

O/0232/26

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION UK00003806882
IN THE NAME OF ROMACO LTD FOR THE TRADE MARKS:**

**Love to Lend
LovetoLend
(SERIES OF TWO)**

IN CLASS 36

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 507353 BY SDKA LTD**

AND

**IN THE MATTER OF REGISTRATIONS UK00004002727 & UK00004002734
IN THE NAME OF SDKA LTD FOR THE TRADE MARKS:**



IN CLASS 36

AND

**APPLICATIONS FOR DECLARATIONS OF INVALIDITY
UNDER NOS. 507372 & 507374 BY ROMACO LTD**

BACKGROUND AND PLEADINGS

1. This decision involves proceedings wherein Romaco Ltd (“Romaco”) and SDKA Ltd (“SDKA”) brought invalidation actions against one another. I will summarise the relevant proceedings below, beginning with Romaco’s application, on the basis that it was brought first.

SDKA’s application

2. Romaco is the registered proprietor of a series of two marks, being ‘Love to Lend’ and ‘LovetoLend’ under UK registration number 3806882 (“Romaco’s registration”). Romaco’s registration was filed on 6 July 2022 and registration was granted on 7 October 2022. Romaco’s registration stands registered for the following services:

Class 36: Loans [financing]; Project financing; Credit financing; Project finance; Corporate finance; Finance leasing; Financing services; Loan financing; Corporate financing; Providing financing; Commodities financing; Equity financing; Finance services; Corporate finance consultancy; Financing of mergers; Financing of acquisitions; Sales credit financing; Arranging of finance; Raising of finance; Financing of sureties; Financially-guaranteed financing; Instalment loan financing; Financing of loans; Automobile lease financing; Equipment financing services; Lease-purchase financing; Financing (Hire purchase -); Lease purchase finance; Loans (Financing of -); Financing of investments; Corporate finance services; Accounts receivables financing; Trade finance services; Mortgage financing services; Finance (Provision of -); Finance (Raising of -); Instalment credit financing; Personal finance services; Industrial financing services; Real estate financing; Asset-based financing; Financing of purchases; Provision of finance; Financing of guarantees; Venture capital financing; Auto financing services; Financing of development projects; Provision of trade finance; Financing of

home loans; Financing of land acquisition; Arranging finance for businesses; Financing and funding services; Financing of industrial activities; Financing of personal loans; Hire purchase financing services; Financing of lease purchase; Banking and financing services; Financing of building projects; Financing and loan services; Financing services for companies; Financing of bridging loans; Financing of property loans; Management of corporate finances; Financing of property development; Facilitating and arranging financing; Provision of finance for sales; Provision of finance for enterprises; Advisory services relating to finance; Advisory services relating to financing; Information services relating to finance; Financing services for sponsoring businesses; Financing of short-term loans; Provision of finance for companies; Arranging finance for construction projects; Financing of loans, mortgages and sureties.

3. On 15 May 2024, SDKA applied to invalidate Romaco's registration under sections 5(4)(a), 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994 ("the Act"). Under the section 5(4)(a) ground, SDKA claims to be the owner of an earlier unregistered sign, being '#WELOVETOLEND' which it claims to have been in use since 12 October 2020 throughout the UK. In respect of the services to which this use pertains, it is noted that SDKA's invalidation application listed services that are identical to the services under Romaco's registration listed above. However, in its evidence, SDKA claims to have used the sign for a different (albeit similar range of services). I will discuss this point further below.
4. As a result of the above claimed use, SDKA's position is that it enjoys a protective level of goodwill in its business. It is claimed that this goodwill, together with the similarity of the parties' marks and the identity/similarity of the services means that use of Romaco's registration will undoubtedly result in a misrepresentation on the part of the public which will, in turn, likely result in damage to SDKA by way of loss of sales.

5. Under the section 3(1)(b) ground, SDKA claims that Romaco's registration is objectionable as it includes marks that consist of an identical expression ('love to lend') which merely serves as a promotional function to endorse the services being provided. It is claimed that the registration is, therefore, devoid of any distinctive character. Lastly, under the section 3(1)(c) ground, SDKA claims that the marks in Romaco's registration are descriptive in their ordinary and plain meaning. As such, it is claimed that the relevant public would perceive the marks as providing information about the services offered. Further, it is claimed that it is in the public interest to ensure that exclusive rights do not exist for purely descriptive terms which other trade in the same or similar sectors may wish to use.
6. Romaco filed a counterstatement denying the claims against it.

Romaco's applications

7. SDKA is the registered proprietor of two different series of figurative marks, being those under UK registration numbers 4002727 ("SKDA's first registration") and 4002734 ("SDKA's second registration"). These registrations were filed on 16 January 2024 and registration was granted for both on 12 April 2024. SDKA's first registration stands registered for the following services:

Class 36: Financial services; Loan and credit services; Lending and loans services; Provision of bridging loans; Financing of bridging loans; Providing financing; Credit services; Credit and loan services; Financing of loans; Loans [financing]; Funding of loans; Financing of short-term loans; Arranging of loans; Secured loans; Loan financing; Commercial lending; Commercial lending services.

