

O/0396/25

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003975598
IN THE NAME OF BOTTOMLINE TECHNOLOGIES INC.
TO REGISTER THE FOLLOWING TRADE MARK:**



IN CLASS 9, 16, 35, 36, 41 AND 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP600003229
BY BALANZ CAPITAL UK LLP**

Background and pleadings

1. On 03 November 2023, Bottomline Technologies Inc. (“the Applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. It was accepted and published in the Trade Marks Journal on 08 December 2023 in respect of goods and services in classes 9, 16, 35, 36, 41 and 42 which are outlined in **Annex A** of this decision.
2. On 08 March 2024, Balanz Capital UK LLP (“the Opponent”) opposed the application under the fast track opposition procedure, based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at the following goods and services in the application:

Class 9: Computer software for financial transaction processing; Downloadable computer software for payment processing and cash management; Downloadable computer software for invoice receipt, management, presentment and payment; Downloadable computer software for electronic banking and financial information reporting; Downloadable computer software for fraud management, identity theft protection, anti-money laundering management; Downloadable computer software for financial messaging, financial market data management, financial account reconciliation and reporting, financial accounting and account opening, financial data aggregation, collections services; Downloadable computer software for legal spend management; Downloadable computer software for interfacing and facilitating communication between applications; Downloadable computer software for mobile phones and handheld computers for payment processing and cash management; Downloadable computer software for mobile phones and handheld computers for invoice receipt, management, presentment and payment; Downloadable computer software for mobile phones and handheld computers for electronic banking and financial information reporting; Downloadable computer software for mobile phones and handheld computers for fraud management, identity theft protection, anti-money laundering management; Downloadable computer software for mobile phones and handheld computers for financial messaging, financial market data

management, financial account reconciliation and reporting, financial accounting and account opening, financial data aggregation, collections services; Downloadable computer software for mobile phones and handheld computers for legal spend management.

Class 36: Financial services for businesses; Financial analysis and consultation services; Financial services in the nature of electronic payment services for businesses, namely, payment processing of electronically presented invoices; Payment and remittance processing for businesses in the nature of bill payment remittance services and electronic payment services involving electronic processing and subsequent transmission of bill payment data; Payment and remittance processing in the nature of bill payment remittance services and electronic payment services involving electronic processing and subsequent transmission of bill payment data to pay employee travel, entertainment and other remittances; Payment management and processing for others; Aggregation services for combining consumer payments from various banks into a single electronic payment to a business; Financial management of accounts, bill payment services, and electronic payment services involving electronic processing and subsequent transmission of bill payment data; Credit disbursement and payment processing for supply chain financing, factoring and asset-based financing activities.

3. The Opponent relies upon the following mark:



UK Registration no. UK00003402669 (“the Earlier Right”)

Filing date: 28 May 2019

Date of registration: 20 September 2019

Relying upon the following goods and services:

Class 9: Software; software [downloadable]; mobile apps; software for financial services; software for financial management; software for making investments; software for financial information, information analysis; software for financial consultancy; software for financial research and analysis; software for brokerage services; software allowing a specific user to manage investment and other users to make investments influenced at least by the specific user's investment decisions; software allowing one user to interact with other users regarding investments; software allowing users to manage investments via the internet; mobile software applications enabling ongoing connection to an investment portfolio; software for trading in financial markets; software for trading in financial instruments; software facilitating wisdom-of-the-crowd for investment decisions.

Class 36: Financial services, namely, financial consultation services; financial services relating to the trading of financial instruments; a financial service allowing users to manage investments via the internet, namely, financial management; a financial service allowing a specific user to manage investments via the internet and other users to make investments influenced at least by the specific user's investments, namely, financial management; financial management; financial management of investments on-line; financial management of investments that are influenced by investments made by others; financial consultancy by investors to users of the internet; financial information and analysis based on the investments of large groups of users; financial management online platform for trading and exchange of financial instruments, namely, on-line trading of financial instruments, shares, options and other derivative products; financial information analysis; providing financial information via a website; investment brokerage services; financial information regarding financial markets and instruments; financial information provided utilising an application programming interface (API); financial consultancy; financial research and analysis.

