

O/0174/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00004005199
BY THE SCOTCH HOUSE ALBA LIMITED
TO REGISTER:**

UP

AS A TRADE MARK IN CLASSES 9, 35 AND 36

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP000447931
BY PARAGON FINANCE PLC**

BACKGROUND AND PLEADINGS

1. On 22 January 2024, THE SCOTCH HOUSE ALBA LIMITED (“the applicant”) applied to register the word mark “UP” in the UK. The application was published for opposition purposes on 08 March 2024. The applicant seeks registration for the following goods and services:

Class 9: Credit cards; encoded cards; chip cards; smart cards; card readers for credit cards; credit card terminals; Commercial information agency software; communication installations; communications software; credit bureau software; credit consultancy software; database management software; databases, data sets and software relating to credit account management databases, data sets and software relating to billing; databases, data sets and software relating to biometric data; databases, data sets and software relating to candidate verification; databases, data sets and software relating to credit application processing; databases, data sets and software relating to credit assessment and credit screening; databases, data sets and software relating to credit scorecards; databases, data sets and software relating to credit strategy management; databases, data sets and software relating to customer profiling; databases, data sets and software relating to financial information; databases, data sets and software relating to identity documents; databases, data sets and software relating to identity verification and authentication; databases, data sets and software relating to names of individuals and organisations; databases, data sets and software relating to postal codes and addresses; databases, data sets and software relating to public record information.

Class 35: Credit card registration services, provision of credit card rewards based programs; preparation of monthly statements of credit card and reward account; provision of credit card and reward monthly statements.

Class 36: E-wallet payment services; financing services; instalment loans; issuance of credit cards; issuance of credit; loans [financing]; processing of credit card payments; Consumer credit history services; credit account management services; credit agency services; credit assessment services;

credit bureau services; credit consultancy services; credit evaluation services; credit information services; credit rating services; credit risk assessment services; credit risk information services; credit scoring and credit scorecard services; credit screening services; credit strategy management services; debt collection services; fraudulent credit application detection services; preparation of credit reports; credit application processing services; credit care services; consumer credit services; credit card services; magnetic card services; chip card services; smart card services; issuance of credit, cards; credit card payment processing; lending services; advisory, consultancy and information services related to all of the aforesaid.

2. The application was opposed by Paragon Finance Plc (“the opponent”) on 10 June 2024. The opposition is based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”) with the opponent relying upon the following mark:

UP

UKTM No. UK00003904804

Filing date: 25 April 2023

Registration date: 11 August 2023

Relying on all services in class 36, namely: Savings services; savings accounts services; provision of savings plans; administration of savings accounts; financial services relating to savings; the provision of information and advice relating to all of the aforesaid.

3. The trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years before the filing date of the application in issue, it is not subject to the use provisions in section 6A of the Act. The opponent can, therefore, rely upon all of the services identified.

4. The opponent claims that the marks at issue are identical and that the goods and services for which application is sought are identical and/or similar to the relied upon services. As a result, the opponent argues that there exists a likelihood of confusion between the marks.
5. The applicant filed a counterstatement admitting that the marks are identical but denying that there is any similarity between the respective goods and services and therefore denying any likelihood of confusion.
6. The opponent is represented by Irwin Mitchell LLP, and the applicant represents itself. The applicant filed evidence in chief and the opponent filed evidence in reply. No hearing was requested however, both parties filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
7. 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.

EVIDENCE

8. The applicant's evidence came in the form of the witness statement of Sion O'Connor dated 6 January 2025. Mr O'Connor provides his statement on behalf of the applicant and claims that he was formally an FCA Approved Person and represented the applicant in meetings with the Financial Conduct Authority. Mr O'Connor's statement is accompanied by six exhibits, being SOC001-SOC006.
9. I note that the majority of Mr O'Connor's evidence appears to contain survey evidence. This includes:

- A credit card market study interim report from the Financial Conduct Authority dated November 2015;¹
- Competition and Markets Authority Report into Acquisition by Experian PLC of ClearScore dated 28 November 2018;²
- A cash savings market review from the Financial Conduct Authority dated July 2023.³

10. I note that no permission was sought to file such evidence, neither were the requirements as set out in the Trade Mark Manual or the criteria as laid out in *Imperial Group plc & Another v. Philip Morris Limited & Another*⁴ adhered to.

11. Even if permission had been sought to introduce this evidence it is of little relevance. The results are not particularly insightful or helpful for my assessment and I place little weight on it.