8. SDKA's second registration stands registered for the following services:

Class 36: Commercial lending; Commercial lending services; Financial lending; Lending and loans services; Money lending services; Financial services in the field of money lending; Financial lending against security; Financial services; Loan and credit services;

Credit and loan services; Financing of bridging loans; Finance services; Secured loans; Financing of short-term loans; Arranging of loans; Arranging loans.

9. On 22 May 2024, Romaco applied to invalidate both of SDKA's registrations under section 5(2)(b) of the Act. In doing so, Romaco is reliant upon the registration that is subject to SDKA's application for invalidity, the details of which are set out at paragraph 2 above. In relying upon section 5(2)(b) grounds, Romaco claims that the marks in the parties' registrations are similar and cover services that are identical. As such, Romaco claims that there exists a likelihood of confusion between the parties' registrations meaning that SDKA's registrations should be invalidated in their entirety.
10. SDKA filed counterstatements to both invalidations denying the claims made against it.
11. Upon the filing of the counterstatements in all proceedings, the Tribunal consolidated the proceedings under the power given to it under Rule 62(1)(g) of the Trade Marks Rules 2008. This was communicated to the parties by way of written correspondence dated 7 August 2024.
12. Both parties filed evidence in chief. As these proceedings involve cross-invalidation applications, both parties were permitted to file evidence in reply. While SDKA filed evidence in reply, Romaco opted to file submissions in reply instead. No hearing was requested and both parties filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
13. 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

14. SDKA's evidence in chief came in the form of the witness statement of Kunal Mehta dated 7 October 2024. Mr Mehta is the Managing Director of SDKA, a position he has held since 22 March 2016, being when the company was initially incorporated. Mr Mehta's statement is accompanied by 13 exhibits, being KKM1 to KKM13, and was adduced in order to demonstrate the existence of goodwill in SDKA's business and to introduce evidence as to why Romaco's registration is objectionable under section 3(1) of the Act.
15. Romaco's evidence came in the form of the witness statement of Scott Marshall dated 7 October 2024. Mr Marshall is the Founder and Managing Director of Romaco, a position he has held since 2014. Mr Marshall's statement is accompanied by 13 exhibits, being SM1 to SM13, and was adduced in order to demonstrate Romaco's own use of its registration.
16. As above, SDKA filed evidence in reply. This came in the form of the second statement of Mr Mehta, dated 9 December 2024. It is not accompanied by any further exhibits but I note that it was adduced in order to respond to Mr Marshall's evidence.
17. I do not intend to summarise the parties' evidence (or submissions, for that matter) in full here. However, 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

18. As set out above, the application for invalidation brought by SDKA initially sought to rely on services identical to those listed under Romaco's registration. However, in its evidence, SDKA claimed to have used its mark for a different range of services, being the following:

“Financial services; Loan and credit services; Lending and loans services; Provision of bridging loans; Financing of bridging loans; Providing financing; Credit services; Credit and loan services; Financing of loans; Loans [financing]; Funding of loans; Financing of short-term loans; Arranging of loans; Secured loans; Loan financing; Commercial lending; Commercial lending services; Financial lending; Money lending services; Financial services in the field of money lending; Financial lending against security; Finance services; Arranging loans.”

19. I appreciate that there is overlap between the two different specifications referred to. However, the above specification, while consisting of lesser terms, offers a broader scope of protection. I say this because the first term listed is “financial services” which can cover any type of service relating to finance. This was not in the initial specification relied upon and it is not open for SDKA to expand its case beyond the services listed in its pleadings. As a result, I will proceed in line with the specification relied upon in the invalidation application.

MY APPROACH

20. I will begin my decision by assessing SDKA’s invalidation application. I do so because any success of the same would have a direct impact on Romaco’s applications. On this point, if SDKA’s application succeeds in full then Romaco’s registration will be declared invalid and deemed to have never been protected in the UK. This would mean that the marks within it would not qualify as earlier marks for the purpose of Romaco’s applications, resulting in said applications falling away. Further, if SDKA’s application is only partially successful then Romaco’s applications will proceed but only in reliance upon those services that remain. Lastly, in the event that SDKA’s application fails outright, then Romaco’s applications will proceed in full. If necessary, I will discuss the position with Romaco’s applications at the conclusion of SDKA’s application.

DECISION

SDKA's application

21. As set out above, SDKA's application for invalidity is based on section 5(4)(a) and 3(1) of the Act. Both of these grounds have application in invalidation proceedings because of the provisions of section 47 of the Act.

22. Section 47 of the Act states as follows:

"47. –

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2D)-(2DA) [Repealed]

[...]

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Section 5(4)(a)

23. Section 5(4)(a) of the Act reads as follows:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(a) [...]

(b) [...]

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

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

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

25. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

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

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

26. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation¹ 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 indicium which is the same or sufficiently similar that the defendant’s goods or business are from the same source² or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which 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 claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (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 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.”

Relevant Date

27. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

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

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the

applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

28. Romaco’s registration does not enjoy a priority date and while there is evidence of use for the same, it is from after the filing date of the registration. The relevant date for this ground is, therefore, 6 July 2022.