4. By virtue of its earlier filing date of 28 May 2019, the above registration constitutes an earlier mark within the meaning of section 6 of the Act. As the earlier mark had not completed its registration process more than five years before the filing date of the application in issue, it is not subject to the use provisions contained in section 6A of the Act. The Opponent can, therefore, rely upon all of the goods and services it has identified without having to demonstrate use.
5. The Opponent submits that the marks are highly similar and the opposed goods and services are identical and/or highly similar.
6. The Applicant filed a counterstatement in which it denies that their mark is similar to the Opponent's mark. The Applicant did not deny the Opponent's position as to the similarity of goods/services.¹
7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that: "(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit." The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions.
8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.
9. A hearing was neither requested nor considered necessary; however, the Opponent filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

¹ The official letter of 23 May 2024 advised the Applicant that if they chose not to particularise this aspect of the defence, the Tribunal may proceed on the basis that the Opponent's position as to the similarity of goods/services is not denied and therefore is admitted. On 17 July 2024 the Applicant confirmed that they wished to proceed on this basis.

10. The Applicant is represented by Barker Brettell LLP; the Opponent is represented by Lara Grant.

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

Section 5(2)(b)

12. Section 5(2)(b) of the Act is 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”.

13. Section 5A of the Act reads as follows:

“5A 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.”

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa; Page 8 of 20

(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.

Goods and services

15. I remind myself that the opposed goods and services are set out in paragraph 2 of this decision and the relied upon goods and services are set out in paragraph 3.

16. As set out at paragraph 6, the Applicant has not denied the Opponent's position as to the similarity of goods/services. The official letter of 23 May 2024 advised the Applicant that following the decision in *SkyClub* O/044/21, further particularisation of their defence was required to admit or deny the similarity of the goods and services at issue. This letter went on to state:

"If you chose not to particularise this this aspect of your defence the Tribunal may proceed on the basis that the opponent's position as to the similarity of goods/services is not denied and therefore admitted."

17. On 17 July 2024 the Applicant provided written confirmation of their position, stating as follows:

"We can confirm we will not be filing an amended TM8 and counterstatement and the Office may proceed on the above basis."

18. As explained at 2.4.1 of Contentious Trade Mark Registry Proceedings (2nd Edition) by Michael Edenborough KC, “If an allegation is admitted, then that fact or matter is no longer in issue between the parties, and so (a) no evidence needs to be adduced to establish it; (b) no argument needs to be advanced to promote or defend it; and, (c) the tribunal need not trouble itself about it, as it becomes an agreed point between the parties and may be used by the tribunal as a basis for its decision”.

19. With this in mind, I am bound to proceed on the basis that the Applicant concedes that the goods and services at issue are identical or highly similar.

Average consumer and the purchasing act

20. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

21. The average consumer for the class 9 goods will consist of two separate groups, being members of the general public at large and professional users purchasing on behalf of a business. The cost will vary dependant on the nature of the goods from mobile apps which may be provided free or for a low cost, to specialist investment software for which the cost could be substantial. Both consumer groups

will consider the suitability for their wants or needs, compatibility with other devices and ease of use and reliability during the purchasing process.

22. For those goods selected by members of the public, I find that they will be available via physical retail stores or their online equivalents. For business users, the goods and services will be selected at specialist retailers, be that physical stores or online. For both consumer groups, the purchase/selection process will involve primarily visual considerations. However, I do not discount the aural element playing a role in the form of advice from sales representatives or word of mouth recommendations.

23. Software for use in relation to financial and investment services, particularly where the customer must provide personal information, is likely to be carefully considered, with members of the general public likely to pay a medium to high degree of attention. This is on the basis that their own personal money or investments may be at stake. Professionals dealing with this software in relation to business accounts are likely to pay a slightly higher level of attention, considering that choosing appropriate finance or investment software may have higher stakes, deal with larger sums of money and may impact the reputation of their business. Where a piece of software is not financial in nature, while it will be considered to ensure it is suitable for the user's needs and compatible with the device upon which it will be used, a lesser degree of attention will be paid. Overall, both consumer groups for these types of goods are likely to pay a medium to high degree of attention to the selection of such items.

24. The average consumer for the services in class 36 will be either businesses or professionals, for example, in the financial sector, without excluding entirely members of the general public who may seek out financial consultation services. The selection process for the services is likely to involve scrutinising the brochures and websites of the companies that offer the services and perusal of advertisements or signage on physical premises; therefore, the purchasing process would be primarily a visual one. However, the consumer may also seek reviews or recommendations about financial services, where verbal factors would come into play.

