Determination of a section 5(2)(b) claim must be made in light of the following principles, which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P. The principles are:

- (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 the goods and services

20. All services in the application are contested, and are those in Classes 35 and 42 set out at paragraph 1 above (and itemised for comparison purposes below, after paragraph 27). The goods and services for which the SWIFT Word Mark is registered and on which the Opposition is based are in Classes 9, 16, 35, 36, 37, 38, 41 and 42. As noted above, the Opponent has not been put to proof of use and is thus entitled to rely on all its registered goods and services. Ms Jones argued the Applicant's case by focussing on a) the specification for the Word Mark only and b) on the goods/services most similar to those in the Applicant's specification, which Ms Jones argued to be all of the goods and services **registered in Classes 9, 35 and 42 under its Word Mark** as follows:

Class 9: Apparatus for data processing, transmission and reproduction of data, including computer terminals, coders and decoders, scramblers, screens and other peripheral equipment for computers; software, magnetic, optical and electronic data carriers, provided with computer programs or not; computer hardware and software to enable secure e-commerce (including electronic transactions and electronic remittances); software for use in digital signatures and certification based on public key cryptography.

Class 35: Business management; business administration; office functions; business advice relating to finances and organisation, in particular to financial institutions.

Class 42: Development of computers and peripheral equipment for computers and software for use in a telecommunication network; system analysis and adaptation of individual computer systems to the network system; writing and adapting of computer programs; rental of computers and peripheral equipment for computers; development of computers and software to enable secure e-commerce (including electronic transactions); consultancy with respect to securing e-commerce and electronic transactions; provision of

digital signatures and the supporting certification services based on public key cryptography; provision of software for electronic message security.

21. I note that the terms ‘in particular’ and ‘including’ in the Opponent’s list of services indicate that the specific services are only examples of items included in the category and that protection is not restricted to them.¹²

22. Section 60A(1)(a) of the Act makes clear that services are not to be regarded as being similar to each other only on the ground that they appear in the same class under the Nice Classification. Rather, in determining the extent to which the respective goods and services at issue may be considered similar or identical, I take account of the relevant case-law guidance. In *Canon*, the Court of Justice of the European Union (“**the CJEU**”) gave the following guidance, that:

“In assessing the similarity of the goods ... all the relevant factors relating to those goods .. 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”.¹³

23. In *Boston Scientific*, the General Court described goods as “complementary” in circumstances where “... *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*”.¹⁴ The principle, expressed in relation to goods, applies comparably to services. I also take note that in *Kurt Hesse v OHIM*, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.¹⁵

24. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case¹⁶ for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

12 09/04/2003 T-224/01 Nu-Tride EU:T:2003:107

13 Case C-39/97, at paragraph 23.

14 *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

15 Case C-50/15 P

16 *British Sugar PLC v James Robertson & Sons Ltd* [1996] R.P.C. 281

- (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.
25. Moreover, the principle in *Gérard Meric* is that where services designated by an earlier mark are included in a more general category designated by a trade mark application - or vice versa - such services may be considered identical.¹⁷
26. Nonetheless, it is also necessary to take into account the need for specifications of services, which are inherently less precise than specifications of goods, to be “interpreted in a manner which confines them to the core of the ordinary and natural meaning rather than more broadly”.¹⁸
27. At paragraph 34 of the skeleton argument filed on its behalf, the Applicant admits that there is some overlap in the general concept between the applied-for services and the Opponent’s registered goods and services, but argues that the *actual* overlap between the parties’ services is minimal. I have already clarified above the extent to which the legal analysis proceeds on a notional basis, which is all the more so where no proof of use has been requested and where applied-for services are not specifically limited; consequently the fact that the parties’ services may not in reality (or currently) overlap, does not assist the Applicant in my assessment of the similarity of the goods and services below.

The Applicant’s contested services in Class 35

Business assistance, management, administrative services; Collection and systemisation of business data; Data management services; Computerised data verification; Data processing management; Data retrieval services; Database management

¹⁷ See paragraph 29 of the ruling of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, EU:T:2006:247.

¹⁸ per Arnold J in *FIL v Fidelis Underwriting* [2018] EWHC 1097 (Pat) at [86]. See too *YouView Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] where Floyd J equally cautioned (in the context of goods) against straining the language unnaturally so as to produce a narrow meaning. I note too the principles of interpretation as set out in *Sky v Skykick* [2020] EWHC 990 (Ch), at [56].