Goodwill

29. The first hurdle for SDKA is that it needs to show that it had the necessary goodwill in the sign relied upon at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

30. In *South Cone* (cited above), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd’s Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C.*

472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

31. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

32. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was

needed, see per Upjohn L.J. in *BALI Trade Mark [1969] R.P.C. 472*. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge’s finding). Again that shows one is looking for more than a minimal reputation.”

33. Goodwill arises as a result of trading activities. I remind myself that SDKA claims to have accrued goodwill in its unregistered sign of ‘#WELOVETOLEND’ in respect of a range of class 36 services, namely those identical the services of Romaco’s registration.

34. SDKA’s evidence sets out that it is a specialist bridge finance lender, offering short-term finance solutions secured on commercial property and buy to let properties throughout England, Wales and Scotland. It is claimed that #WELOVETOLEND began appearing on SDKA’s website (sdka ltd.com) since as early as 2020. A screenshot from nominet.uk is provided that shows that SDKA’s domain was created in July 2020.¹ In terms of how the website actually appeared prior to the relevant date, I note that screenshots obtained from the internet archive facility, the Wayback Machine, are provided in evidence.² Printouts dated 9 December 2021 and 24 June 2022 show the following banner:



35. In terms of the actual websites themselves, they speak solely to the SDKA brand, as opposed to them containing any further offering of services under

¹ KKM2

² KKM8

#WELOVETOLEND. In terms of visits to this website, the evidence sets out the following number of visits and page views for 2020 to 2022:³

Year	Visitors	Page Views
2020	16,330	61,357
2021	23,336	94,596
2022	36,245	90,084
Total	75,911	246,037

36. It is claimed that #WELOVETOLEND has been used continuously and extensively throughout the UK since 2020 and that it is a core aspect of its marketing strategy. Examples of how SDKA has used the sign on its social media channels and at conferences/events are provided.⁴ Some of the social media posts are not dated but are, instead, shown as being posted '1 yr' prior, for example. As it is not precisely clear when such printouts were obtained, I am unable to determine when they were made. These posts are, therefore, of no assistance here. Of the posts that are dated, they simply include the hashtag #welovetolend within the text shown, alongside other hashtags such as #bridgingfinance, #moviequotes and #brokers, for example. The conference/event evidence includes images of SDKA's stands at various finance expos. Only one of these is from prior to the relevant date and shows the following image:⁵

³ Figures for 2023 and 2024 are provided but these fall after the relevant date so are not included here.

⁴ KKM3

⁵ Page 13 at KKM3



37. While #WELOVETOLEND does appear on one of the displays, it is not prominent. Lastly, this evidence shows a number of what appears to be excerpts from pamphlets.⁶ While noted, these are undated and it is not clear whether they can be said to have been from prior to the relevant date.

38. In respect of SDKA's turnover, the evidence includes figures from 2020 to 2024. As the figures from 2023 and 2024 are not relevant to the present ground, I will refrain from reproducing them here. Therefore, the relevant figures are as follows:

Year end 31 March	Turnover (£)
2020	1,169,046
2021	1,285,945
2022	2,992,718
Total	5,447,709

39. The narrative evidence sets out that the above turnover relates to services provided throughout the UK under the trade mark #WELOVETOLEND. I note that annual accounts of SDKA's business are provided in evidence.⁷

⁶ Pages 17 to 19 of KKM3

⁷ KKM4

40. In terms of marketing, the evidence confirms that since launching #WELOVETOLEND, SDKA has incurred a spend in excess of £45,000. While noted, this claim is vague as it pertains to the spend incurred as at the time of the statement, which is dated 7 October 2024. It cannot, therefore, be said to cover the spend as at the relevant date. On this point, I note that evidence in support of the marketing spend is provided by way of invoices covering various advertising activities.⁸ A number of the invoices provided are from after the relevant date so are not relevant here. Further, some of the invoices from prior to that date show costs associated with general business expenses (such as travel and accommodation) and salary of staff. Such costs are not to be taken as advertising costs. Of the invoices that can be said to relate to marketing from prior to the date, I have calculated that SDKA's actual relevant advertising spend shown in evidence stands at £4,291.65.

41. Examples of SDKA's actual marketing activities are provided in evidence.⁹ While noted, it all stems from after the relevant date so is of no assistance here. The same can be said for the award evidence discussed in that it relates to a 2023 award and a submission for the 2024 awards,¹⁰ so cannot speak to the level of goodwill as at the relevant date.

42. Lastly in support of its claim to enjoy goodwill, SDKA has provided evidence relating to its social media accounts. It is noted that its LinkedIn account had 1,680 followers as at the date of the statement, 145 followers on X and 382 followers on Instagram. Printouts showing these accounts are provided in evidence.¹¹ While the posts shown use the hashtag #WELOVETOLEND, none of them are from prior to the relevant date.

Assessment of the evidence

43. While SDKA's marketing evidence leaves a lot to be desired, its evidence to have accrued a turnover of over £5 million as at the relevant date is such that I am

⁸ KKM5

⁹ KKM6

¹⁰ KKM7

¹¹ KKM9

satisfied that SDKA enjoys the benefit of a protectable level of goodwill. While that may be the case, my primary issue in considering the present ground is that the evidence simply does not demonstrate that the sign relied upon, being #WELOVETOLEND', is distinctive of and/or associated with that goodwill. My reasons follow.