25. The services are likely to be sought infrequently and although the costs of the services will vary according to the exact nature, the cost could be substantial. A member of the general public will, in my view, be prudent when considering their prospective service provider because they will want to ensure that the service meets their needs and effectively manages or provides guidance on their finances. Where the average consumer is a professional, acting on behalf of a business, their level of attention will be higher as the services are likely to be important to the running and success of their business. Weighing all factors, I find that the average consumer is a member of the general public, they will apply a medium to high degree of attention to the purchase. Where the average consumer is a professional, acting on behalf of a business, they will apply a high degree to attention to the purchase.



Comparison of marks

26. 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 Court of Justice of the European Union 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.”

27. 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.

28. The respective trade marks are shown below:

| Earlier right | Contested trade mark |
|---|--|
|  |  |

29. Both parties have filed submissions regarding the similarity of the marks. Whilst I do not propose to reproduce those here, I have taken them all into consideration in reaching my decision.

30. The earlier right consists of a capital letter “B” presented in red in a standard typeface. The letter “B” is positioned in the centre of a dark blue square background. It is the letter “B” that makes the most significant contribution to the overall impression of the mark, and the colour arrangement makes a lesser contribution. The square background will play a lesser role in the overall impression.

31. The contested trade mark consists of a capital letter “B” presented in a standard typeface in white, on a black background. The background is reminiscent of a square, however the corners are rounded. Below the letter “B” is a white horizontal line, which is the same width as the letter. While the figurative elements present in the mark will be noticed, the letter “B” is the dominant element in the overall impression of the mark and catches the eye first.

Visual

32. Visually the marks coincide insofar as they both contain a letter “B”, presented in a similar manner in a standard font. The Applicant submits there are visual differences in the letter “B”, including their mark having an elongated bottom

section.² While I note that the presentations of the letter “B” in each mark have subtle differences, I do not consider them to be significant differences. I note that the Opponent’s mark is presented in red and blue, while the Applicant’s mark is presented in black and white. However, in respect of the colour used, as a mark registered in black and white, the Applicant’s mark is capable of being used in any colour,³ including that used by the Opponent. While the shape of the backgrounds in each mark acts as a point of visual difference, I consider that the square and square-like shape with rounded edges still share a degree of similarity, and I note that I have found these shapes to play a lesser role in the overall impression of the respective marks. The Applicant’s mark also includes a horizontal line below the letter “B”, which is not present in the Opponent’s mark. Overall, I find there to be a medium to high degree of visual similarity between the respective marks.

Aural

33. Aurally, both marks will be pronounced as the letter “B” (‘BEE’). The figurative aspects of the marks will not play a part in the aural comparison. The marks are, therefore, aurally identical.

Conceptual

34. While the concepts of the marks lie in their single letters, those letters do not carry any meaning to consumers beyond the fact that they are letters of the alphabet. The stylisation and colour elements present in the respective marks do not create a conceptual gap on the basis that they have no clear relationship with the letter “B” and will not convey any particular meaning. Accordingly, the marks are conceptually identical.

Distinctive character of the earlier trade mark

35. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference

² Applicant’s TM8 and counterstatement, paragraph 13.

³ See paragraph 5, *Specsavers* [2014] EWCA Civ 1294.

to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

36. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.
37. The Opponent has not filed any evidence to support that the earlier mark’s distinctive character has been enhanced through use. Consequently, I have only the inherent position to consider.

38. There is no evidence to suggest that the letter “B”, or the stylisation contained in the earlier mark describes or alludes to the goods or services for which the mark is registered. Accordingly, I find the mark meaningless in respect of the same. Whilst the overall presentation of the mark is noted, I am of the view that there is nothing especially striking or inventive about a single letter of the alphabet. Accordingly, I find the earlier mark to be inherently distinctive to a lower than medium degree.

Likelihood of confusion

39. I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

40. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

41. In relation to assessing the likelihood of confusion where the common element has no or low distinctiveness, I keep in mind that in *Face2FaceHR Partners Limited v Peninsula Business Services Limited*,⁴ Emma Himsworth K.C. as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin*⁵ and

⁴ O/0368/23

⁵ [2015] EWHC 1271 (Ch)

Nicoventures Holdings Limited v The London Vape Co Ltd,⁶ as well as guidance in the Common Communication on the Common Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non-distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Ms Himsworth summarised the correct approach as follows, at paragraph 44:

“(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.