12. The opponent's evidence in reply came in the form of the witness statement of Georgina Alexandra Laurel Collins dated 10 March 2025. Ms Collins is a partner at the opponent's representative firm. Ms Collins' statement is accompanied by three exhibits, being GLC1-GLC3. The purpose of the evidence is to demonstrate that financial institutions such as banks provide both savings and credit related services to their customers.

13. Whilst I do not intend to summarise the evidence filed by the parties in full here, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

PRELIMINARY ISSUE

14. It is noted that, in the present case, the Tribunal considered it appropriate to issue a preliminary indication in accordance with Rule 19 of the Trade Marks Rules 2008.

¹ Exhibit SOC-001

² Exhibit SOC-003

³ Exhibit SOC-006

⁴ [1984] RPC 293

This is dated 15 August 2024 and I can confirm that it was given by a Hearing Officer other than myself. Whilst I would ordinarily refrain from looking at (or even mentioning) a preliminary indication, I note that the opponent's submissions make reference to it and to its outcome. As such, I have become aware of the outcome of the preliminary indication issued. I raise the point here because I wish to set out that, for the avoidance of doubt, the preliminary indication is in no way binding upon me and, further, it has no influence upon my decision, which will be made based on my own considerations of the various assessments I must make throughout. As a result, I will say no more about the preliminary indication.

DECISION

Section 5(1) and 5(2)(a)

15. Section 5(1) of the Act reads as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

16. Section 5(2)(a) of the Act is as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, [...] there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case

C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Identity of the marks

18. The applicant accepts that the marks are identical and as such, this satisfies the first requirement of both section 5(1) and 5(2)(a) grounds.

Comparison of goods and services

19. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

20. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

21. Complementary means “there is a close connection between them, 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”.⁵ Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity,⁶ and it can be clearly distinguished from ‘use in combination’ – the latter being where goods/services are merely used together, whether by choice or convenience (e.g. bread and butter; or wine and wine glasses),⁷ this means that they are not essential for each other.

⁵ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

⁶ *Kurt Hesse v OHIM*, Case C-50/15 P

⁷ As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Products Limited*, BL O/255/13 - “It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

22. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

"...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

23. I also note that in *Unicorn Studio Inc v Veronese* Case CH-2023-000214, Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity (between goods and services) requires the exercise of common sense.⁸

24. The goods and services to be compared are as follows:

Opponent's services
Class 36: Savings services; savings accounts services; provision of savings plans; administration of savings accounts; financial services relating to savings; the provision of information and advice relating to all of the aforesaid.
Applicant's goods and services
Class 9: Credit cards; encoded cards; chip cards; smart cards; card readers for credit cards; credit card terminals; Commercial information agency

⁸ At [24].

software; communication installations; communications software; credit bureau software; credit consultancy software; database management software; databases, data sets and software relating to credit account management; databases, data sets and software relating to billing; databases, data sets and software relating to biometric data; databases, data sets and software relating to candidate verification; databases, data sets and software relating to credit application processing; databases, data sets and software relating to credit assessment and credit screening; databases, data sets and software relating to credit scorecards; databases, data sets and software relating to credit strategy management; databases, data sets and software relating to customer profiling; databases, data sets and software relating to financial information; databases, data sets and software relating to identity documents; databases, data sets and software relating to identity verification and authentication; databases, data sets and software relating to names of individuals and organisations; databases, data sets and software relating to postal codes and addresses; databases, data sets and software relating to public record information.

Class 35: Credit card registration services, provision of credit card rewards based programs; preparation of monthly statements of credit card and reward account; provision of credit card and reward monthly statements.

Class 36: E-wallet payment services; financing services; instalment loans; issuance of credit cards; issuance of credit; loans [financing]; processing of credit card payments; Consumer credit history services; credit account management services; credit agency services; credit assessment services; credit bureau services; credit consultancy services; credit evaluation services; credit information services; credit rating services; credit risk assessment services; credit risk information services; credit scoring and credit scorecard services; credit screening services; credit strategy management services; debt collection services; fraudulent credit application detection services; preparation of credit reports; credit application processing services; credit care services; consumer credit services; credit card services;

magnetic card services; chip card services; smart card services; issuance of credit, cards; credit card payment processing; lending services; advisory, consultancy and information services related to all of the aforesaid.

Class 9

Encoded cards; chip cards; smart cards

25. In comparing these terms to the opponent's *financial services relating to savings*, I first note that they differ in terms of nature, purpose and method of use. However, it is not uncommon for banks to offer both these goods and services to their customers especially in circumstances where cards are issued to customers to access their savings accounts. I therefore find that users and trade channels overlap. I also consider that there is an important relationship between these goods and services, and this is to the extent that users would believe they are derived from the same undertaking; they are therefore complementary. However, I do not consider there to be any competition between the goods and services. Overall, I consider there to be a low degree of similarity.