44. I appreciate that the narrative evidence sets out that the turnover covers use under the #WELOVETOLEND mark. While I do not disbelieve SDKA's witness as to the level of turnover, I have considered the evidence in full and am of the view that the claim to the turnover being under the relevant branding is unsupported. To me, this claim appears to be a bare assertion that is not actually borne out in the evidence filed. As such, I do not consider it appropriate for me to simply take the turnover and attribute it to trading activities offered under the sign relied upon. I say this because the evidence points solely to the offering of services under the SDKA brand. On this point, I note the following examples:

- a. SDKA's website, refers to services offered by SDKA with #WELOVETOLEND simply appearing as a hashtag in a banner. At no point does the body of the website make reference to any services being offered under #WELOVETOLEND.
- b. The displays shown at the one finance expo that took place prior to the relevant date shows '#WELOVETOLEND' as a hashtag at the bottom of the display and in a much smaller font than 'SDKA'. Clearly, it is SDKA that is the branding offering the services.
- c. The social media evidence is clear on the point in that #WELOVETOLEND appears solely as a hashtag at the end of the posts shown often alongside other, sometimes unrelated, hashtags.

45. While I accept that SDKA operated a relatively successful business with annual turnover in the multiple millions of pounds prior to the relevant date, I am not satisfied that there is anything before me in evidence that actually shows SDKA offering services under the sign relied upon. As a result, I find that the present

ground fails at the first hurdle on the basis that any goodwill in SDKA's business is not associated with the sign relied upon.

46. Even if I were satisfied that any goodwill was associated with and/or distinctive of the sign relied upon, I remind myself of the case of *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39. In that case, Lord Simons stated that:

“Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

47. While that case related to outright descriptive words, I consider that a similar outcome applies here. In short, the sign ‘#WELOVETOLEND’ is directly connected to the services at issue in that they heavily allude to the fact that the service provider ‘loves to lend’. As such, I consider that the differences between SDKA's sign and the marks in Romaco's registration, though relatively minor, are sufficient to avoid confusion. Further, by adopting words that are likely to be common in SDKA's trade, some risk of confusion is inevitable and, as above, that risk must be run otherwise SDKA would be allowed to unfairly monopolise such words.

48. As a result, for the reasons set out above, I find that even if I were satisfied that SDKA's sign was associated with or distinctive of its goodwill, there would be no misrepresentation between Romaco's registration and SDKA's sign.

Section 3(1) case law and legislation

49. It is noted that, in support of both section 3(1)(b) and 3(1)(c), SDKA filed evidence demonstrating that its own applications (both for class 36 services) for the figurative

mark '#welovetolend' and the word only series of marks 'We Love to Lend' and 'WeLovetoLend' were refused by this Office.¹² While this is noted, it has no bearing on my decision. Firstly, the marks at issue are not the same as those referred to in SDKA's evidence. Secondly, I am not bound to reach the same decisions as those made during the examination stage. If I were, then raising grounds of opposition or invalidation under sections 3(1)(b) and (c) would always be bound to follow the decisions reached upon the examination of the same. This is not the case and I must, therefore, assess the present grounds whilst bearing in mind the relevant case law and considerations, which I will discuss below.

50. Section 3(1) of the Act provides as follows:

"3(1) The following shall not be registered –

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) [...]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

¹² KKM11 and KKM12

51. The relevant date for determining whether Romaco's registration is objectionable under sections 3(1)(b) and 3(1)(c) is its filing date, being 6 July 2022.

52. I bear in mind that the present grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b): *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at [25].

53. The position under the present grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect: *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. Romaco's services are all financial services that will be sought by members of the general public and business users.

Section 3(1)(c)

54. For reasons that will become obvious below, I will consider the section 3(1)(c) ground first.

55. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of

21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by analogy, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

56. Romaco's registration consists of two marks, being 'Love to Lend' and 'LovetoLend'. In considering the second mark, I appreciate that it is presented as one word. However, I find that consumers will readily identify it as being the three word 'Love to Lend' conjoined as one. As such, there is no material difference between the marks and I will, therefore, base my assessment on the mark 'Love to Lend', with my findings applying equally to both marks within the registration.

57. I remind myself that under the present ground, SDKA's pleaded case is that the marks in Romaco's registration are descriptive as they would be perceived as providing information about the services provided by Romaco. This pleading is rather vague in that SDKA did not expressly state what 'information' is being referred to. It is noted that SDKA did expand upon this in its written submissions in lieu of a hearing wherein it argued that the marks were descriptive of Romaco's services. This is the first time that Romaco would have had any sight of SDKA's actual case and while I note that Romaco was permitted to file submissions in response, the lateness of the specificity of the pleading does potentially give rise to some procedural unfairness against Romaco. That being said, I will proceed to consider this ground as per the case expanded upon in SDKA's submissions.

58. I note that in its written submissions, SDKA includes a screenshot of the dictionary definition of the word 'LEND'. This was not adduced formally as evidence but, even if it were, it would be of very little assistance. I say this because the word 'LEND' is a widely known English dictionary word that will be understood immediately as a reference to something being temporarily given to someone on the basis that it will be returned at a later date. In solus, the word 'LEND' may very well be descriptive of the purpose of the services at issue. However, the assessment I must make here is to be based on the mark as a whole. The addition of 'LOVE TO' will qualify the word 'LEND' in that it will be understood as a statement that the provider of said services 'loves to lend'.