(2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.

(3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.

(4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.

(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.


(6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical.”

42. I note that in *General Ecology, Inc. v Wan Jou Lin & Great Ins Company Ltd*,⁷ Professor Phillip Johnson, as the Appointed Person, found that marks “NATURE

⁶ [2017] EHC 3303 (Ch)

⁷ O/0331/23



PURE”, and  were confusingly similar, despite the common elements only having low distinctiveness. Furthermore, I remind myself that a low level of distinctiveness does not preclude a likelihood of confusion.⁸

43. I remind myself of the following conclusions I have reached in this decision:

- I have found the marks to be visually similar to a medium to high degree.
- I have found the marks to be aurally identical.
- I have found the marks to be conceptually identical.
- I have found the earlier mark to be inherently distinctive to a lower than medium degree.
- I have identified the average consumer for the goods to be professionals acting on behalf of a business or members of the general public.
- I have concluded that for goods in class 9 a medium to high degree of attention will be paid during the purchasing process.
- I have concluded that for services in class 36, where the consumer is a member of the general public a medium to high degree of attention will be paid during the purchasing process. Where the consumer is a business, or professional user, a high degree of attention will be paid.
- The Applicant conceded that the goods and services at issue are identical or highly similar.

44. Taking all of the above into account, given that the average consumer rarely has the opportunity to compare marks side-by-side will, to my mind, lead the average consumer to mistake one mark for the other, even for those who are paying a high degree of attention during the purchasing process. This is particularly the case as the shared single letter ‘B’ is the dominant element in each mark. I consider the average consumer could easily overlook or imperfectly recall the differences, especially considering the aural identity of the marks, the identical concept of a single letter ‘B’ and the highly similar presentation of the marks, which overcomes

⁸ L’Oréal SA v OHIM, Case C-235/05 P

any difference in the stylisation (namely the use of colours and the line element in the Applicant's mark). I also remind myself that as the Applicant's mark is black and white, it is capable of being used in any colour, bringing it visually closer to the Opponent's mark. Weighing all the factors and bearing in mind the Applicant conceded that the goods and services at issue are identical or highly similar, I consider that there is a likelihood of direct confusion for all the opposed goods.

45. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, (as he then was) sitting as the Appointed Person, explained that:

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

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).”

46. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.⁹

47. Firstly, I note that the two marks do not appear to fall into one of the categories highlighted in *L.A. Sugar*. However, I note that these categories are not exhaustive, and so I consider again all of the factors I have found within this decision, and if I find another basis for a likelihood of indirect confusion in this instance. I consider that the shared dominant “B” element in the parties’ marks will lead consumers to conclude that the marks originate from the same or economically linked undertakings. If the average consumer notices the differences in the colour and background shapes within the marks or notices the addition of the line element of the Applicant’s mark, I am satisfied that they would perceive it as an alternative or updated mark indicative of re-branding. I consider that it is not uncommon for undertakings to undergo a brand ‘re-fresh’ or ‘brand-revamp’ from time to time to accommodate changes in marketing considerations. Consequently, I consider there to be a likelihood of indirect confusion.

⁹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Conclusion

48. The opposition under section 5(2)(b) of the Act has been successful. Subject to any successful appeal against my decision, the application will be refused for the opposed goods and services in classes 9 and 36.

COSTS

49. As the Opponent has been successful it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the Opponent the sum of £550 calculated as follows:

| | |
|--|-------------|
| Official fee for Opposition: | £100 |
| Preparing a statement and considering the other side's statement: | £250 |
| Preparing and filing submissions in lieu | £200 |
| Total | £550 |

I therefore order Bottomline Technologies Inc. to pay Balanz Capital UK LLP the sum of £550. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of April 2025