Credit cards

26. *Credit cards* differ in terms of nature, purpose and method of use compared to the opponent's *financial services relating to savings*. However, it is not uncommon for banks to offer both these goods and services to their customers. I therefore find that users and trade channels overlap. I do not consider there to be an important relationship between these goods and services because credit cards are for borrowing money up to a set limit whereas savings accounts are for storing money and accruing interest; as such they are not complementary. I do not consider there to be any competition between the goods and services. Overall, I consider there to be a very low degree of similarity.

Card readers for credit cards; credit card terminals

27. The above terms are physical electronic devices used to process card payments. They have a different nature, purpose and method of use compared to *financial services relating to savings*. There is also no competition nor complementarity between the same. I am of the view that the above goods are targeted at retailers whereas the opponent's services would be targeted at the general public and some businesses. As far as I am aware, it is also not common in the trade for financial providers to sell the above goods. As such, the users and trade channels would differ. Even if I were to find a broad overlap in users, this would not be sufficient for a finding of similarity due to the other differences. These goods and services are dissimilar.

Communication installations; communications software

28. To my mind, the above terms are hardware and software that facilitate communications. For example, *communication installations* may include routers or transmitters and *communications software* would include software for the purposes of communication such as emailing, instant messaging and video calls. The opponent's services in class 36 are, broadly speaking, financial services related to savings. The competing goods and services therefore have a different nature, purpose and method of use. There is no competition or complementarity. The goods and services would reach consumers via different trade channels. Whilst the goods and services may both be offered to the general public, I do not consider this to be sufficient for a finding of similarity. As such, I find these goods and services to be dissimilar.

Commercial information agency software; credit bureau software; credit consultancy software; database management software

29. The above terms have a different nature, purpose and method of use compared to the opponent's savings services in class 36. I do not consider the above terms to be important or indispensable to any of the opponent's services so there is no complementary relationship to be found. Further, I do not consider there to be any competition between the same. I do not consider the above terms would be used by the general public. Even if the respective goods and services were to be

used by business users, there is no overlap in trade channels. Consequently, I find the above terms to be dissimilar to any of the opponent's services.

Databases, data sets and software relating to credit account management; databases, data sets and software relating to billing; databases, data sets and software relating to credit application processing; databases, data sets and software relating to credit assessment and credit screening; databases, data sets and software relating to credit scorecards; databases, data sets and software relating to credit strategy management; databases, data sets and software relating to biometric data; databases, data sets and software relating to candidate verification; databases, data sets and software relating to customer profiling; databases, data sets and software relating to identity documents; databases, data sets and software relating to identity verification and authentication; databases, data sets and software relating to names of individuals and organisations; databases, data sets and software relating to postal codes and addresses; databases, data sets and software relating to public record information

30. As far as I am aware, the above goods are digital tools used by businesses for internal credit-checking and verification processes. I find that their nature, purpose and methods of use are distinct from the opponent's services. They would reach the market through different trade channels, and I do not consider there would be any competition between the same. Whilst it may be the case that financial institutions would use the above goods for their own internal processes, I do not consider that they would provide these goods to their customers. As such, there is no overlap in consumers. Further, I do not consider the competing goods and services to have a complementary relationship. The goods and services are dissimilar.

Databases, data sets and software relating to financial information

31. I consider the above term to be a digital tool or data resource that stores, organises or processes financial information. This is distinct from the opponent's services in terms of nature and method of use. The purpose of the above term is to provide technological means for accessing or handling financial data, rather

than to offer or support the management of savings. I consider the applicant's goods would be used internally by a financial institution whereas the opponent's services are likely to be used by the general public. I also consider that the trade channels would differ. Further, there is no competition or complementary relationship between the same. I do not consider these services to be similar.

Class 35

Credit card registration services, provision of credit card rewards based programs; preparation of monthly statements of credit card and reward account; provision of credit card and reward monthly statements

32. I consider that the above services have a different nature and purpose compared to the opponent's class 36 services. The applied for services concern the administration of credit card and rewards-based programs for the purposes of customer retention whereas the opponent's services involve the provision of a savings product for the purposes of depositing money, accruing interest and managing savings balances. I do not consider that a customer would choose between a savings account and the above services to satisfy the same need. As such, there is no competition between these services. Nor do I consider the services to share a complementary relationship as they are not important or indispensable to each other. I do find, however, that the services would overlap in user, trade channels and would likely be provided to the customer by a financial institution such as a bank or building society. Accordingly, I find there is a low degree of similarity between these services.