28. Business assistance – these applied-for services are specified in terms clearly wide enough to encompass the Opponent’s “*business advice relating to finances and organisation, in particular to financial institutions*” and are therefore **identical**.
29. Business management services – these applied-for services are clearly **identical** to the Opponent’s specified “*business management*”.
30. Business administrative services - these applied-for services are **identical** to the Opponent’s ‘*Business administration*’.
31. Collection and systemisation of business data; Data management services; Computerised data verification; Data processing management; Data retrieval services; Database management – Ms Jones addressed these remaining services applied for in Class 35 together, making submissions as to similarity that in part reflected findings by the EUIPO Opposition Division, based on precisely the same comparison of services (and between the same parties). A copy of that decision was included with the Opponent’s skeleton argument.¹⁹ It was submitted that this selection of applied-for services are used by businesses to perform the day-to-day operations that are required to enable them to function. These applied-for services are thus **similar** to the Opponent’s “*office functions*” and/or “*business administration*” and/or the Opponent’s “*business advice relating to finances and organisation, in particular to financial institutions*” as they coincide in purpose, relevant public and may be provided by the same kind of undertakings. I recognise that these six contested services focus on data management, whereas “*office functions*” is a far broader term; nonetheless, I accept that “*office functions*”, “*business advice relating to finances and organisation*” and certainly “*business administration*” may include as a central element, effective management of data. I find these services may be considered similar to a **medium degree**.
32. I also accept, as Ms Jones further submitted, that the applied-for services of ‘*Collection and systemisation of business data; Data management services; Computerised data verification; Data processing management; Data retrieval services; Database*

19 EUIPO decision dated 28/01/2021 Opposition Number B 003111533. That opposition succeeded based on the same SWIFT Word Mark to an EUTM application for a mark identical to that contested herein and including the same services, EUIPO decisions are not binding authority on a UK tribunal, and it is noted, for instance, that the perspective of the relevant average (UK) consumer in the present case differs from that of the Italian-, Romanian- and Spanish-speaking public on which the EUIPO findings were based. That said, given the extent to which trade mark law is harmonised and aligned at a European level, and notwithstanding the UK’s withdrawal from the European Union, there is no fundamental reason for the two different Offices to take a different approach in this case in relation to the findings of similarity of services.

management' are **similar** to the Opponent's Class 9 goods - "*Apparatus for data processing, transmission and reproduction of data, including computer terminals, coders and decoders, scramblers, screens and other peripheral equipment for computers; software, magnetic, optical and electronic data carriers, provided with computer programs or not; computer hardware and software to enable secure e-commerce (including electronic transactions and electronic remittances); software for use in digital signatures and certification based on public key cryptography*" – on the basis that these goods are **complementary** to those services. Such apparatus is indispensable for the provision of the services, and on the basis of the Opponent's evidence that it offers both such goods and services, I am prepared to accept that the consumer think that they were the responsibility of the same undertaking.

The Applicant's contested services in Class 42

IT services; Hosting services; Software as a service; Platform as a service; Hosting of platforms on the internet; Design and development of databases; Data warehousing; Data analysis; Data migration services; Data security services; Online data storage; Data encryption services; Data security consultancy; Electronic data storage and data back-up services; Computer services concerning electronic data storage

33. IT Services – the applied-for 'IT Services' include the Opponent's "*Development of computers and peripheral equipment for computers and software for use in a telecommunication network; writing and adapting of computer programs; Development of computers and peripheral equipment for computers and software to enable secure e-commerce (including electronic transactions)*" and are therefore **identical**. (Indeed, the breadth of the term 'IT Services' could be said on a plain reading to encompass all of the Opponent's services in Class 42.)
34. Data security services – these applied-for services include the Opponent's "*provision of software for electronic message security*" and are therefore **identical**.
35. Data security consultancy - these applied-for services are **highly similar** to the Opponent's "*provision of software for electronic message security*" as the services correspond in purpose, user, channels of trade and are complementary.