Emma Rees
For the Registrar

Annex A

Good and services of UK trade mark application no. UK00003975598

Class 9: Computer hardware for cheque writing and cheque printing; Computer printers for printing documents and instruction manuals therefor when sold as a unit; Computer software for financial transaction processing; Downloadable computer software for payment processing and cash management; Downloadable computer software for invoice receipt, management, presentment and payment; Downloadable computer software for electronic banking and financial information reporting; Downloadable computer software for fraud management, identity theft protection, user behaviour monitoring and anti-money laundering management; Downloadable computer software for creating electronic forms, electronic signature processing, financial messaging, financial market data management, financial account reconciliation and reporting, financial accounting and account opening, financial data aggregation, collections services; Downloadable computer software for workflow management and business process automation; Downloadable computer software for information security and privacy protection; Downloadable computer software for legal spend management, vendor management and customer relationship management; Downloadable computer software for interfacing and facilitating communication between applications; Downloadable computer software for healthcare clinical and transactional output production and management; Downloadable computer software for document production and automation; Downloadable computer software for mobile phones and handheld computers for payment processing and cash management; Downloadable computer software for mobile phones and handheld computers for invoice receipt, management, presentment and payment; Downloadable computer software for mobile phones and handheld computers for electronic banking and financial information reporting; Downloadable computer software for mobile phones and handheld computers for fraud management, identity theft protection, user behaviour monitoring and anti-money laundering management; Downloadable computer software for mobile phones and handheld computers for creating electronic forms, electronic signature processing, financial messaging, financial market data management, financial account reconciliation and reporting, financial accounting and account opening, financial data aggregation, collections services; Downloadable

computer software for mobile phones and handheld computers for workflow management and business process automation; Downloadable computer software for mobile phones and handheld computers for information security and privacy protection; Downloadable computer software for mobile phones and handheld computers for legal spend management, vendor management and customer relationship management; Downloadable computer software for mobile phones and handheld computers for healthcare clinical and transactional output production and management; Downloadable computer software for mobile phones and handheld computers for document production and automation.

Class 16: Bond paper; computer paper; blank computer cheque forms; Paper for use as material of stock certificates or security documents.

Class 35: Invoicing services in the nature of electronic invoice presentment; Business consulting services in the field of electronic and digital fund transfer, payment processing, invoice processing and remittance processing; Business consulting services in the fields of legal spend management and vendor management, and the administration, billing and reconciliation of accounts on behalf of others; Business advisory services relating to management of financial transactions and financial transaction processing.

Class 36: Financial services for businesses; Financial analysis and consultation services; Financial services in the nature of electronic payment services for businesses, namely, payment processing of electronically presented invoices; Payment and remittance processing for businesses in the nature of bill payment remittance services and electronic payment services involving electronic processing and subsequent transmission of bill payment data; Payment and remittance processing in the nature of bill payment remittance services and electronic payment services involving electronic processing and subsequent transmission of bill payment data to pay employee travel, entertainment and other remittances; Payment management and processing for others; Aggregation services for combining consumer payments from various banks into a single electronic payment to a business; Financial management of accounts, bill payment services, and electronic payment services involving electronic processing and subsequent transmission of bill

payment data; Credit disbursement and payment processing for supply chain financing, factoring and asset-based financing activities.

Class 41: Education services relating to financial transaction processing; , Training courses in the field of financial resource management; Training courses in the field of computerized and online financial transaction processing.

Class 42: Computer hardware and software support services ; Troubleshooting services in the nature of diagnosing computer hardware and software problems; Maintenance of computer software; Software as a Service (SaaS) services relating to financial transactions; Software as a Service (SaaS) services featuring software for payment processing and cash management; Software as a Service (SaaS) services featuring software for invoice receipt, management, presentment and payment; Software as a Service (SaaS) services featuring software for electronic banking and financial information reporting; Software as a Service (SaaS) services featuring software for fraud management, identity theft protection, user behaviour monitoring and anti-money laundering management; Software as a Service (SaaS) services featuring software for creating electronic forms, electronic signature processing, financial messaging, financial market data management, financial account reconciliation and reporting, financial accounting and account opening, financial data aggregation, collections services; Software as a Service (SaaS) services featuring software for workflow management and business process automation; Software as a Service (SaaS) services featuring software for information security and privacy protection; Software as a Service (SaaS) services featuring software for legal spend management, vendor management and customer relationship management; Software as a Service (SaaS) services featuring software for interfacing and facilitating communication between applications; Software as a Service (SaaS) services featuring software for healthcare clinical and transactional output production and management; Software as a Service (SaaS) services featuring software for document production and automation.