59. I appreciate that the marks do not expressly clarify what it is that the provider 'loves to lend'. However, the marks will be viewed in connection with a range of financial services which are either broad enough to cover the provision of loans or offer

financing, or they expressly cover the arranging of finance, loans and mortgages. In this context, the consumer will instantly understand that the statement ‘love to lend’ applies to the lending of money. That being said, I consider that the statement will be understood as one relating to the enthusiasm of the provider for lending money as opposed to a direct description in relation to the services. Put simply, I consider that the addition of the words ‘Love to’ before ‘Lend’ creates a degree of uniqueness that takes away from the idea that the marks directly describe the purpose of the services at issue. Again, as I have set out above, ‘Lend’, solus, may be descriptive of the services at issue, that is not the assessment I must make. As a result, while I accept that the marks at issue are heavily allusive to the services at issue, I do not consider that they are directly descriptive of any of their characteristics. For the avoidance of doubt, I also find that the marks are capable of identifying trade origin.

60. Lastly, I note that a basis of SDKA’s claim was that the marks should be invalidated because it is in the public interest to ensure that rights to not exist for purely descriptive terms. Given what I have said above in that I do not consider ‘Love to Lend’ to be purely descriptive, this aspect of SDKA’s claim does not bite. It is, therefore, dismissed.

61. As a result of what I have said above, I find that Romaco’s registration is not objectionable under the provisions set out in section 3(1)(c) of the Act.

Section 3(1)(b)

62. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and section 3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or

service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

63. SDKA claims that the marks Romaco's registration serve as a promotional function to endorse the services being provided and, therefore, are devoid of any distinctive character. In respect of this claim, I remind myself of the case of *Audi AG v OHIM*, Case C-398/08 P, wherein the CJEU held that slogans can be distinctive if they are not caught by section 3(1)(c) and their capacity to identify trade origin is discernible, even if secondary to a promotional function. Therefore, given what I have said above in respect of the section 3(1)(c) ground, I do not consider that this claim can succeed. While I do not doubt that there may be a promotional function to the marks in Romaco's registration, I have found that they are not objectionable under section 3(1)(c) and that they maintain their capacity to identify the trade origin of the services in issue. As a result, I do not consider that SDKA's pleaded case succeeds and, therefore, I find that Romaco's registration is not objectionable under section 3(1)(b) of the Act.

Conclusion of SDKA's application

64. SDKA's application fails in its entirety, meaning that Romaco's registration may remain registered for all services. It, therefore, remains a valid earlier mark capable of being relied upon in Romaco's applications, which I will now proceed to consider.

Romaco's applications

65. Section 5(2)(b) of the Act has an application in invalidation proceedings because of the provisions of section 47 of the Act, which states as follows:¹³

"47. –

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

¹³ For the avoidance of doubt, certain provisions have been removed due to the fact that they are already included in the reproduction of section 47 I have set out under SDKA's application.

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or

(where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

Section 5(2)(b): legislation and case law

66. Section 5(2) of the Act reads as follows:

“(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, or

(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.”

67. Section 5A of the Act states as follows:

“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.”

68. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

69. Given their earlier filing dates, the marks in Romaco’s registration qualify as earlier trade marks under the above provisions. Romaco’s registration did not complete its registration either five years before the filing of SDKA’s registrations or five years before the filing of the invalidation applications. As such, it is not subject to the use provisions and Romaco may, therefore, rely on all of the services for which its marks are registered.

70. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and

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

Comparison of services

71. Romaco's services are set out at paragraph 2 above. SDKA's first registration's services are set out at paragraph 6 whereas its second registration's services are set out at paragraph 7.

72. The parties' specifications are relatively broad and cover a range of differently worded terms that, essentially, cover the same service. In short, all of the terms at issue relate to financing, credit and loans. Rather than labour over the specifications at issue, I will simply find that all of SDKA's terms are either self-evidently identical or identical under the principle outline in *Meric*¹⁴ (be that whether SDKA's terms encompass Romaco's, or vice versa) with the terms "loans [financing]", "personal finance services", "industrial financing services" and "credit financing" in Romaco's specification.

The average consumer and the nature of the purchasing act

73. 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. (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 parties were agreed that the

¹⁴ See paragraph 29 of *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05

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.”

74. The services at issue will be selected by members of the general public or business users. The services are likely to be selected direct from the provider (such as banks and other financial institutions) after being presented to the consumer via physical or digital advertising, on websites, or in physical premises where information will be displayed in brochures and pamphlets. As a result, I find that the purchasing process is predominantly visual in nature. However, I do not discount an aural element playing a part as the consumer is likely to also receive word of mouth recommendation or engage in discussions with the provider.

75. The frequency with which the services are selected is likely to vary so too is their cost. I say the latter point because the costs associated with the services is likely to come via interest payments which will depend on how much money is being borrowed, and for how long. None of the services are casual selections on the basis that they are financial in nature and will require attention being paid to the reputation of the provider, repayment terms, overall amount to be repaid and penalties for late/non-payment. While these selections are somewhat ordinary, I consider that the level of attention paid will be higher than medium (but not outright high) due to the financial nature of the services.