36. Data encryption services - these applied-for services include the Opponent's "*provision of software for electronic message security*" and the Opponent's "*provision of digital signatures and the supporting certification services based on public key cryptography*" and are therefore **identical**. Alternatively, these services are **highly similar** given the overlap in nature, purpose, user, channels of trade and complementarity.
37. Design and development of databases - these applied-for services may be considered **highly similar** to the Opponent's "*writing and adapting of computer programs*" and/or "*development of software for use in a telecommunication network*" as the services coincide in their nature and purpose, distribution channels, relevant public and may be provided by the same kind of undertakings.
38. Hosting services; Hosting of platforms on the internet – As I understand it, hosting services involve the provision of applications, IT infrastructure components or functions that the service user may access typically through an internet connection. Such hosting services cover a wide spectrum of shared or dedicated offerings, including web hosting, off-site backup and virtual desktop, video hosting and blog hosting, shopping cart software and email hosting.
39. Ms Jones submitted that these applied-for services may be considered highly similar to the Opponent's "*writing and adapting of computer programs*" and/or "*rental of computers and peripheral equipment of computers*" and/or "*consultancy with respect to securing e-commerce and electronic transactions*", notably in terms of their nature, origin/providers and recipients.
40. Having in mind the core of the services, I do not consider these to be highly similar. In my view, the Opponent's "*rental of computers and peripheral equipment*" suggests a service of leasing of hardware, although I recognise that such may be complementary to the applied-for "*hosting services*". Likewise, "*writing and adapting of computer programs*" will be a complementary element of a dedicated hosting service (so too the Opponent's "*Development of computers and peripheral equipment for computers and software for use in a telecommunication network*"). I also find that the Opponent's "*consultancy with respect to securing e-commerce and electronic transactions*" and "*development of computers and peripheral equipment for computers and software to enable secure e-commerce (including electronic transactions)*" may be complementary to web hosting services. Taken overall, including the nature, origin/providers and recipients of the

services, I find **a medium degree of similarity** in respect of the contested *“hosting services; hosting of platforms on the internet.”*

41. Software as a service; platform as a service - As I understand it, the applied-for “Software as a service” offers an alternative to installing and maintaining software on local hardware, where the customer instead accesses software via the Internet as a service. “Platform as a service” is a cloud computing model where a third-party provider delivers hardware and software tools to users over the internet. The provider hosts the hardware and software on its own infrastructure, thereby avoiding the need for users (usually application developers) from having to install in-house hardware and software to develop or run a new application.
42. Ms Jones submitted that the applied-for “software as a service” and “platform as a service” are highly similar to the Opponent’s *“development of computers and peripheral equipment for computers and software for use in a telecommunication network; writing and adapting of computer programs; development of computers and peripheral equipment for computers and software to enable secure e-commerce (including electronic transactions); consultancy with respect to securing e-commerce and electronic transactions”*. I also note that the Opponent’s Class 42 service include *“provision of software for electronic message security”*, which presumably may be provided by a subscription method. Taken overall, I find **a high degree of similarity** in respect of these contested services – *“software as a service”* and *“platform as a service”* - based on considerations of nature, purpose, potential methods of use, complementarity and that they may have the same origin/providers and target the same relevant public.
43. Data warehousing; data migration services; online data storage; electronic data storage and data back-up services; computer services concerning electronic data storage – all of these applied-for services are about storing and moving data. Ms Jones submitted that these applied-for services are highly similar to (amongst other services) the Opponent’s *“development of computers and peripheral equipment for computers and software for use in a telecommunication network”* and the Opponent’s *“development of computers and peripheral equipment for computers and software to enable secure e-commerce (including electronic transactions)”*. I find those services to be complementary, and to potentially coincide in nature and purpose, distribution channels, target the same relevant public and may be provided by the same kind of undertakings. Having in mind the core

of the services, I find a **medium degree of similarity** in respect of these contested services.

44. *Data analysis* - Ms Jones submitted that these applied-for services are highly similar to the Opponent's "system analysis and adaptation of individual computer systems to the network system" as they are similar in nature and distribution channels and may have the same origin/provider, and will target the same relevant public. In my view, data analysis might more naturally imply scrutinising gathered data to draw conclusions as to trends and patterns etc. However, this conception is not distant from scrutinising a system (which inevitably involves data) and making adaptations to improve matters in the context of a network system. Having in mind the core of the services, I find a **medium degree of similarity** in respect of these contested services.
45. I also accept, on the basis of the evidence, and as Ms Jones further submitted, that the applied-for services "*Data warehousing; Data analysis; Data migration services; Data security services; Online data storage; Data encryption services; Data security consultancy; Electronic data storage and data back-up services; Computer services concerning electronic data storage*" are **complementary** and therefore **similar** to some of the Opponent's Class 9 goods.