Class 36

E-wallet payment services; processing of credit card payments; credit card payment processing

33. The above services relate to the processing of electronic and card-based payments, whose core purpose is to facilitate immediate financial transactions. The opponent's services include *savings services* and *administration of savings*

accounts. These services are aimed at consumers wishing to deposit and retain funds over time. The services therefore differ in nature, purpose and method of use. Although banks may offer both savings products and payment facilities to the same users, this is not sufficient to establish similarity where the services are otherwise distinct. They are neither in competition nor complementary, as the use of one is not indispensable or important for the use of the other. I consider these services to be dissimilar.

Financing services; instalment loans; loans [financing]; lending services

34. The applicant's services provide money or credit to their customers, whether by way of instalment arrangements, loan products or other forms of lending. The opponent's services help customers store and grow their existing money, usually through savings accounts, savings plans, or similar deposit-based products. As such, these services differ in terms of nature, purpose and method of use. A customer may choose either the applicant's or opponent's services to fund a purchase, so I consider there to be some degree of competition. I also consider that the same undertaking would provide these services and users and trade channels would overlap. I do not consider the services to have a complementary relationship. As such, I find there is a low degree of similarity between these services.

Issuance of credit cards; magnetic card services; chip card services; smart card services; issuance of credit, cards; issuance of credit; consumer credit history services; credit account management services; credit agency services; credit bureau services; credit consultancy services; credit information services; credit strategy management services; credit care services; consumer credit services; credit card services; credit assessment services; credit evaluation services; credit rating services; credit risk assessment services; credit risk information services; credit scoring and credit scorecard services; credit screening services; credit application processing services; preparation of credit reports

35. These services encompass a broad range of credit-related activities, including the issuance of credit cards, card-based account services, the provision of credit

and consumer credit assessment and information services. There is a broad overlap in nature as the services pertain to financial matters however, their purpose and method of use differs from the opponent's *savings services* and *administration of savings accounts*. There is no competition between these services nor is there any complementary relationship. I consider that the respective services would be provided by the same undertaking and users and trade channels would overlap. Accordingly, I consider these services to be similar albeit to a low degree.

Fraudulent credit application detection services

36. The above services are used by lenders such as banks to identify or prevent deceptive or stolen-identity credit applications. They have a different nature, purpose and method of use compared to the opponent's *savings services*. There is no overlap in user or trade channels. There is also no competitive or complementary relationship to be found. As such, I find these services to be dissimilar.

Debt collection services

37. I consider that debt collection services focus on the recovery of outstanding debts on behalf of creditors. These services would be provided to financial institutions, businesses or utilities companies seeking to recover unpaid invoices or overdue accounts whereas the opponent's *savings services* and *administration of savings accounts* would predominantly be sought out by the general public. The services differ in terms of nature, purpose and method of use. There is no competition or complementarity between the same. These services are dissimilar.

Advisory, consultancy and information services related to all of the aforesaid

The applicant's specification in this class also includes the term advisory, consultancy and information services related to all of the aforesaid. I consider that there may be an overlap in user and trade channels with the opponent's services in class 36 as they also include information and advice services in relation to all

of their aforesaid services. For example, a consumer may go to the same undertaking for advice and consultancy in relation to savings services as they would for information on financing services. Taking the above into account, I consider that the applicant's services are similar to the opponent's services to a low degree but only to the extent that it relates to the services that I have found to be similar in class 36.

Conclusion of the goods and services comparison

38. It is a requirement of section 5(1) of the Act that the goods and services be identical. Given the findings I have made above, the section 5(1) aspect of the present ground must fail. That being said, the section 5(2)(a) aspect of this ground may proceed in respect of the goods and services I have found similar. As for the dissimilar goods, I remind myself that a likelihood of confusion under section 5(2) of the Act may only succeed where there is a degree of similarity between goods and services.⁹ The section 5(2)(a) aspect of the present ground, therefore, fails against the dissimilar goods and services.

The average consumer and the purchasing act

39. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively

⁹ see *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA

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.”

40. The average consumer of the goods and services which I have found to be similar may be a member of the general public or a business user. The frequency with which the services are purchased/selected is likely to vary but overall, I do not consider the services to be overly expensive. However, none of the goods or services are casual purchases, given that they are all financial in nature. The average consumer is likely to consider factors such as the reputation of the provider, interest rates, security and efficiency when making a selection. In my view, members of the general public are likely to demonstrate at least a medium level of attention. Business users are likely to pay a slightly higher level of attention because they will recognise that the selection may be important to the success of their business.