Comparison of the marks





76. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

77. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

78. It would be wrong, therefore, to artificially dissect the trade marks, 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.

79. The respective trade marks are shown below:

Romaco's registration	SDKA's registrations
<p style="text-align: center;">Love to Lend LovetoLend (series of two)</p>	<div style="text-align: center;">   (series of two) (“SDKA's first registration”) </div> <div style="text-align: center;">   (series of two) (“SDKA's second registration”) </div>

80. Both parties' registrations are series of two marks. Each mark within the respective series is essentially identical save for the use of spacing (in Romaco's marks) and colour (in SDKA's marks). Given that the differences between the marks in their respective series are of no real consequence to their comparison,¹⁵ I will proceed to consider the first mark in each registration only, with the findings made in relation to those marks applicable to all marks in the corresponding registrations. For ease of reference, I will refer to these marks as Romaco's mark, SDKA's first mark and SDKA's second.

Overall impression

81. Romaco's mark is a word only mark, being 'Love to Lend'. This will be seen as a unitary phrase and, as such, the overall impression of the mark lies equally across all three words.

82. SDKA's first mark is a figurative mark consisting of the letters 'SKDA' in a large white standard typeface. Underneath the letters sits the element, '#welovetolend' which, while presented as one word, will be readily identified as the four words, 'we love to lend'. It is presented in a much smaller white typeface with the hashtag presented in yellow. The empty spaces within the hashtag and the two letter 'O's' within '#welovetolend' are shaped like a heart. Both of these elements sit on a coloured blue background. For reasons that I will come to explain below, the letters 'SKDA' will dominate the overall impression of the mark with '#welovetolend', the colour used and the stylisation elements playing much lesser roles.

83. SDKA's second mark is also a figurative mark which consists of the same '#welovetolend' element (inclusive of the hearts within the hashtag and the 'O's') as appears in the first mark. The letters are in blue and the hashtag is in yellow. This element sits on a white background. For reasons that I will come to explain

¹⁵ On the basis that consumers will recognise 'LovetoLend' as the conjoining of the same three words in Romaco's first mark. Further, the use of colour in SDKA's mark is, as I will come to discuss below, a point of difference with the marks in Romaco's registration regardless of what that colour is. As such, whether that colour is green or blue is irrelevant for the purposes of this assessment.

below, I find that the word element, the stylisation and use of colour (on the basis that there is a contrived colour split within the mark) play an equal role in the overall impression of the mark.

Visual comparison

84. Firstly, I consider it necessary to point out that by virtue of being a word only mark registered in black and white, Romaco's mark may be presented in any standard typeface and in any colour. That being said, the fair and notional use of a word only mark in black and white does not extend to the stylisation used within the text of SDKA's marks (namely the use of hearts within the text). Further, the use of colour does not extend to the contrived colour splits, such as that used by SDKA in its marks. These are, therefore, points of visual difference between the marks.

Romaco's mark and SDKA's first mark

85. In comparing these marks, I note that they share the words 'love to lend'. This is the only point of similarity between these marks. The marks differ in their presentation as well as the presence of a range of different elements in SDKA's mark, namely the presence of the word 'we', the hashtag, the stylisation of the hearts within the '#welovetolend' element and, most notably, the letters 'SDKA'. While the shared 'love to lend' element will not be ignored outright, it does play a much lesser role in SDKA's mark and is presented much smaller. It, therefore, only acts as a small point of similarity. As a result, I find that these marks are only visually similar to a low degree.

Romaco's mark and SDKA's second mark

86. These marks share the words 'love to lend', which forms the entirety of Romaco's mark. The marks differ in the presence of various elements within SDKA's mark, being the inclusion of '#we' prior to the shared element, the colour used and the stylisation elements. Despite what I will come to say about the words '#welovetolend' in SDKA's mark, the common element is a point of considerable similarity. That being said, the stylisation and presence of '#we' still creates a

significant impact on SDKA's mark so will act as a point of difference, especially given that '#we' sits at the beginning of SDKA's mark, being where consumers tend to focus.¹⁶ Overall, I consider that these marks are visually similar to between a medium and high degree.

Aural comparison

87. Romaco's mark consists of three syllables that will be pronounced in the ordinary way. As for SDKA's first mark, I do not consider that '#welovetolend' will be pronounced by the majority of consumers. I say this because (1) it appears much smaller within the mark and (2) has the sole purpose of being a hashtag within the mark that consumers will simply see as a tagline acting as some sort of social media identifier, for example. As a result, SDKA's first mark will simply be pronounced as four individual letters and, as such, it will be aurally dissimilar to Romaco's mark. Even if some consumers do articulate '#welovetolend', I do not consider that they form a significant proportion of consumers so will have no impact upon these proceedings.