The average consumer and the purchasing process

46. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select them. 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.²⁰ In *Hearst Holdings Inc*,²¹ Birss J. (as he then was) 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 relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical... [it] does not denote some form of numerical mean, mode or median."

²⁰ *Lloyd Schuhfabrik Meyer*, Case C-342/97

²¹ *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)

47. Most of the applied-for **services in Class 35**, and the Opponent's services in the same class, will be of primary interest to businesses, such that the average consumer is the business public.
48. Some of the applied-for **services in Class 42** - such as "*platform as a service*" - will be of primary interest to businesses such that the average consumer group will include the business public. However, the Class 42 services include some that may be used by the general public, such as "*electronic data storage and data back-up services*". The Opponent's services in Class 42 likewise include some of interest both to a business and the general public (for instance, "*provision of software for electronic message security*").
49. The average consumer of the Opponent's **goods in Class 9** will include businesses, but some of the goods will also reach or be of interest to the general public.
50. The average consumer will likely see the marks on product literature, websites and exhibitions and may hear the marks spoken for example, in meetings or in oral recommendation, or, as an end-user, as part of the process of accessing a service. Visual considerations may predominate in the purchasing process, but aural considerations are also relevant.
51. Services such as "*business management services*" are normally contracted on an infrequent basis, often for specific purposes, are quite expensive and may have serious consequences for the functioning of a business. Businesses tend to pay a higher degree of attention in their purchasing decisions than does the general public.
52. Ms Jones noted that for many of the services that would be provided to a business customer e.g. the Opponent's "*computer hardware and software to enable secure e-commerce (including electronic transactions and electronic remittances)*" or the Applicant's '*data security services*' or '*data encryption services*' there will be an end user e.g. the individual wishing to make an electronic transaction or who wishes to ensure that their data will be secure when providing it to the relevant business. Ms Jones also noted that where goods/services are purchased by a number of different average consumers, the likelihood of confusion must be judged in light of the lowest level of attention that would be paid to the purchasing act.²² Nonetheless, I find that whether purchased by a

member of the general public or the business public, the goods and services will be purchased with **not lower than a medium level of attention**.

Comparison of the marks

53. It is clear from *Sabel* 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 in *Bimbo* 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.”²³
54. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. For procedural economy, I will continue the Opponent’s focus on what I have agreed is its most similar mark, so that the marks to be compared are:

The contested Mark:	
The Opponent’s Word Mark	SWIFT

Overall impressions of the marks

55. The overall impression of the **Opponent’s Word Mark** lies in the plain word “SWIFT”.
56. Although the **Applicant’s Mark** is a figurative mark, the Applicant accepts that it is a stylisation of the word “Ddataswift”.²⁴ The stylisation of the opening letter D contributes to the overall impression, but the lowercase font of most of the mark appears entirely

²³ *Bimbo SA v OHIM*, Case C-591/12P (paragraph 34)

²⁴ E.g. paragraph 23 Skeleton Argument

standard and the overall impression is based on the word as a whole, which will be perceived as a coinage joining two words “DATA” and “SWIFT”.²⁵ The “data” element may be considered more or less non-distinctive/descriptive in relation to the applied-for services such that the “swift” component may be considered the more distinctive element.

Visual Comparison

57. The Opponent’s Word Mark is shown in black capital letters, whereas the contested mark is largely in lower case and its colour may be very dark blue. However, registration of a word in black capital letters would cover its use in any standard font, case or colour, so these minor differences are anyway of no consequence. There is though a notable visual difference in that the Applicant’s mark has a different opening – “Data” – making it visibly longer by four letters. The opening letter D is presented as an open curve with a splayed top, which adds a small degree of distinctive difference, but it will still be seen as functioning a capital D. I also note that generally speaking a consumer will typically pay greater attention to the start of marks; however, when I take account of the very low distinctiveness of the “data” element and the greater distinctive role of the “swift” element, I find the marks are visually similar to a degree **between medium and high**.

Aural Comparison

58. The Applicant’s mark begins with two additional syllables (DA-TA), and it is only its third syllable that is the same as the Opponent’s earlier mark (SWIFT). However, that shared syllable is the whole of the earlier mark. I also again note that a consumer may typically pay greater attention to the start of marks; however, when I take account of the low distinctiveness of the “data” element and the greater distinctive role of the “swift” element in the overall impression of the contested mark, I find the marks are aurally similar to a degree **between medium and high**.