41. The goods and services are likely to be purchased direct from the provider (mainly banks and other financial institutions) after being presented to the average consumer in advertising, on websites, or in physical premises where information will be displayed in brochures, pamphlets or on signage. Therefore, I find that the purchasing process is predominantly visual in nature. However, I do not discount an aural element to the purchasing process as the average consumer may receive verbal recommendations or wish to discuss the services with the provider.

Distinctive character of the earlier mark

42. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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).”

43. 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 or services, 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.

44. While I note that the opponent has filed evidence, this was not for the purpose of proving an enhanced degree of distinctive character. As such, there is no evidence pointing to any actual use of its mark in the UK prior to the relevant date. As a result, I have only the inherent position to consider.

45. The opponent’s mark is comprised solely of the dictionary word “UP”. It is neither descriptive nor allusive of the opponent’s services. Accordingly, I consider the mark has a medium degree of inherent distinctive character.

Likelihood of confusion

46. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

47. Direct confusion involves the average consumer mistaking one mark for the other (*L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10).

48. The respective marks are identical. I have found the respective goods and services to be similar from a very low degree to a low degree. I have found that the average consumer will comprise members of the general public and business users who and visual considerations will dominate during the purchasing process, however; I do not discount an aural component. The general public will pay at least a medium degree of attention during the purchasing/selection process whereas business users will pay a higher degree of attention. Lastly, I have found the earlier mark enjoys a medium degree of inherent distinctive character.

49. Weighing up all of the above, noting the principle of imperfect recollection, that the earlier mark has a medium level of distinctive character, and that consumers rarely have the opportunity to compare marks side by side, I consider that the average consumer is likely to mistake the parties' marks for one another despite the goods and services being similar to a low or very low degree. I make this finding on the basis of the interdependency principle and as I consider this lesser degree of similarity between these goods will be offset by the identity between the contested mark and the earlier mark. Consequently, I find that there is a likelihood of direct confusion between the marks. For the avoidance of doubt, the

identity of the marks means that this finding applies even where the consumer pays a higher than medium degree of attention.

CONCLUSION

50. The opposition under section 5(2)(a) has partially succeeded. Subject to any appeal, the application will be refused for the following goods and services:

Class 9: Credit cards; encoded cards; chip cards; smart cards.

Class 35: Credit card registration services, provision of credit card rewards based programs; preparation of monthly statements of credit card and reward account; provision of credit card and reward monthly statements.

Class 36: Financing services; instalment loans; issuance of credit cards; issuance of credit; loans [financing]; Consumer credit history services; credit account management services; credit agency services; credit assessment services; credit bureau services; credit consultancy services; credit evaluation services; credit information services; credit rating services; credit risk assessment services; credit risk information services; credit scoring and credit scorecard services; credit screening services; credit strategy management services; preparation of credit reports; credit application processing services; credit care services; consumer credit services; credit card services; magnetic card services; chip card services; smart card services; issuance of credit, cards; lending services; advisory, consultancy and information services related to all of the aforesaid.

51. I note that there is a separate opposition¹⁰ against this application that is aimed at all of the applied-for goods and services. Pending the outcome of that opposition, the application will proceed to registration for the following goods and services:

¹⁰ Opposition number 447876

Class 9: Card readers for credit cards; credit card terminals; commercial information agency software; communication installations; communications software; credit bureau software; credit consultancy software; database management software; databases, data sets and software relating to credit account management; databases, data sets and software relating to billing; databases, data sets and software relating to biometric data; databases, data sets and software relating to candidate verification; databases, data sets and software relating to credit application processing; databases, data sets and software relating to credit assessment and credit screening; databases, data sets and software relating to credit scorecards; databases, data sets and software relating to credit strategy management; databases, data sets and software relating to customer profiling; databases, data sets and software relating to financial information; databases, data sets and software relating to identity documents; databases, data sets and software relating to identity verification and authentication; databases, data sets and software relating to names of individuals and organisations; databases, data sets and software relating to postal codes and addresses; databases, data sets and software relating to public record information.

Class 36: E-wallet payment services; processing of credit card payments; debt collection services; fraudulent credit application detection services; credit card payment processing.

COSTS

52. In this case both parties have enjoyed roughly an equal measure of success. I therefore order that both parties should bear their own costs.

Dated this 27th day of February 2026

Catrin Williams
For the Registrar