88. As the sole verbal element in SDKA's second mark, clearly the words 'love to lend' will be pronounced in full. As for the '#', I appreciate that a significant proportion of consumers will pronounce it as the two syllable word, 'hashtag'. I say this because consumers are, as far as I am aware, used to articulating social media hashtags in this way. While that may be the case, I will, for the purpose of this assessment, focus on those who pronounce the mark simply as 'we love to lend', as this represents SDKA's best case. The words 'love to lend' sit wholly within 'we love to lend', which differs only in one syllable. While that difference sits at the beginning of SDKA's mark, the identity of three syllables is such to justify a finding that these marks are aurally similar to a high degree.

¹⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Conceptual comparison

89. Conceptually, Romaco's mark will be readily understood as a phrase indicating that the provider of the services loves to lend something. As for what is being lent, this will be understood in the context of the services for which that mark is registered, being financial services. Therefore, Romaco's mark will be understood as relating to the lending of money.¹⁷ I have set out above that this is not outright descriptive but it is heavily allusive to Romaco's services.

90. Turning to SDKA's first mark, I consider that it will be dominated by the concept of the letters 'SDKA', which will have no obvious meaning outside of being an initialism of four letters, presumably standing for the name of the company/organisation. The addition of '#welovetolend' will have very little impact on the overall concept of the mark as it will be viewed as a hashtag that SDKA uses on social media platforms and simply acts as a declaration that 'we', being SDKA, loves to lend money. As was the case with Romaco's mark, this element is heavily allusive and this is why I found that it plays a much lesser role in SDKA's first mark. Comparing the overall concept of these marks, I accept that there is some overlap due to the shared reference to 'loving to lend money' but, given the role of this element in SDKA's mark and its heavily allusive nature, its impact will only be slight. Therefore, I find that these marks are conceptually similar to only a low degree.

91. As for SDKA's second mark, the concept associated with this lies solely in '#welovetolend' which, as above, will be viewed as a hashtag that SDKA uses on social media platforms and simply acts as a declaration that 'we', being SDKA, loves to lend money. Again, this is heavily allusive to the fact that the provider loves to lend money. That being said, it is the only concept that can be associated with the mark. I do not consider that the difference created by the inclusion of '#we' in SDKA's mark is sufficient to take away from the idea that both marks are

¹⁷ On this point, see paragraph 32 of *LIGHT VITAMIN* (BL O/1174/25) wherein Mr Thomas Mitcheson K.C., sitting as the Appointed Person, set out that an assessor should normally consider if the goods have a potential effect on conceptual meaning as a result of any link or allusion between the mark and the goods. While referring to goods, this principle is equally applicable to services.

declaratory statements that the provider loves to lend. As a result, I find that these marks are conceptually identical.

Distinctive character of Romaco's registration

92. 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).”

93. 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 marks can be enhanced through use. I note that Romaco filed evidence of use in these proceedings and I will, therefore, consider whether the

evidence is sufficient to give rise to a finding that the distinctiveness of Romaco's registration has been enhanced through use. Before doing so, I will consider the inherent position.

94. Romaco's registration consists of two marks that are 'Love to Lend' and 'LovetoLend'. I have explained above that 'LovetoLend' will be seen as the conjoining of the words 'Love', 'to' and 'Lend' and, as such, I find that the two marks in the registration are, essentially, the same. I will, therefore, consider the distinctiveness of the marks as one. Inherently, the words 'Love to Lend' will heavily allude to the fact that the services at issue are those that relate to the lending of money. I have explained in SDKA's application above that this is not directly descriptive but that it is heavily allusive. This message is, in my view, only sufficient to give rise to a finding that the marks in Romaco's registration benefit from only a very low degree of distinctive character.

95. In respect of the enhanced distinctiveness of this mark, I can confirm that I have reviewed Romaco's evidence in full. On the face of it, I accept that Romaco conducts a fairly sizeable business operation within the UK, with turnover of £15 million between August 2022 and May 2023, and £21 million for June 2023 to May 2024.¹⁸ However, the issues complained of with regard to SDKA's evidence when considering goodwill above are also present here. I say this because while the wording 'Love to Lend' appears throughout the evidence, this is mainly as a hashtag underneath the actual branding that Romaco's uses, being 'ROMA'. As an example of this use, I refer to the following image from the evidence:¹⁹



¹⁸ Albeit the latter figure covering three months after the relevant date for these applications, being January 2024.

¹⁹ See page 16 of SM6

96. This appears as part of a larger advert for borrowing services relating to property. Clearly, the use of the mark at issue is very small and, Roma will clearly be identified as the actual brand offering the services. Further, the website and email show that the business operation is under 'romafinance', with no reference to 'Love to Lend'. In furtherance of this point, I note that the social media evidence provided shows accounts under the name 'roma.finance'.²⁰

97. While I appreciate that there are instances with 'love to lend' appearing above 'Roma', I see no evidence wherein 'Love to Lend' would actually be seen as an indicator of the origin of the services. Instead, it is shown simply as a hashtag that the company 'Roma' uses on its social media platforms. I am of the view that the relevant public is aware of how companies utilise social media by using hashtags so will not attribute any actual use of Romaco's services to '#lovetolend'. As a result, I fail to see how Romaco's evidence gives rise to any level of awareness of the mark as an indicator of origin by the relevant public in the UK. For these reasons, I find that Romaco has not demonstrated that its registration benefits from any enhanced degree of distinctive character.