Conceptual comparison

59. The counterstatement claimed although the main definition of “swift” refers to “something happening quickly or having speed”, since the contested mark also “includes the word ‘Data’ ... it would not be evident to a consumer that the word ‘swift’ refers to the same concept and therefore there cannot exist any conceptual similarity.” The Applicant’s

²⁵ The General Court has held that, although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a word sign, they will break it down into elements that, for them, suggest a specific meaning, or that resemble words they know (13/02/2007, T-256/04, *Respicur*, EU:T:2007:46, § 57).

skeleton argument argued only that “whilst the word is the dominant and distinctive feature of the contested Mark, the stylisation of the lettering would be understood as critical to the nature of the Mark”.

60. I accept that there is more than one meaning of “swift” – for instance additionally a type bird. I also acknowledge that the inclusion of the word “data” adds another concept to the mark not present in the word “swift” solus. However, in my view the average consumer will likely perceive the same concept of speed or promptness in both marks. The stylised flourish of the opening letter does not in my view materially inform the concept of the mark, and taking account of the very low distinctiveness of the “Data” component of the whole of the contested mark I find the respective marks **conceptually similar to degree between medium and high**.

Distinctive character of the Opponent’s Mark

61. The distinctive character of the earlier mark must be considered. The more distinctive an earlier mark, either by inherent nature or by use, the greater the potential for a likelihood of confusion (*Sabel*). In *Lloyd Schuhfabrik*²⁶ 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 ...

*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).”*

62. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services specified in the registration and, secondly, by reference to the way it is perceived by the relevant public.²⁷

Inherent distinctiveness:

63. The word 'SWIFT' (although in fact an acronym) presents as a word that alludes to a quality of speediness that a consumer might expect to find in the goods or services to which the mark. Ms Jones submitted that the evidence shows that word 'SWIFT' can and does function as a trade mark by which the Opponent is widely recognised. This mark is not one in relation to which the Registry has to afford it a low level of distinctiveness purely because it has made it on to the register despite its descriptive nature. Instead, it falls well within the range, which many successful trade marks fall within, namely, a brand name which is distinctive of a single entity, which successfully serves to denote the origin of goods and services and which may also be allusive of a particular characteristic or quality of the goods or services. I accept that the word is allusive and not descriptive and may be considered to have, on an inherent basis, a moderate level of distinctiveness.

Enhanced distinctiveness:

64. The evidence shows that the Opponent's business has been operating since 1973. Both the Word Mark and the Device Mark (in which the word mark centrally features) are used extensively by the Opponent. In the provision of its services, the use of the mark 'SWIFT' is a vital element, this being used as the name for the codes necessary to execute a financial transaction (of which there are billions of instances). The Opponent's annual revenues, based on a range of goods and services, are shown to be in the tens of millions of pounds. Its direct customers include all major banks in the UK and, in a recent 4-year period, the Opponent spent well over 1.6 million Euros in promotion of the brand in the UK.

65. I accept the position argued by Ms Jones that firstly, the enhanced distinctiveness of the Word Mark and the Device Mark is considerable - rendering the distinctiveness of its SWIFT brand as high, if not very high; and secondly that such enhanced distinctiveness applies in relation to all of the goods and services on which the Opponent provides, which are all closely related to its core service of providing a secure financial transaction

messaging network. While I am mindful that services are to be interpreted in line with their core function and should not be permitted undue sprawl, I find in this case that I am persuaded that it would be difficult to segregate any part of the goods and services in classes 9, 35 and 42 used as basis for the assessment of similarity/identity, and to deny such goods and services the benefit of the enhancement. I therefore accept that enhanced distinctiveness applies in relation to all such goods and services. The effect of the enhancement is that amongst the relevant professional public, the marks are distinctive to **a high degree**.

Conclusion as to likelihood of confusion

66. In my global assessment of likelihood of confusion, I take account of the case law principles outlined in paragraph 19 above in view of my findings set out in the foregoing sections of this decision (focused on the Opponent's Word Mark). Central points from my analysis above include:

- i. Comparing the services as specified in the application with the goods and services registered under just the Opponent's Word Mark has led to findings that some of the services at issue are identical, some highly similar and that others are similar to medium degree
- ii. The average consumer includes businesses and professionals, but for some services the average consumer includes members of the general public (including as an end user of some of the services). Businesses will pay a higher level of attention, but even the general public will pay **at least a medium level of attention**.
- iii. Visual considerations may predominate in the selection of the services, but aural considerations are also relevant and the marks are visually and aurally,, and conceptually similar to a degree that is **between medium and high**;
- iv. On an inherent basis, the Opponent's Word Mark is distinctive to a moderate degree, but long-standing use, widespread use has led to **enhancement of the distinctiveness of the Word Mark to a high degree among the relevant professional public and for its registered goods and services in Class 9, 35 and 42**. The benefit of this enhanced distinctiveness is a significant factor in my view (and

I have noted that the claim of enhanced distinctiveness was not denied in the Applicant's counterstatement).

67. The question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public.²⁸ The relative weight of the factors is not laid down by law, but is a matter of judgment for the tribunal on the particular facts of each case.²⁹ Confusion can be direct or indirect. Whereas direct confusion involves the average consumer mistaking one trade mark for the other, indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.
68. Evaluating a likelihood of confusion implies some interdependence between the relevant factors and, in particular, between the degree of similarity between the marks and that between the goods or services. *Canon* expressly steers that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the services and vice versa.³⁰ Clearly the identity /high similarity and medium degrees of similarity prevalent in the goods and services in this case weigh in the scale towards a likelihood of confusion. As a counterweight, the levels of attention likely to apply on the part of the notional average consumer of the goods and services are medium or higher. However, I also take into account the high degree of distinctiveness that attaches to the Opponent's mark, and too that average consumers rarely have the chance to make a direct comparison between different marks but must trust in their imperfect recollection of them.³¹ Even consumers who pay a high degree of attention need to rely on their imperfect recollection of trade marks.³²
69. The Applicant's position is that there is a clear difference between the services operated by the Opponent in the financial industry and the Applicant's services within the data industry and that the Applicant's use of its mark in the UK has not resulted in consumer confusion. On this I note (i) that the likelihood of confusion entails a primarily notional assessment (ii) that a registered trade mark is a property right and an asset that may be transferred to a third party whose real-world use of the registration may more obviously and directly compete with the Opponent's own real-world use of its registered rights (iii)

28 Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at §34

29 See paragraph 33 of the decision of Iain Purvis QC sitting as the Appointed Person in Case No. O-079-17, (*Rochester Trade Mark*).
30 Case C-39/97 cited above.

31 Lloyd Schuhfabri, § 26

32 (21/11/2013, T-443/12, ancotel, EU:T:2013:605, § 54)

the trite point that absence of evidence of confusion is not evidence of absence of confusion and (iv) that the Applicant's evidence does not establish that the relevant public has had significant exposure to its mark through promotion or use – indeed the Applicant was originally known as HAT Data Exchange Ltd, and decided to rename as Dataswift Ltd after raising seed capital of £1.8m in September 2019.³³ And finally, as the Opponent noted, Ms Ng states at paragraph 7 of her witness statement that “the logic of the Applicant's name comes directly from the intent of the business i.e. data exchange executed swiftly.” The Opponent reasonably maintains that this is an accurate description of the Opponent's core service so in that respect Ms Ng's evidence may be considered to show the similarity between the parties' respective services.

70. The difference created by the element 'Data' of the contested sign, does not safely exclude a likelihood of confusion. I find that confusion may be direct, through imperfect recollection and/or indirect, as a perceived sub-branding by the Opponent. I recognise that the word “swift” is an ordinary English word and that monopoly rights should be scrutinised carefully, but the distinctiveness of the Word Mark in the context of the relevant goods and services has been significantly increased through use and. The marks coincide fully in their most distinctive element and the differentiating element 'Data', even with its stylised opening letter, is at best weak and is insufficient to distinguish between the marks.

OUTCOME under the section 5(2)(b) claim:

71. The opposition based on section 5(2)(b) therefore **succeeds in respect of all of the applied-for services.**

The section 5(3) claim

72. Section 5(3) of the Act (as applicable at the commencement of these opposition proceedings) states that a trade mark which 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 Community/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.”

33 Paragraph 6 Ms Ng witness statement.

The law and principles applicable to section 5(3) grounds

73. The relevant legal principles can be found in the following judgments of the CJEU: Case C-375/97, *General Motors Corp v Yplon SA* [2000] RPC 572; (CJEU), Case 252/07, *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15; Case C-408/01, *Adidas-Salomon AG v Fitnessworld Trading Ltd*. [2004] ETMR 10, Case C-487/07, *L’Oreal SA and others v Bellure NV and others* - C-487/07 and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *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.