98. In any event, even if Romaco's use could be said to be attributable to the relevant registration, the inherent position is so low that any enhancing of its distinctive character would require a high level of use over a prolonged period of time. In the present case, I appreciate that the use may be in the tens of millions of pounds per annum. However, this is not particularly intensive in the context of the market for the services at issue (being a range of financial services).²¹ Further, it covers only around 18 months of use (being August 2022 to January 2024). Therefore, even if I were satisfied that Romaco's evidence was of assistance to the mark at issue, it is not sufficient enough to alter the inherent position which, as above, is very low.

²⁰ See SM7

²¹ I appreciate that I have no direct evidence as to the size of the market. However, even without such evidence, I am satisfied that the UK market for the types of lending services at issue is a very large one.

Likelihood of confusion

99. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the marks in Romaco's registration, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that they have retained in their mind.

100. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., 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)."

101. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C., sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

102. I have found the marks in Romaco's registration to be visually and conceptually similar to a low degree and aurally dissimilar with the marks in SDKA's first registration. As for the marks in SDKA's second registration, I have found these to be visually similar to between a medium and a high degree, aurally similar to a high degree and conceptually identical with the marks in Romaco's registration. I have found the services at issue to be identical. The average consumer base is formed

of members of the general public and business users who will select the goods and services via primarily visual means (though not discounting an aural component). The level of attention paid will be higher than a medium degree, though not outright high. Lastly, I have found the marks in Romaco's registration to only benefit from a very low degree of distinctive character. In respect of this point, I remind myself of the case of *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, O/0368/23, wherein Emma Himsworth K.C., as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) and *Nicoventures Holdings Limited v The London Vape Co Ltd* [2017] EHC 3303 (Ch), 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. Miss Himsworth summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness 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.”

103. Given the differences between SDKA’s registrations, I will deal with the issue of a likelihood of confusion in respect of them in turn, beginning with the first registration.

SDKA’s first registration

104. Taking all of the above into account, I appreciate that the shared use of the element ‘lovetolend’ will be noticed across the marks across these registrations. However, the dominant element in SDKA’s marks is the element ‘SDKA’. In short, I see no reason why consumers would overlook the presence of this element so as to misremember which mark was which. Consequently, there exists no likelihood of direct confusion between these marks, even on identical goods.

105. Turning to the issue of indirect confusion, I am of the view that the differences between the marks would not lead the consumer to believe that they originated from the same or economically linked undertakings. Put simply, I am of the view that the shared use of a reference to ‘love to lend’ would be viewed purely as the coincidental use of a phrase that heavily alluded to the fact that the provider of the services loved to lend money. In the context of SDKA’s mark, I see no reason why consumers would believe that ‘#welovetolend’ was an indicator of origin but, instead, a hashtag/tagline used by the undertaking ‘SDKA’ to allude to its services.²² Consequently, I find that there exists no likelihood of indirect confusion between these marks, even on identical services.

SDKA’s second registration

106. Clearly, the marks in SDKA’s second registration share greater degrees of similarity with the marks in Romaco’s registration when compared with the marks

²² For the avoidance of doubt, it is for this reason that I fail to see why the *Medion* principle (the correct approach set out at paragraphs 18 to 21 in *Whyte and Mackay* – cited above) would apply because, plainly, ‘#welovetolend’ will not be viewed as having its own distinctive significance which is independent of the significance of the whole.

in SDKA's first registration. However, I remind myself that the distinctive character associated with the words 'Love to Lend' is very low due to their heavily allusive nature. Paying particular regard to the fact that this is the common element between these marks, I am of the view that, even bearing in mind the principle of imperfect recollection, the differences between the parties' marks will take on a greater significance for the average consumer than they might otherwise. Although the stylised aspects of SDKA's marks are not particularly remarkable, they take on greater significance due to the heavily allusive nature of the word element and the fact remains that these aspects are entirely different and will be noticed. As such, they will lead consumers to be able to accurately recall the marks for one another. A further point in support of this conclusion is that the consumer will pay a higher than medium degree of attention, meaning that they are more likely to recall the differences. Consequently, I find that there exists no likelihood of direct confusion between these marks, even on identical services.

107. Moving on to the issue of indirect confusion, I am of the view that this gets Romaco no further. I say this because the shared wording is so heavily allusive to the services at issue that the average consumer would, upon being confronted by both parties' marks, view the commonality between them as purely coincidental. While the different elements are not so remarkable themselves, the average consumer will pay a higher than medium degree of attention when selecting the services at issue so they are more likely to notice them. This factor, together with the fact that the marks in Romaco's registration are only very low in distinctive character, lead me to conclude that there is nothing that could give rise to a "proper basis", as required under *Liverpool Gin* (cited above), for finding a likelihood of indirect confusion. Consequently, I find that there exists no likelihood of indirect confusion, even on identical services.

CONCLUSION

108. Both invalidation applications have failed in their entirety. As such, Romaco's registration may remain registered for all services. Further, both SDKA's registrations may remain registered for all services.

COSTS

109. Given that both parties have failed in their applications for invalidity, I will refrain from making any costs award in favour of either party. Instead, I will simply order that the parties in these proceedings are to bear their own costs.

Dated this 19th day of March 2026

A COOPER

For the Registrar