- (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 of 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*).

74. In order to succeed with a claim under section 5(3) a party must establish (i) a reputation, (ii) similar or identical marks, (iii) a link with the earlier mark in the mind of the relevant public, (iv) in consequence of the link, a finding that the use of the mark will take unfair advantage of the distinctive character or repute of the earlier mark or is detrimental to that distinctive character or repute, and (v) that the mark is applied for and to be used without due cause.³⁴

Reputation

³⁴ *Intel Corp Inc v CPM United Kingdom Ltd* (C-252/07) [2009] R.P.C. 15
Page 31 of 39

75. It is sufficient for an EUTM to be known by a significant part of the public concerned by the goods/services of the mark in a substantial part of the territory of the EU, where the territory of a Member State may be considered to constitute a substantial part of the relevant territory.³⁵ The CJEU in *General Motors* gives guidance on assessing the existence of a reputation. Paragraph 27 of that judgment requires that I “*take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.*”
76. In this case a reputation is claimed in respect of the Opponent’s Word Mark (SWIFT) and of its Device Mark for all their registered goods and services in the area of finance and related software, technology and business services. The Applicant’s counterstatement does not deny the claimed reputation. In my assessment of the level and extent of reputation shown in the evidence, I note, for example: (i) the European and global reach of the Opponent’s business; (ii) that the Opponent has offered its services in the UK since 1973; (iii) that all major banks and financial institutions in the UK use the Opponent’s secure interbank financial transaction messaging network, transmitting billions of messages and generating tens of millions of pounds of revenue each year; (iv) its role of influence and leadership in the financial sector; (v) and award accolades, including recognition in data services categories.
77. I find that the Opponent has a reputation for goods and services related to its financial messaging system, which extends to the categories of evidence covered by Mr Krekels’ first witness statement, namely, data security and security consultancy services, business intelligence, management, consultancy and business administration services and covers the goods and services in Class 9, 35 and 42 under its Word Mark, on which my decision has focused. The reputation is substantial and strong among the relevant section of the public as regards the goods or services for which the mark is registered, which in this case includes at least financial institutions and businesses.

Similarity of the Marks

78. The Opponent's Word Mark satisfies the requirement for similarity, as I have set out in my analysis for the purposes of the section 5(2)(b) claim. Since the word is dominant in the Device Mark, it follows that the Device Mark too is similar, however, for the purposes of this ground too I shall focus on the Word Mark.

Link

79. As noted above in the summary of relevant case-law principles "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." This does not set a high bar for the owner of the earlier mark; in *Adidas-Salomon* the CJEU explained (at paragraph 29) that the link arose from "a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them." And as Floyd LJ said more recently in *Argos Ltd v Argos Systems Inc*: "It is sufficient for such a link that the sign will call the trade mark to the mind of the average consumer."³⁶
80. Taking account of the similarity of the respective marks, the similarity and identity between the goods/services, the strength of the Word Mark's reputation, and the extent of the potential overlap between the relevant consumers for those goods/services, I find that the necessary mental link will be made at least in so far as the goods and services in respect of which I have found a likelihood of confusion under the section 5(2)(b) claim.

Serious likelihood of injury

81. Since I have found the earlier mark has the necessary reputation and that a link will arise, I must determine whether there is a serious likelihood of one or more of the types of injury set out in section 5(3) of the Act.

Unfair advantage

82. As set out in the case law above, unfair advantage covers situations where the user of a junior mark may be considered to trade upon the reputation of a senior mark, 'free-riding on its coat-tails'. This is to say that there is a risk that the repute of the earlier mark is

³⁶ [2018] EWCA Civ 2211; [2019] F.S.R. 3 at paragraph 82

transferred to the services covered by the Applicant's mark, with the result that the Applicant unfairly could benefit from the marketing efforts of the earlier mark and its own marketing will be made easier as a result of the association with that earlier mark.

83. In this case I find that in relation to any of the Applicant's specified services, there is a serious likelihood that use of **Dataswift** would take unfair advantage of the reputation of the Opponent's mark with a reputation. The image and reputation of the earlier mark and the characteristics which they project – for example, a long-standing, dominant presence on the market and association with secure, reliable and effective goods and services - will be transferred to the Applicant's services if they are marketed under the contested sign. There is nothing to prevent the parties operating in precisely the same field and market, the applied-for mark is likely to benefit from the powers of attraction of the earlier SWIFT mark which has achieved considerably enhanced distinctiveness and strong reputation in the field of payment services. In my view, this is the strongest of the three limbs of damage and it is sufficient to satisfy the requirement. I am less convinced that there would be detriment to distinctive character as it is not clear that there is a serious risk of a change in the economic behaviour on the part of the Opponent's customers. I am still less prepared to find a serious likelihood of damage to the repute of the earlier mark, which prospect appears too hypothetical in the circumstances of this case.³⁷

Without due cause

84. I have noted Ms Ng's explanation that the logic of the Applicant's name comes directly from the intent of the business, but I do not consider this enough to demonstrate any necessity to use the mark. Nor is this a case where the Applicant asserts an earlier right to the mark, since the decision to change the name to Dataswift appears more or less contemporaneous with the application for the trade mark. Nor is it a clear example of fair competition given the high degree of recognition of the Opponent's Mark and the potential overlap between the Applicant's and Opponent's commercial offerings. I therefore find that there is no due cause for use of the applied-for mark in this case.

³⁷ See comments of Anna Carboni at paragraphs 46 and 47 of *Unite The Union v The Unite Group Plc*, Case BL O/219/13

Outcome under the section 5(3) claim:

85. The section 5(3) claim succeeds in full against the application.

The section 5(4)(a) claim

86. Section 5(4)(a) of the Act states that:

“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 or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,

87. It is settled law that for a successful finding of passing off, three factors must be present: goodwill, misrepresentation and damage. Her Honour Judge Melissa Clarke, sitting as Deputy Judge of the High Court, conveniently summarised the essential requirements of the law in *Jadebay Limited, Noa and Nani Limited (trading as The Discount Outlet) v Clarke-Coles Limited (trading as Feel Good UK)* [2017] EWHC 1400 IPEC

“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 these 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).”

88. 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.”

Goodwill

89. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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 distinguished an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

90. For there to be goodwill, there must be customers in the UK.

Misrepresentation

91. The relevant test was set out by Morritt LJ in *Neutrogena Corporation and another v Golden Limited and another* [1996] RPC 473:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is: is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product].’ [*my underlining*]”

92. Although they are different, the test for misrepresentation tends to have the same results as the test for confusion under trade mark law. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchin L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

93. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “*a substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, 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.
94. In view of my findings based on the registered rights, I can deal with this ground relatively briefly. The Opponent’s section 5(4)(a) ground is based on claimed unregistered earlier rights founded on goodwill in two signs directly equivalent to Word Mark and its Device Mark and in respect of the goods and services closely aligned to those in Classes 9, 16, 35, 36, 38, 41 and 42 covered by the Device Mark. The same analysis applies, *mutatis mutandis*, as set out above in relation to the average consumer (applied here in relation to the relevant public), enhanced distinctiveness of the SWIFT Word Mark and the between medium and high level of similarity between the Applicant’s Mark and the SWIFT Word Mark. I also accept Ms Jones’s submission that in fact, the similarity between services becomes stronger in relation to the claim for passing off as the services relied on. I am satisfied on the evidence, that the Opponent is, for instance, able to rely on its claimed goodwill in ‘maintaining and updating of computer databases’ and ‘data analysis’, which are not included within the specification for the SWIFT Word Mark.
95. In the circumstances, I find that there that *a substantial number* of the relevant public will be deceived such that the risk of misrepresentation is made out and that consequent damage may be inferred.

Outcome

96. The opposition succeeds fully on the basis of the Opponent’s unregistered rights under sections 5(4)(a) of the Act.

COSTS

97. The Opponent has been successful and is entitled to a contribution towards its costs, in line with the scale set out in Tribunal Practice Notice 2/2016. I award the Opponent the sum of **£3300**, which is calculated as follows:

<i>Form TM7 fee</i>	<i>£200</i>
<i>Preparing a statement and considering the other side's statement:</i>	<i>£350</i>
<i>Preparing evidence and considering and commenting on the other side's evidence:</i>	<i>£1250</i>
<i>Preparation for and attending hearing:</i>	<i>£1500</i>
	<i>Total: £3300</i>

98. I order Dataswift Limited to pay Society for Worldwide Interbank Financial Telecommunication SRC the sum of £3300. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of July 2021

Matthew Williams
For the Registrar
